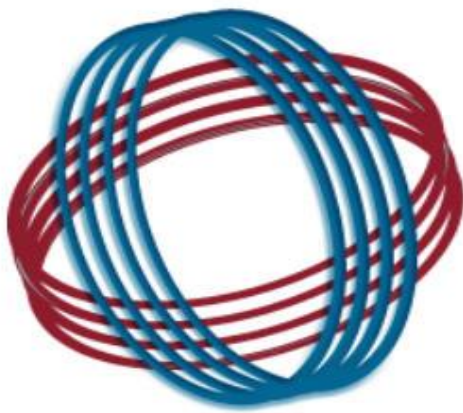




AIPLA

18th Annual Patent Cooperation Treaty Seminar

July 21 - 22, 2014

**The Westin Westminster
Westminster, CO**

July 24 - 25, 2014

**The Westin Arlington Gateway
Arlington, VA**

INTRODUCTION TO AND BENEFITS OF THE PATENT COOPERATION TREATY

Samson Helfgott
Katten Muchin Rosenman LLP
New York, NY

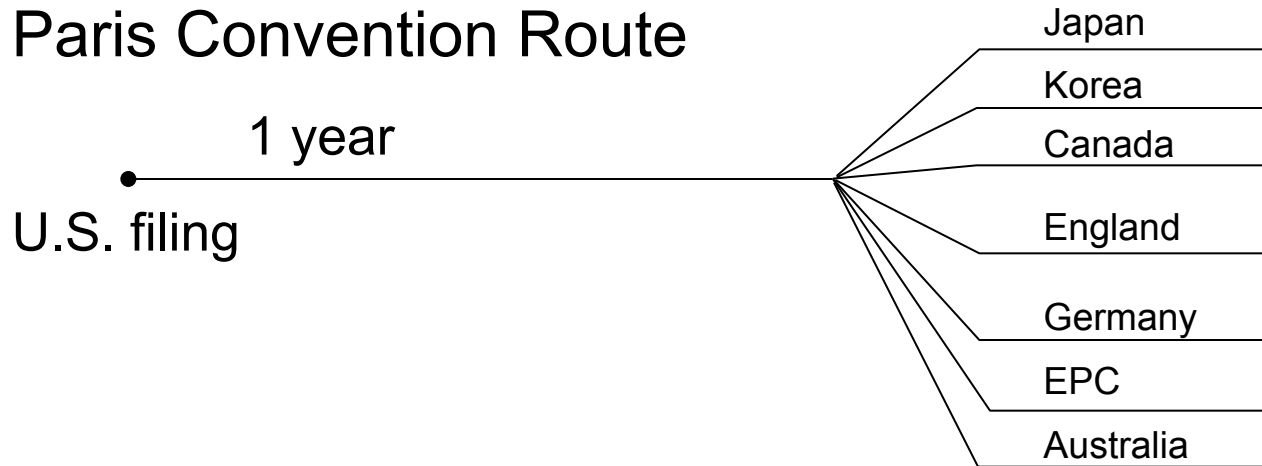
AIPLA
PCT Seminar
July, 2014

BENEFITS

- PCT is generally being used because client is considering foreign filing.
 - Buying time and deferral of costs

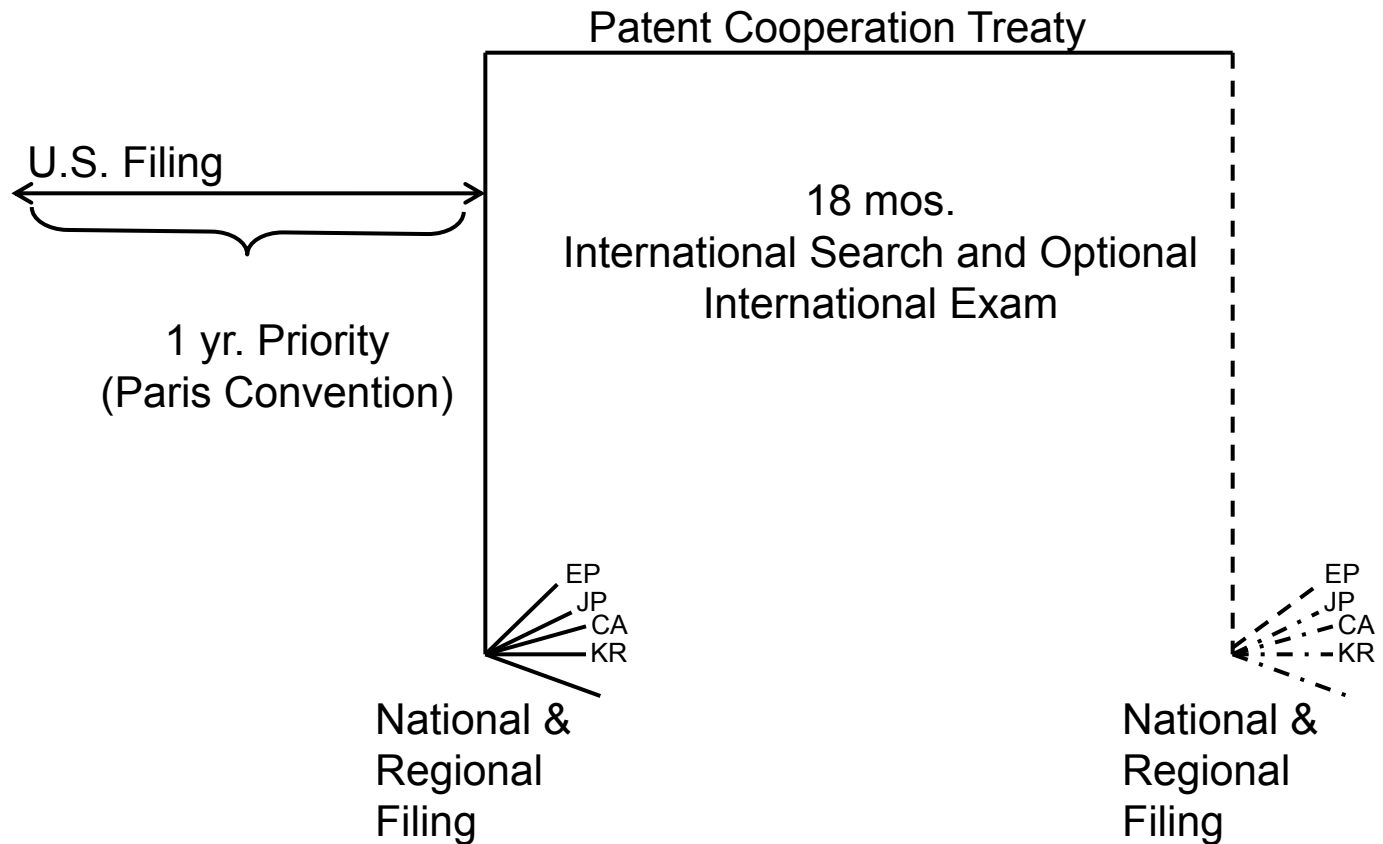
PCT GIVES YOU MORE TIME **TO DECIDE WHERE TO FOREIGN** **FILE YOUR APPLICATION**

Paris Convention Route



- The procedure is very costly.
- Within 1 year you rarely have enough information on importance of invention.
- Within 1 year you rarely have enough information on the selection of countries.
- Generally, the deferral of money is important for clients.
- Often cases are dropped early on.

FOREIGN FILING USING THE PCT



PCT DEFERS

HIGH COST OF FOREIGN FILING

- Translation Costs
- Claim fees
- Agent Fees
- Government fees
- Examples
 - Japan – about \$300 per page (typing and translation)
 - Germany – about \$200 per page (translation)
 - Claim fees
 - Europe – \$300 for every claim above 15 (further increases in the future)
 - Japan – \$50 per claim

- Lifetime costs (not including cost of writing application)
 - U.S. approximately - \$25,000
 - Europe (8 countries) approximately - \$150,000 (will be less in the future using the Unitary Patent)
 - Japan approximately - \$75,000

1993 Costs.
For today's costs
multiply by 1.5 -
2 times

**“Patent Filing Costs Around the
World,” Samson Helfgott, PTOS,
Vol. 75, No. 7, July, 1993**

*TABLE II
Summary of Patent Filing Costs*

\$US Country	Off'l. Filing Fees	Agt's. Fees	Transl. (Type/Copy)	TOTAL
Argentina	\$ 500	\$ 1100	\$ 815	\$ 2415
Australia*	220	750	—	970
Austria	64	830	1525	2419
Brazil	120	800	850	1770
Canada**	325	365	—	690
Columbia	196	1500	520	2216
Denmark	580	1150	2200	3930
Finland	265	935	1500	2700
France	80	912	2050	3042
Germany	101	965	2000	3066
Greece	302	578	780	1660
India*	50	410	—	460
Israel*	235	535	—	770
Italy	367	1170	2125	3662
Japan	140	1812	2820	4772
Korea	67	900	1500	2467
Luxembourg	36	515	1085	1636
Mexico	640	1025	940	2605
Netherlands	317	468	1518	2303
N. Zealand*	281	572	—	853
Norway	207	945	1806	2958
Panama	110	1125	430	1665
Paraguay	40	860	287	1187
Singapore**	165	190	—	355
Spain	121	1573	1810	3504
So. Africa*	76	842	—	918
Sweden	300	875	2150	3325
Switzerland	170	925	1850	2995
Taiwan	195	1021	1190	2406
U.K.**	350	850	20	1220
Venezuela	40	1010	1232	2282
U.S.**	755	635	—	1390
EPO**	2950 (5 ctys)	1650	—	4600

* no translation needed

+ large entity

** registration of UK patent

including search

FOREIGN FILING (National/Regional Phase)

EPC	filing	prosecution	4 - 6 yrs	\$4,000	France	\$1,000 - \$2,000
				\$4,500	Germany	\$800 - \$3,000
				\$2,500	England	\$500 - \$2,500
				\$4,500	Spain	\$400 - \$2,500
				<u>Translations and filing (less with London Protocol)</u> <u>Grant</u> <u>Maintenance/yr.</u>		
Japan	Filing with translation	deferral	prosecution	grant	\$1,000 - \$3,000	
	\$7,000 - \$10,000	3 yrs	\$6,000 1 - 3 yrs		Maintenance/yr.	
Canada	Filing	prosecution			\$500 - \$2,000	
	\$3,000	2-4 yrs	grant		Maintenance/yr.	
Korea	Filing with translation	deferral	prosecution		\$700 - \$2,500	
	\$8,000	4 yrs	4 - 6 yrs \$8,000	grant	Maintenance/yr.	

OTHER BENEFITS

- However, there are other benefits we get using the PCT.
 - Search, written opinion, and optional examination
 - Opportunity for Patent Prosecution Highway
 - Opportunity to “get to know your invention”

BRIEF SUMMARY OF SOME BENEFITS OF USING THE PCT

- Provides additional 18 months after priority year (30 months) before making foreign filing decisions
- Some countries permit 31 months
- While it adds additional International Costs (about \$3,000-\$5,000), it defers high costs of national filing (\$25,000-\$50,000)
- Preserves priority rights in all member countries
- Gives client more time to assess importance of invention and make better decisions on foreign filing
- Can file in English – No translation costs on filing
- Will get an International Search and Written Opinion & Optional Examination Process
- Can use one application for “Global” Filing
- Can use for Patent Prosecution Highway

OUR CHALLENGE

- How to use the PCT system.
- How to make the best strategic use of the system.

**Contact Information for
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Director of Patents
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New York, N.Y., 10022
(212) 940-8683
samson.helfgott@kattenlaw.com**

Disclaimer: This presentation does not constitute any specific legal or business advice.



An Overview of the PCT System

Carol Bidwell
July 2014

Tab 1 - 1

NAMES & ABBREVIATIONS

The following words and expressions used throughout this document should be understood as follows:

Administrative Instructions	- the Administrative Instructions under the PCT
Article	- an Article of the PCT
Chapter I	- Chapter I of the PCT "International Application and International Search"
Chapter II	- Chapter II of the PCT "International Preliminary Examination"
Contracting State	- a State (country) party to the PCT
Demand	- a Demand for International Preliminary Examination
International Phase	- the phase under which an application is processed under the PCT
National Phase	- the phase under which an application is processed under national law
National Stage	- the term used specifically in the DO/EO/US for the national phase
Regional Phase	- the phase under which an application is processed by a regional organization (EPO, EAPO, ARIPO, OAPI)
Regulations	- the Regulations under the PCT
Rule	- a Rule of the regulations of the PCT
Section	- a Section of the Administrative Instructions under the PCT

References to "national" Office or national fees, national processing, national phase, should be understood to include "regional" Office, regional fees, regional processing, regional phase, etc.

The following abbreviations used throughout this document should be understood as follows:

AIA	- America Invents Act
ARIPO	- African Regional Industrial Property Organization
DO	- Designated Office under the PCT (Chapter I)
EO	- Elected Office under the PCT (Chapter II)
EPO	- European Patent Office
IB	- International Bureau (of the World Intellectual Property Organization)
IPE	- International Preliminary Examination
IPEA	- International Preliminary Examining Authority
IPER	- International Preliminary Examination Report (same as IPRP (Chapter II))
IPRP (Chapter I)	- International Preliminary Report on Patentability (Chapter I of the PCT)
IPRP (Chapter II)	- International Preliminary Report on Patentability (Chapter II of the PCT)
ISA	- International Searching Authority
ISR	- International Search Report
PCT	- Patent Cooperative Treaty
PLTIA	- Patent Law Treaty Implementation Act of 2012
PPH	- Patent Prosecution Highway
OAPI	- Organisation Africaine de la Propriété Intellectuelle (African Intellectual Property Organization)
RO	- Receiving Office
SIS	- Supplementary International Search
SISA	- Supplementary International Searching Authority
SIS Report (SISR)	- Supplementary International Search Report
WIPO	- World Intellectual Property Organization
WOISA	- Written Opinion of the International Searching Authority
WTO	- World Trade Organization

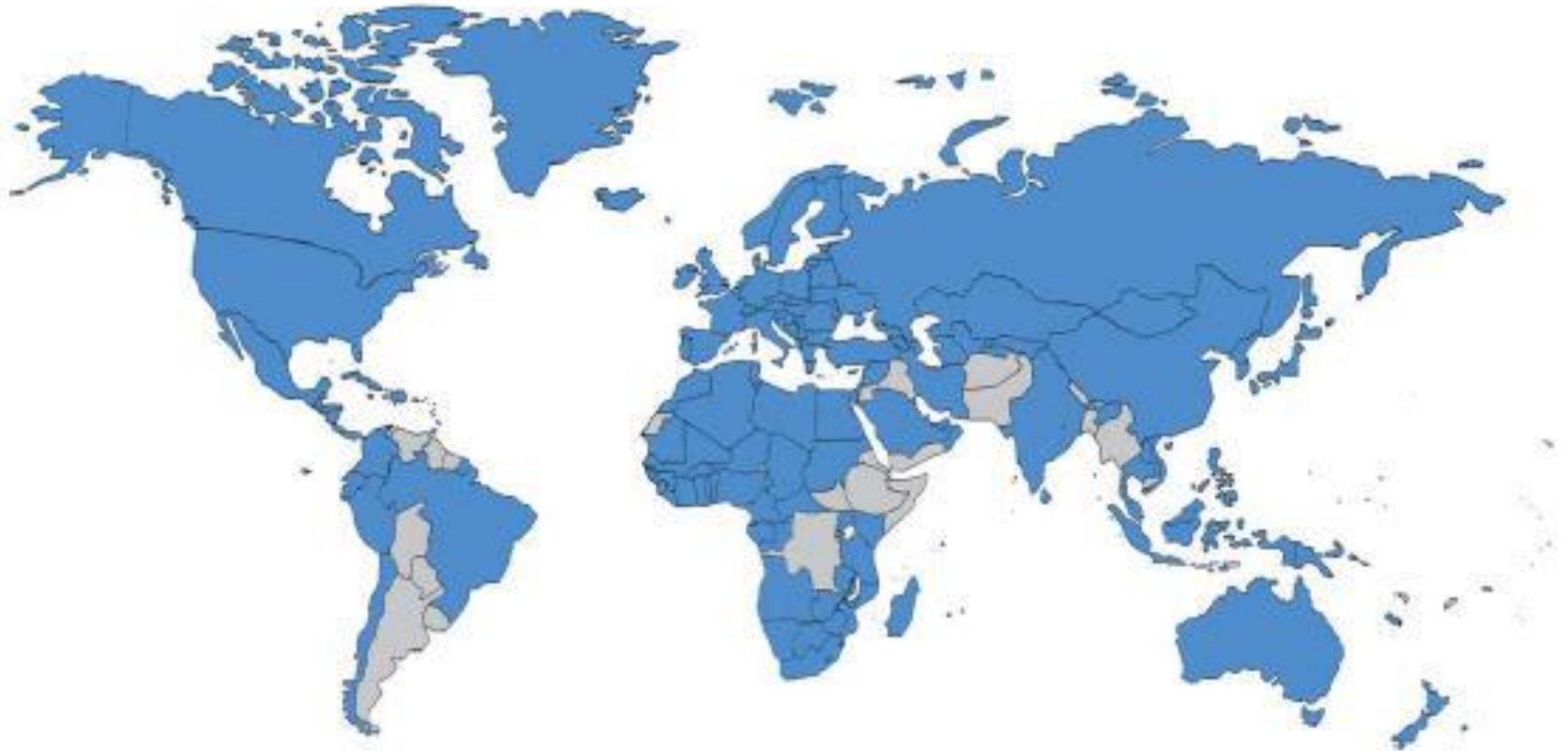
General remarks on the PCT system (1)

- The PCT system is a patent “filing” system, not a patent “granting” system. There is no “PCT” or “international” patent
- The decision on granting patents is taken exclusively by national or regional Offices in the national phase
- All PCT Contracting States must also be party to the Paris Convention
- Any international application having been accorded an international filing date has the effect of a regular national application (including establishment of a priority date) in each designated State as of the international filing date

General remarks on the PCT system (2)

- Only inventions may be protected via the PCT by applying for patents, utility models and similar titles
- Design and trademark protection cannot be obtained via the PCT; there are separate international conventions dealing with these types of industrial property protection (the Hague Agreement and the Madrid Agreement and Protocol, respectively)
- The PCT is administered by World Intellectual Property Organization (WIPO) as are other international conventions in the field of industrial property, such as the Paris Convention

PCT Contracting States (148 on 4 October 2013)



PCT member



Country not party to the PCT

PCT Contracting States (148) - Regional Offices (1)

States designated for regional and national protection except where otherwise indicated

EP European Patent

AL	Albania	▲ GR	Greece	▲ MT	Malta
AT	Austria	HR	Croatia	▲ NL	Netherlands
▲ BE	Belgium	HU	Hungary	NO	Norway
BG	Bulgaria	▲ IE	Ireland	PL	Poland
CH	Switzerland	IS	Iceland	PT	Portugal
▲ CY	Cyprus	▲ IT	Italy	RO	Romania
CZ	Czech Republic	LI	Liechtenstein	RS	Serbia
DE	Germany	LT	Lithuania ¹	SE	Sweden
DK	Denmark	LU	Luxembourg	▲ SI	Slovenia
EE	Estonia	▲ LV	Latvia	SK	Slovakia
ES	Spain	▲ MC	Monaco	SM	San Marino
FI	Finland	MK	The former Yugoslav Republic of Macedonia	TR	Turkey
▲ FR	France				
GB	United Kingdom				

▲ Regional patent only

¹ LT will close the national route with effect from 4 September 2014

PCT Contracting States (148) - Regional Offices (2)

States designated for regional and national protection except where otherwise indicated

AP ARIPO Patent

BW Botswana
 GH Ghana
 GM Gambia
 KE Kenya
 LR Liberia
 LS Lesotho
 MW Malawi
 MZ Mozambique
 NA Namibia
 RW Rwanda
 SD Sudan
 SL Sierra Leone
 ST Sao Tome & Principe *
 ▲ SZ Swaziland
 TZ United Republic of Tanzania
 UG Uganda
 ZM Zambia
 ZW Zimbabwe

EA Eurasian Patent

AM Armenia
 AZ Azerbaijan
 BY Belarus
 KG Kyrgyzstan
 KZ Kazakhstan
 RU Russian Federation
 TJ Tajikistan
 TM Turkmenistan

OA OAPI Patent

▲ BF Burkina Faso
 ▲ BJ Benin
 ▲ CF Central African Republic
 ▲ CG Congo
 ▲ CI Côte d'Ivoire
 ▲ CM Cameroon
 ▲ GA Gabon
 ▲ GN Guinea
 ▲ GQ Equatorial Guinea
 ▲ GW Guinea-Bissau
 ▲ KM Comoros
 ▲ ML Mali
 ▲ MR Mauritania
 ▲ NE Niger
 ▲ SN Senegal
 ▲ TD Chad
 ▲ TG Togo

▲ Regional patent only

* Applies to PCT's filed on or after 19 August 2014

PCT Contracting States (148)

States designated for national protection only except where otherwise indicated

AE	United Arab Emirates	IR	Islamic Republic of	OM	Oman
AG	Antigua and Barbuda		Iran	PA	Panama
AO	Angola	JP	Japan	PE	Peru
AU	Australia	KN	Saint Kitts and	PG	Papua New
❖ BA	Bosnia and		Nevis		Guinea
	Herzegovina	KP	Democratic	PH	Philippines
BB	Barbados		People's Republic	QA	Qatar
BH	Bahrain		of Korea	SA	Saudi Arabia
BN	Brunei Darussalam	KR	Republic of Korea	RS	Serbia
BR	Brazil	LA	Lao People's	SC	Seychelles
BZ	Belize		Democratic	SG	Singapore
CA	Canada		Republic	ST	Sao Tome &
CL	Chile	LC	Saint Lucia		Principe*
CN	China	LK	Sri Lanka	SV	El Salvador
CO	Colombia	LR	Liberia	SY	Syrian Arab
CR	Costa Rica	LY	Libyan Arab		Republic
CU	Cuba		Jamahiriya	TH	Thailand
DM	Dominica	MA	Morocco	TN	Tunisia
DO	Dominican Republic	MD	Republic of	TT	Trinidad and
DZ	Algeria		Moldova		Tobago
EC	Ecuador	❖ ME	Montenegro	UA	Ukraine
EG	Egypt	MG	Madagascar	US	United States of
GD	Grenada	MN	Mongolia		America
GE	Georgia	MX	Mexico	UZ	Uzbekistan
GT	Guatemala	MY	Malaysia	VC	Saint Vincent and
HN	Honduras	NG	Nigeria		the Grenadines
ID	Indonesia	NI	Nicaragua	VN	Viet Nam
IL	Israel	NZ	New Zealand	ZA	South Africa
IN	India				

❖ Extension of European patent possible

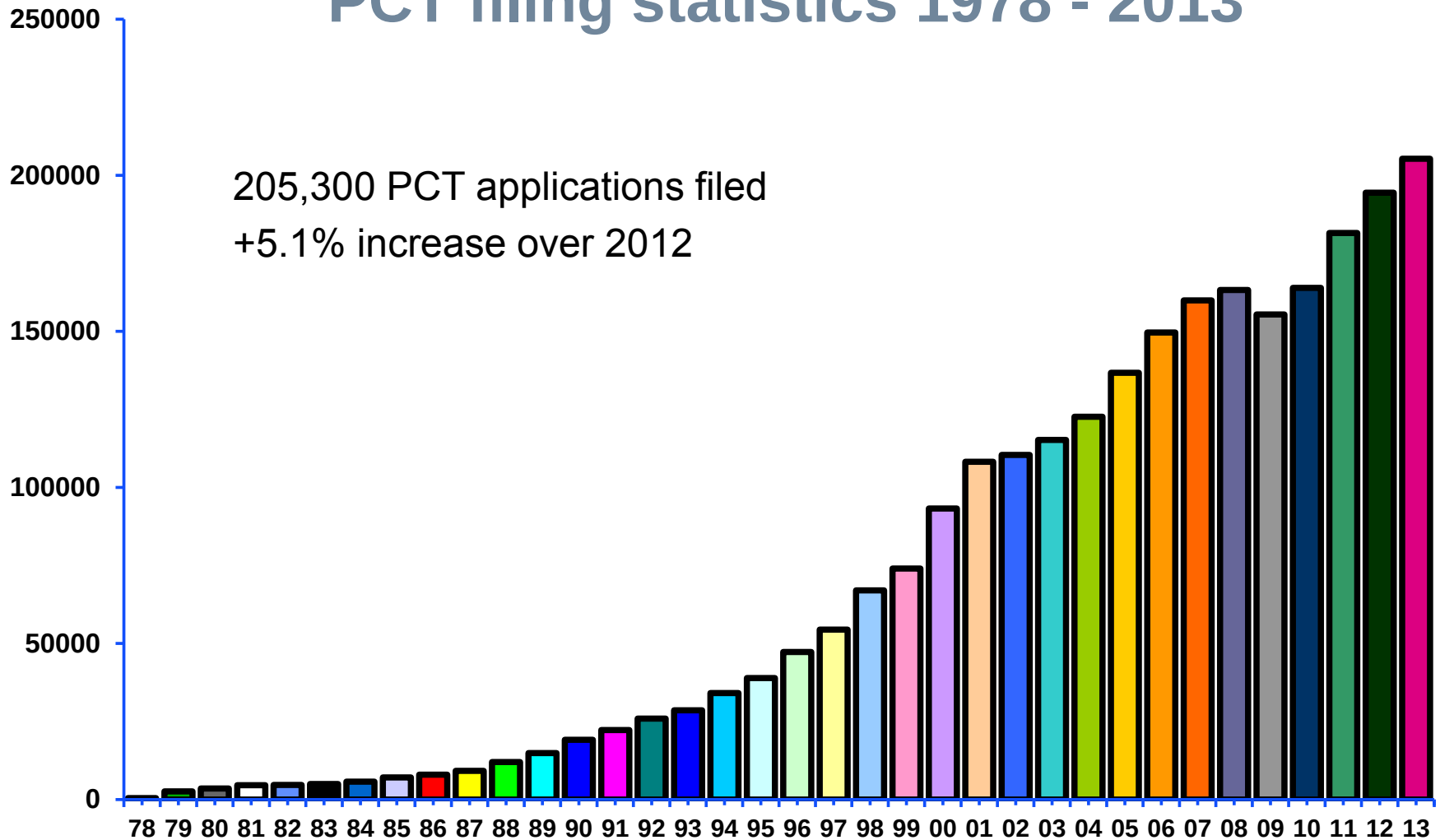
* Will become party to ARIPO with effect from 19 August 2014

Countries that are not PCT Contracting States

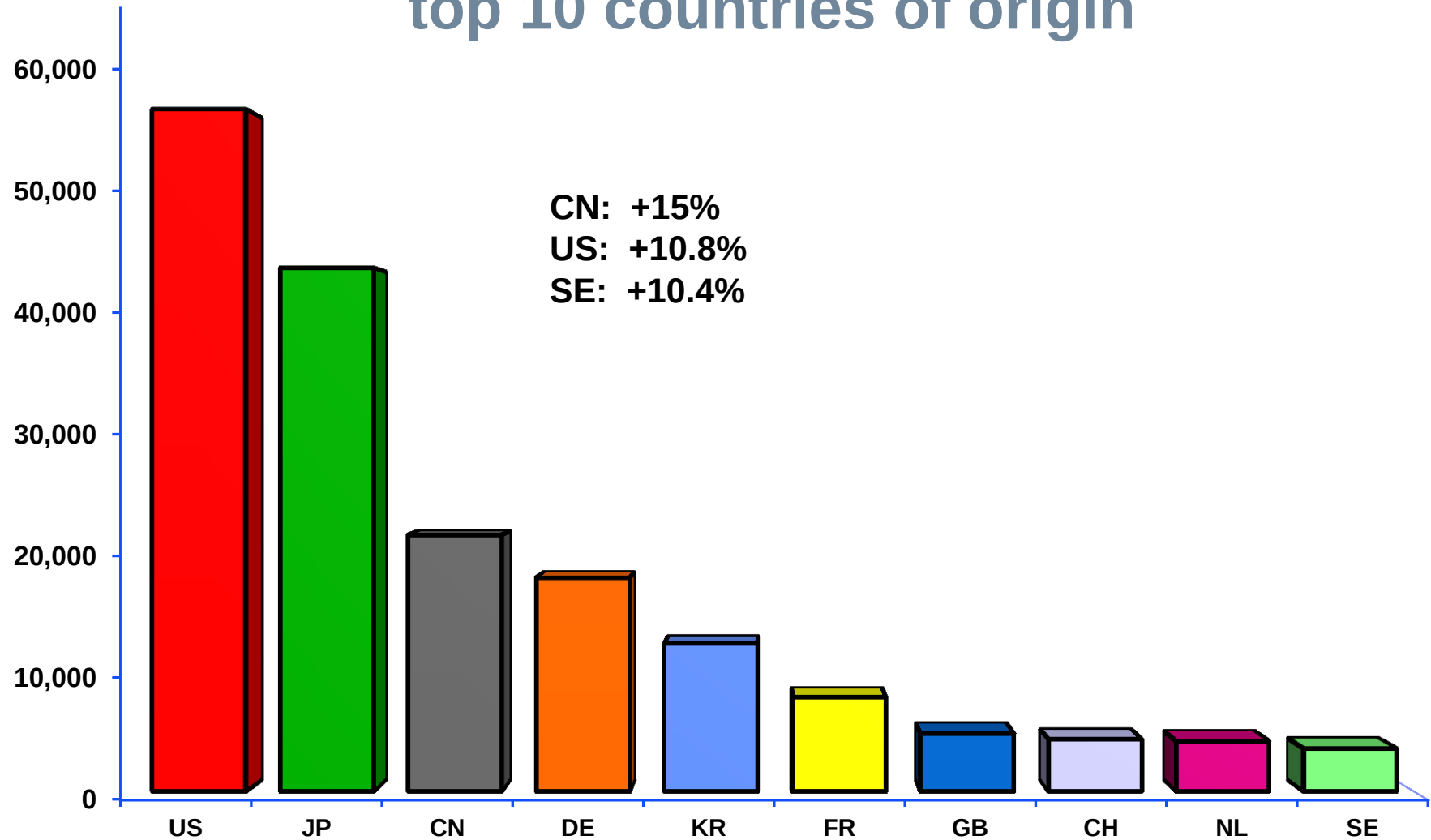
Afghanistan	Haiti	Palau
Andorra	Iraq	Paraguay
Argentina	Jamaica	Samoa
Bahamas	Jordan	Solomon Islands
Bangladesh	Kiribati	Somalia
Bhutan	Kuwait	South Sudan
Bolivia	Lebanon	Suriname
Burundi	Maldives	Taiwan*
Cambodia	Marshall Islands	Timor-Leste
Cape Verde	Mauritius	Tonga
Democratic Republic of Congo	Micronesia	Tuvalu
Djibouti	Myanmar	Uruguay
Eritrea	Nauru	Vanuatu
Ethiopia	Nepal	Venezuela
Fiji	Pakistan	Yemen
Guyana		

* The United Nations considers Taiwan to be a province of China

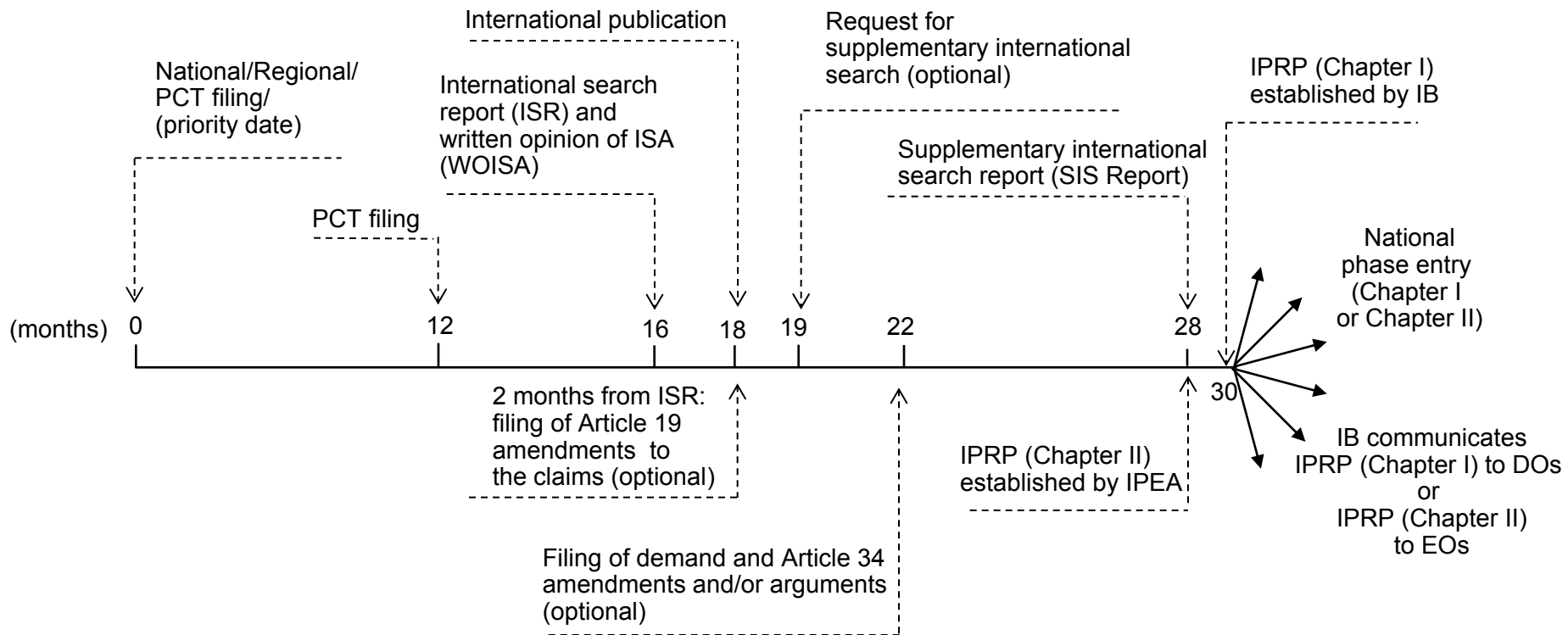
PCT filing statistics 1978 - 2013



PCT applications 2013 top 10 countries of origin



PCT timeline



Note: The national Offices of the following States have notified the International Bureau that they will not apply the 30 month time limit under Chapter I, as of 1 April 2002, for as long as modified Article 22(1) is not compatible with their national law:

LU	Luxembourg
TZ	United Republic of Tanzania
UG	Uganda

If no demand is filed before the expiration of 19 months, the national phase will have to be entered before the expiration of 20 or 21 months from the priority date. This reservation to the modified Article 22(1) timing does not apply when seeking patent protection in these countries via the EPO (LU) or ARIPO (TZ & UG).

Minimum requirements to file an international application and be accorded an international filing date by the receiving Office (Article 11(1))

- At least one applicant must be a national or resident of a PCT Contracting State
- The application must be in a prescribed language
- The application must contain at least:
 - an indication that it is intended as an international application (Rule 4.2)
 - a request which has the effect of making all possible designations (Article 4 and Rules 3 and 4.9)
 - the name of the applicant (Rule 4.5)
 - a description (Rule 5)
 - a claim (Rule 6)

Competent receiving Office (RO)

■ In order for a RO to be competent to accord an international filing date

- ☐ at least one of the applicants must have the right to file with the RO for reasons of nationality or residence

- ☐ the application must be in a language accepted by the RO

■ Note that if:

- ☐ at least one of the applicants is a resident or national of a PCT Contracting State but none of the applicants have the right to file with the RO for reasons of residence or nationality or

- ☐ the application is filed in a language not accepted by the RO for that purpose

that Office will transmit the application to the receiving Office of the International Bureau (RO/IB) for further processing

Not required for obtaining an international filing date

- Payment of fees
- Applicant's signature
- Title of the invention
- Abstract
- Drawings, whether formal or not
 - ☐ however, attention should be given to the question of whether the drawings are necessary for the understanding of the invention;
 - ☐ later furnishing of drawings will, under certain conditions, result in a change of the international filing date (see Article 14(2) and Rule 20.5)
- Translation into language of search or publication

Concept and operation of designation system

- The Treaty requires the designation of at least one Contracting State at the time of filing the international application
 - all States bound by the Treaty as of the international filing date are automatically designated by the filing of the request form
 - exception to the all-inclusive designation is possible for DE, JP and KR, that is, countries with rules on “self-designation”
 - but only if the international application contains a priority claim to an earlier application filed in the State that is to be excluded (see Annex B1 of the PCT Applicant’s Guide for DE, JP and KR)
 - otherwise withdrawals of designations are possible
- Choice of type of protection is postponed until national phase entry (e.g. patent or utility model, national or regional patent)
- PCT request form may include specific reference to earlier to “parent” application for continuation or CIP applications

Applicant of convenience

- What can be done where the applicant, or if there are multiple applicants, none of the applicants
 - ☐ is a national or resident of a PCT Contracting State or
 - ☐ is not entitled to file with a receiving Office by reasons of nationality or residence
- Name an applicant on the request form who is entitled to file an international application or to use a particular receiving Office, e.g., the RO/US as
 - ☐ an “applicant only” and
 - ☐ a co-applicant but only for the purposes of a PCT Contracting State of very low commercial importance to the main applicant
- Some who use this practice prepare a document signed by the main applicant that assigns a small portion of the rights to invention for that State to the co-applicant

Naming an applicant of convenience in Box No. III

Box No. III FURTHER APPLICANT(S) AND/OR (FURTHER) INVENTOR(S)	
<i>If none of the following sub-boxes is used, this sheet should not be included in the request.</i>	
Name and address: <i>(Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country. The country of the address indicated in this Box is the applicant's State (that is, country) of residence if no State of residence is indicated below.)</i> SMITH, Lawrence 1561 S. Burton Way West Hollywood, California 90048 US	This person is: ☒ applicant only ☐ applicant and inventor ☐ inventor only <i>(If this check-box is marked, do not fill in below.)</i>
Applicant's registration No. with the Office	
State <i>(that is, country)</i> of nationality: US	State <i>(that is, country)</i> of residence: US
This person is applicant for the purposes of: ☐ all designated States ☒ the States indicated in the Supplemental Box	

Specifying the State in the Supplemental Box

Supplemental Box

If the Supplemental Box is not used, this sheet should not be included in the request.

1. *If, in any of the Boxes, except Boxes Nos. VIII(i) to (v) for which a special continuation box is provided, the space is insufficient to furnish all the information: in such case, write "Continuation of Box No." (indicate the number of the Box) and furnish the information in the same manner as required according to the captions of the Box in which the space was insufficient, in particular:*
 - (i) *if more than one person is to be indicated as applicant and/or inventor and no "continuation sheet" is available: in such case, write "Continuation of Box No. III" and indicate for each additional person the same type of information as required in Box No. III. The country of the address indicated in this Box is the applicant's State (that is, country) of residence if no State of residence is indicated below;*
 - (ii) *if, in Box No. II or in any of the sub-boxes of Box No. III, the indication "the States indicated in the Supplemental Box" is checked: in such case, write "Continuation of Box No. II" or "Continuation of Box No. III" or "Continuation of Boxes No. II and No. III" (as the case may be), indicate the name of the applicant(s) involved and, next to (each) such name, the State(s) (and/or, where applicable, ARIPO, Eurasian, European or OAPI patent) for the purposes of which the named person is applicant;*

Continuation of Box No. III,
Smith, Lawrence; Seychelles



Pros & Cons of Using RO/US and RO/IB

Jay Erstling
Patterson Thunte IP
William Mitchell College of Law
erstling@ptslaw.com

Washington or Geneva?

- Fax for IA Filing
 - RO/US: No
 - RO/IB: Yes, with a hard copy filed within 14 days
- Express Mail Provisions
 - RO/US: Yes
 - RO/IB: No, filing date will be actual date of receipt at the RO/IB
- E-Filing
 - RO/US: EFS-Web
 - RO/IB: PCT SAFE or ePCT private services



Washington or Geneva?

■ Filing Discounts

■ RO/US:

- \$111 – where the IA is filed on paper together with a copy in electronic form of the request and abstract in character coded format (that is, prepared using PCT-SAFE in PCT-EASY mode) *
- \$111 – where the IA is filed electronically and the request form is not in character coded format, e.g., in PDF
- \$221 – where the IA is filed electronically and the request form is in character coded format

* This option is scheduled to be phased out by July 2015



Washington or Geneva?

■ Filing Discounts

■ RO/IB:

- \$111 – where the IA is filed on paper together with a copy in electronic form of the request and abstract in character coded format *
- \$221 – where the IA is filed electronically and the request is in character coded format
- \$332 – where the IA is filed electronically and the request, description, claims and abstract are in character-coded format (i.e., in XML format)

* This option is scheduled to be phased out by July 2015



Washington or Geneva?

- Transmittal Fee
 - RO/US: \$240, but:
 - \$120 if filing as a small entity
 - \$60 if filing as a micro-entity
 - RO/IB: \$111
- Non-Electronic Filing Fee
 - RO/US: \$400
 - \$200 if filing as a small entity or micro-entity
 - RO/IB: None



Washington or Geneva?

- Restoration of the Right of Priority
 - RO/US: unintentional criterion only
 - RO/IB: in spite of due care or unintentional criterion
- Fee for Requesting Restoration of the Right of Priority
 - RO/US: \$1,700
 - \$850 if filing as a small entity or micro-entity
 - RO/IB: None
- IF YOU NEED TO RESTORE PRIORITY, THINK RO/IB



Washington or Geneva?

■ Languages Accepted

- RO/US: English
- RO/IB: Any language, but
 - If the language is not accepted by the ISA, the applicant will have to furnish a translation. If the language is not a language of publication, the applicant will have to furnish a translation of the application into one of the languages of publication.

■ ISA Choices

- RO/US: US, EP, KR, AU, RU
 - Israel Patent Office (IL) as of October 1, 2014
- RO/IB: Same as RO/US, but may have additional choices depending on the nationality and residence of the applicants



Washington or Geneva?

- Certified Copies of US Priority Documents
 - RO/US: No fee; documents prepared and furnished to IB by PTO
 - RO/IB: Applicant must request and furnish, but may be able to use WIPO's DAS system for US priority documents
- Foreign Filing License
 - RO/US: RO/US reviews the IA and grants a foreign filing license before the record copy is sent to IB
 - RO/IB: Applicant must obtain a foreign filing license before filing the IA with the RO/IB



Washington or Geneva?

- Processing Time for Initial Review
 - RO/US: 85.8% of applications transmitted to the IB within 4 weeks of filing
 - (Generally 1-2 weeks)
 - RO/IB: 71.1% of applications transmitted to the IB within 4 weeks of filing
 - (Generally 2-4 weeks)
- Time Difference
 - RO/US: Eastern time zone
 - RO/IB: Central European time zone



America Invents Act (AIA) Implications on PCT Practice



Michael Neas

Deputy Director

International Patent Legal Administration



Applicants for U.S. Patent Applications

- Persons qualified to be an applicant has been **expanded** by 35 U.S.C. 118 as amended by the AIA
 - inventors are no longer the only possible applicants
 - applicants may be persons:
 - to whom the inventor has assigned
 - to whom the inventor is under an obligation to assign
 - who otherwise shows sufficient propriety interest in the matter
 - applies to U.S. patent applications filed under 35 U.S.C. 111 or 363 on or after 16 Sep 2012
 - includes applications filed under 35 U.S.C. 371 that originate from an international application having an international filing date on or after 16 Sep 2012



Establishment of Micro Entity

- §10(b) of the AIA
 - authorizes the Director of the USPTO to set or adjust patent fees for micro entities
- §11(g) of the AIA
 - defines micro entity status
 - see page 75033 at:
 - http://www.uspto.gov/aia_implementation/77fr75019.pdf
 - effective 19 March 2013
 - reduction of 75% in most domestic fees for qualifying applicants
 - effective 01 January 2014
 - international fees set by USPTO have small/micro amounts
 - see page 4212 at:
 - <http://www.gpo.gov/fdsys/pkg/FR-2013-01-18/pdf/2013-00819.pdf>



Micro Entity Qualifications

- AIA defines two ways to qualify as micro entity
 - Gross Income Basis
 - Institution of Higher Education Basis



Claiming Micro Entity Status

- A claim for micro entity status requires
 - a certification of entitlement to micro entity status
 - Office forms are available
 - PTO/SB/15A (Gross Income Basis)
 - PTO/SB/15B (Institution of Higher Education Basis)
- A proper certification must be made prior to or with payment of a micro entity fee
- Entitlement to micro entity status must be evaluated when paying any micro entity fee



AIA & International Stage



Applicants for PCT Applications - International Stage (1)

- For international applications with a filing date on/after 16 Sept 2012
 - an applicant for the **purposes of the United States** may be
 - inventor
 - legal representative of deceased or legally incapacitated inventor
 - assignee
 - obligated assignee
 - person who otherwise shows proprietary interest
 - proof of proprietary interest will be required in the national stage
- **Example:** Inventor X assigns all rights in the invention to Assignee Y. Assignee Y may be indicated on the PCT Request form (Box II) as an applicant for “**all designated States**” and Inventor X indicated (in Box III) as “**inventor only**”



Applicants for PCT Applications - International Stage (2)

- Change to 35 U.S.C. 118 allowed the PCT Request Form to be simplified

Box No. I TITLE OF INVENTION	
PROCESS FOR FOLDING WRAPPING PAPER FOR CHOCOLATES	
Box No. II APPLICANT ☐ This person is also inventor	
Name and address: <i>(Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country. The country of the address indicated in this Box is the applicant's State (that is, country) of residence if no State of residence is indicated below.)</i>	
CANDY WRAP UNLIMITED, INC. 300 Colorado Street Baltimore, Maryland 21201-4307 United States of America	
Telephone No. (+1-301) 876-5432	Facsimile No. (+1-301) 876-5555
Applicant's registration No. with the Office	
E-mail authorization: Marking one of the check-boxes below authorizes the receiving Office, the International Searching Authority, the International Bureau and the International Preliminary Examining Authority to use the e-mail address indicated in this Box to send, notifications issued in respect of this international application to that e-mail address if those offices are willing to do so. ☐ as advance copies followed by paper notifications; or ☒ exclusively in electronic form (no paper notifications will be sent). E-mail address: candy@anumma.com	
State (that is, country) of nationality: US	State (that is, country) of residence: US
This person is applicant for the purposes of: ☒ all designated States ☐ the States indicated in the Supplemental Box	



Applicants for PCT Applications - International Stage (3)

Sheet No. ... 2 ...	
Box No. III FURTHER APPLICANT(S) AND/OR (FURTHER) INVENTOR(S)	
<i>If none of the following sub-boxes is used, this sheet should not be included in the request.</i>	
Name and address: <i>(Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country. The country of the address indicated in this Box is the applicant's State (that is, country) of residence if no State of residence is indicated below.)</i> JONES, Mary 1600 South Eads Street Arlington, Virginia 22202-2913 United States of America	This person is: ☐ applicant only ☐ applicant and inventor ☒ inventor only <i>(If this check-box is marked, do not fill in below.)</i> Applicant's registration No. with the Office
State <i>(that is, country)</i> of nationality:	State <i>(that is, country)</i> of residence:
This person is applicant for the purposes of: ☐ all designated States ☐ the States indicated in the Supplemental Box	
Name and address: <i>(Family name followed by given name; for a legal entity, full official designation)</i>	This person is:



Important Practice Tips

- If naming a non-inventor applicant as applicant for “all designated States”
 - review residence and nationality of the applicant(s) because residence/nationality of the applicant(s), not the inventor(s), is used to determine
 - the competence of the receiving office (RO/US)
 - whether a U.S. practitioner may be appointed to represent the applicant
 - whether an applicant is entitled to file international application under the PCT



International Stage Fees (1)

(Effective 01 Jan 2014)

International Application Fees (Chapter I)

DESCRIPTION	Regular	Small entity	Micro entity	Fee Code
Transmittal Fee	\$ 240	\$ 120*	\$ 60	1601/2601/3601
Fee for Transmitting IA to the International Bureau to Act as Receiving Office	\$ 240	\$ 120	\$ 60	1621/2621/3621
United States Patent and Trademark Office (USPTO) as International Searching Authority (ISA)	\$ 2080	\$ 1040**	\$ 520	1602/2602/3602
Supplemental search fee, per additional invention (payable only upon invitation)	\$ 2080	\$ 1040	\$ 520	1604/2604/3604
Non-electronic filing fee (additional fee for applications filed in paper)	\$ 400	\$ 200	\$ 200	1609/2690

* Payment in the small entity amount is treated as a written assertion of small entity status.

** Payment in the small entity amount is treated as a written assertion of small entity status only when filing in an RO other than US.

See 37 CFR 1.27(c)(3).



International Stage Fees (2)

(Effective 01 Jan 2014)

International Application Fees (Chapter II, optional)

DESCRIPTION	Regular	Small entity	Micro entity	Fee Code
USPTO as International Preliminary Examining Authority (IPEA) where USPTO was ISA	\$ 600	\$ 300	\$ 150	1605/2605/3605
USPTO as International Preliminary Examining Authority (IPEA) where USPTO was not ISA	\$ 760	\$ 380	\$ 190	1606/2606/3606
Additional examination fee, per additional invention (payable only upon invitation)	\$ 600	\$ 300	\$ 150	1607/2607/3607



AIA & U. S. National Stage



Inventorship in 35 U.S.C. 371 National Stage Applications (1)

- Inventorship in a §371 application of IA having an **international filing date** (IFD) on or after 16 Sep 2012 (37 CFR 1.41(e))
 - if a signed ADS is included with the initial §371 submission, inventorship will be as indicated on the ADS
 - otherwise, inventorship will be that set forth in the international stage
 - including any change effected under PCT Rule 92*bis*
 - a Rule 4.17(iv) declaration from a PCT Request dated prior to 16 September 2012 is not acceptable



Inventorship in 35 U.S.C. 371 National Stage Applications (2)

- Correction of inventorship and/or an inventor's name
 - has been simplified under 37 CFR 1.48
 - 37 CFR 1.497(d) does not apply to §371 applications having an IFD on or after 16 Sep 2012
 - request under §1.48 need only include
 - an ADS, or amended ADS, and
 - a processing fee in the amount of \$130 (37 CFR 1.17(i))
 - an inventor's oath or declaration will be required for each actual inventor who has not yet executed one



Applicants for 35 U.S.C. 371 National Stage Applications (1)

- Applicants for 35 U.S.C. 371 applications of IA having an **international filing date** on or after 16 Sept 2012
 - will be those applicants identified in the international stage for the United States
 - unless changed in the national stage (37 CFR 1.46(b))
 - for a person who otherwise shows sufficient proprietary interest in the matter, the applicant must submit a petition including
 - the fee set forth in 37 CFR 1.17(g) (\$200)
 - a showing that such person has sufficient proprietary interest and
 - a statement that making the application is appropriate to preserve the rights of the parties (37 CFR 1.46(b)(2))



Applicants for 35 U.S.C. 371 National Stage Applications (2)

- Once an applicant has been specified, under 37 CFR 1.46(c)
 - any request to correct or update the name of an applicant must
 - include an ADS, or amended ADS, specifying the corrected or updated name in the applicant information section (37 CFR 1.76(b)(7))
 - any request to change the applicant must
 - include an ADS specifying the applicant in the applicant information section (§1.76(b)(7)), and
 - comply with 37 CFR 3.71 and 3.73



Inventor's Oath or Declaration (1)

- 35 U.S.C. 115 as amended by the AIA
 - still requires that the inventors execute an oath or declaration
 - except as otherwise provided
 - changes the required statements
 - now requires statements that
 - the application was made by or authorized to be made by the affiant or declarant
 - the individual believes himself or herself to be the original inventor or an original joint inventor of a claimed invention
 - no longer requires the following statements
 - citizenship
 - the inventor believes himself or herself to be the “first” inventor of the subject matter
 - “duty to disclose”
 - “reviewed and understands”
 - “true or believed to be true”
 - inventor's oath or declaration forms for national stage applications originating from a PCT international application filed on or after 16 Sept 2012 are available at: http://www.uspto.gov/forms/aia_forms.jsp



Inventor's Oath or Declaration (2)

- Substitute statements (37 CFR 1.64)
 - can be submitted where the inventor is
 - deceased, legally incapacitated, cannot be found or reached after diligent effort, or refuses to execute
 - divergent from old 37 CFR 1.42, §1.43, and §1.47 practice
 - no petition is required to execute the substitute statement
 - PTO/AIA/02 may be used for this purpose



Inventor's Oath or Declaration (3)

- Combined assignment-statement
 - an assignment may include statements required in an oath/dec
 - no PTO form has been provided for this purpose
 - no surcharge will be assessed for the declaration where
 - an application is filed via EFS-Web, and
 - the assignment-statement is filed via the EPAS system on the same day
 - recording the assignment against application number received in EFS-Web
 - for proper recordation of the assignment-statement
 - application number must be on the EPAS cover sheet
 - not the executed assignment-statement
 - the assignment-statement must identify the application in some way
 - e.g. name of inventors, attorney docket number on the SPEC as filed, title of the invention on the SPEC as filed



Important Practice Tips (1)

- Include a signed ADS with the initial §371 submission
 - if inventorship has changed and
 - to express domestic benefit claims if not in Request or IA publication
- Applicability of the AIA is
 - determined by the international filing date
 - **NOT** the date the 371 submission is filed



Important Practice Tips (2)

- For IAs filed before 16 Sept 2012
 - consider filing a bypass continuation if
 - status under 37 CFR 1.42 is needed
 - the inventor is deceased and
 - there are complications identifying the legal representative or obtaining their signature
 - status under 37 CFR 1.47 is needed
 - an inventor refuses to sign or
 - cannot be located after diligent effort
 - substitute statement practice is available in an application filed under 35 U.S.C. 111(a) on or after 16 Sept 2012
 - assignee or joint inventors may execute a substitute statement



Questions?

Tab 4B

AIA strategies for PCT filers

Figuring out whether to "check the box"

Carl Oppedahl
Oppedahl Patent Law Firm LLC
www.oppedahl.com

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Statement under 37 CFR 1.55 or 1.78 for AIA (First Inventor to File) Transition Applications

☐ This application (1) claims priority to or the benefit of an application filed before March 16, 2013 and (2) also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

Should you check the box?

How do you know whether or not to “check the box”?

- That is not the question!
- The question is, how may I proceed in such a way that years from now in litigation, the infringer will be unable to claim that I got it wrong
- It is in the best interests of the client if I proceed in such a way that years from now in litigation, the infringer will be unable to claim that I got it wrong

How do you know whether or not to “check the box”?

- The related question is, how may I proceed in such a way that years from now, the client will be unable to claim that I got it wrong
- It is in my own best interest to minimize the risk that the client will be able to claim that I got it wrong

“old” versus “new” section 102

- The question whether a particular patent application is better off under “old” 102 or “new” 102 is extremely fact-dependent and extremely fact-specific
- It is impossible to state in any general way that all patent applications are better off under one of the 102's or the other of the 102's
- But recall that many patent practitioners pulled all-nighters in the weeks leading up to March 16, wanting to preserve the ability to get “old” 102 if desired

A one-way door

- If you have an application that is subject to the “new” 102, it is impossible to change it so that the “old” 102 applies instead of the “new” 102
- On the other hand, if you have an application that is subject to the “old” 102, you can effortlessly change it so that the “new” 102 applies instead of the “old” 102
- Note that it is the ***entire application***, not any particular claim, that is subject to one 102 or the other

How does the Examiner know which 102 applies to a particular application?

- It's very simple
- The Examiner looks at a field on a screen in Palm (PAIR)

Patent Application Information Retrieval

[Order Certified Application As Filed](#) [Order Certified File Wrapper](#) [View Order List](#)

10/xxx,xxx **WIDGET** **34977**

Select New Case Application Data Transaction History Image File Wrapper Patent Term Adjustments Continuity Data Foreign Priority Fees Published Documents Address & Attorney/Agent Display References

Bibliographic Data

Application Number:	10/xxx,xxx	Customer Number:	-
Filing or 371 (c) Date:	03-17-2003	Status:	Patented Case
Application Type:	Utility	Status Date:	01-25-2006
Examiner Name:	Examiner, Pat N.	Location:	ELECTRONIC
Group Art Unit:	2500	Location Date:	-
Confirmation Number:	5711	Earliest Publication No:	US 2004-xxxxxxx A1
Attorney Docket Number:	34977	Earliest Publication Date:	01-15-2004
Class / Subclass:	134/058.00D	Patent Number:	6,xxx,xxx
First Named Inventor:	Doe, John	Issue Date of Patent:	02-14-2006
Entity Status:	Micro	AIA (First Inventor to File):	No

Title of Invention: WIDGET

Yes' if FITF; 'No' if not FITF; '-' (hyphen) if not ready for examination

Contains, or ever contained ...

- There are two very easy fact patterns
 - Easy case #1 – Application was filed prior to March 16, 2013
 - Easy case #2 – Application was filed on or after March 16, 2013 and has no priority or domestic benefit claim to a date prior to March 16, 2013

In either of these fact patterns it is clear and unambiguous as to whether the application contains or ever contained a claim with an effective filing date on or after March 16, 2013

- It is clear now and it will be clear in litigation

Now the difficult case

- The difficult case is an application filed on or after March 16, 2013 ... that claims priority or domestic benefit to an application filed before March 16, 2013
- USPTO calls this a “transition application”
- In such a case, the USPTO wants the Examiner to follow some simple mechanical rule
- The simple mechanical rule for the Examiner is to look at that field in Palm (PAIR)
- Which in turn is based on whether you “checked the box”

New matter in a case filed on or after March 16, 2013

- Suppose you file a CIP (meaning it contains new matter as compared to the priority application or domestic benefit parent)
- For example a US national phase from a PCT/CIP
- Does this mean you need to check the box?
- No!
- You need to check the box only if a claim *claims* some of that new matter (or if a claim once claimed some of that new matter)

Best practices

- PCT application filed before March 16, 2013
- Now you are entering the US national stage
- You are on safe ground if you did not check the box
- It is safe ground regardless of what amendments you may make whilst entering the US national phase

Best practices

- PCT application filed before March 16, 2013
- Now you are filing a bypass continuation instead of entering the US national stage
- Best practice is to file an ***exact copy*** of the PCT application as your bypass continuation
- Then wait at least one day, and only then file a preliminary amendment with your changes
- If the Examiner later decides the amendment contains new matter, then you will cancel the new matter and you will be under the old 102

Difficult fact patterns

- Provisional application or priority application filed before March 16, 2013
- PCT is filed on or after March 16, 2013
- You are pretty sure that all claims are fully supported by the provisional
- Now you are getting ready to enter US national phase, or file a bypass continuation
- Can you confidently not check the box?
- Is there anything you can do to reduce the risks?

A scenario from the PCT listserv

- Provisional or foreign priority filed before March 16, 2013
- PCT filed on or after March 16, 2013 which contains or contained at least one claim having an effective filing date on or after March 16, 2013 (meaning the claim was not supported in the provisional or foreign priority)
- Can you enter national phase, presenting only claims supported by the provisional, and not check the box?
- Answer: no

A scenario from the listserv

- Provisional or priority filed before March 16, 2013
- PCT filed on or after March 16, 2013 which contains or contained at least one claim having an effective filing date on or after March 16, 2013 (meaning the claim was not supported in the provisional or priority)
- Can you file a bypass continuation, presenting only claims supported by the provisional, and not check the box?
- Answer: no

Scenario from the listserv

- PCT application filed prior to March 16, 2013. US national phase is entered.
- No need to have checked the box or to have avoided checking the box, because no statement was needed one way or the other
- Old 102 applies
- Now we are filing an amendment
- Suppose the Examiner ***refuses to enter it*** saying it's new matter. Will we now be subject to the new 102?
- Answer: no. If the Examiner refuses to enter it, then it was never in the application. Old 102 still applies.

When September 16, 2015 arrives ...

Priority application filed on or after March 16,
2013

30 months is September 16, 2015

National phase filed on or after September 16,
2015 will not require any decision as to whether or
not to check the box

But even after September 16, 2015 ...

You have a pending case that is a national phase
of a PCT filed before March 16, 2013 ...

Maybe long after September 16, 2015, the need
arises to file a continuation or divisional ...

You will still need to worry about whether or not to
“check the box”

But even after September 16, 2015 ...

You have a pending case that is a national phase of a PCT filed on or after March 16, 2013, that claims priority from an application filed before March 16, 2013 ...

Maybe long after September 16, 2015, the need arises to file a continuation or divisional ...

You will still need to worry about whether or not to “check the box”

Trap for the unwary

- US continuation or divisional or bypass is being filed now
- Parent was filed prior to March 16, 2013
- The trap for the unwary is to file the preliminary amendment ***on the same day*** as the continuation or divisional
- Years from now the infringer will claim that the PA contained new matter, and that the case was thus really a CIP, and thus the new 102 applies
- It would have been smarter to delay the PA by at least one day

Signature Requirements, Agents, Common Representatives, Withdrawals, Recording Changes and Provisional Protection

Carol Bidwell
July 2014

Signature of the international application (Rules 4.15, 26.2bis(a))

- In principle, the request must be signed by all persons (legal entity or natural persons) indicated as “applicant” and “applicant and inventor”
 - ❑ a person named on the request as “inventor only” does not need to sign the request
 - ❑ so long as the request is signed by one of the applicants, the lack of signature of the other applicants will not be considered a defect
- If the request is only signed by an agent, a separate power of attorney signed by all applicants must be filed (either an original power of attorney or copy of a general power of attorney) unless the receiving Office has waived the requirement

Signing on behalf of legal entities

- The RO/US accepts the signature of an authorized officer of a legal entity, for example, President, Vice President, Secretary, Treasurer, etc., as someone having the apparent authority to sign the request
- The RO/US also allows someone without apparent authority to make a self-certifying statement as to their entitlement to sign the request on behalf of the legal entity
 - ☐ see MPEP Section 1820 for additional information
- A legal representative may sign the request
 - ☐ if the applicant is a natural person who is deceased or legally incapacitated
 - ☐ if the applicant is a bankrupt company

Waiver of power of attorney requirement (Rules 90.4(d) and 90.5(c))

- An RO, ISA, IPEA and the IB may waive the requirement that
 - ☐ a separate power of attorney and/or
 - ☐ a copy of a general power of attorneymust be furnished
- All Offices and Authorities may nevertheless require that a power of attorney has to be furnished in particular instances even if it has waived the requirement in general
- Information as to whether an Office or Authority has made such a waiver is available on the WIPO Internet site

Agents and common representatives

■ Who can act as agent?

- ☐ any person (attorney, patent agent, etc.) who has the right to practice before the RO can act as agent and automatically has the right to practice before the IB, ISA and IPEA
- ☐ an agent who has the right to practice before the ISA and/or IPEA can be appointed specifically for the purposes of the procedure before the IB, ISA or IPEA
- ☐ agents may appoint sub-agents

■ Who can act as common representative?

- ☐ one of the applicants who is entitled to file an international application (that is, who is a resident or national of a PCT Contracting State) may be appointed by all the other applicants to act on the application

Withdrawals under Chapter I and Chapter II

Chapter I – international application, designations, priority claim

Chapter II – in addition to those listed above, the demand and elections

When – before the expiration of 30 months from the priority date

How – by a notice of withdrawal (PCT/IB/372 recommended) signed by all applicants, their agent or appointed common representative, and filed with the RO or IB; withdrawal of demand or election filed with IB

Effect – withdrawal effective upon receipt by the appropriate Authority

- withdrawal has no effect in DOs/EOs where national processing or examination has already started
- withdrawal of international application or designations:
 - effect ceases in each DO/EO concerned, with same consequences as withdrawal of a national application in that State
 - if notice of withdrawal received by the IB before completion of technical preparations for international publication, there will be no international publication (withdrawal can be made conditional on receipt in time to prevent publication)
- withdrawal of priority claim: time limits which have not expired are re-computed on the basis of the revised priority date resulting from the withdrawal

Uses of Rule 92*bis* to record various changes

- Change of the name of the applicant
- Change of the address: applicant, agent, inventor
- Change of the nationality or residence of the applicant
- Addition or removal of an applicant/inventor
- Death of an applicant/inventor
- Change of the agent

Request for recording a change under Rule 92bis

- The request must be made in writing
- It may be filed with the IB or the RO
- Generally no evidence of the change is required during the international phase; the designated Offices may, however, require that evidence (for example, assignment) be submitted once the national phase has been entered
- The IB will notify the applicant (using Form PCT/IB/306) that the requested change has been recorded
- The request must reach the International Bureau before the expiration of 30 months from the priority date
Recommendation: use ePCT to file it directly with the International Bureau to ensure that the change is recorded before 30 months
- The IB will record a change affecting multiple pending international applications with a single written request

Request for recording a change under Rule 92bis (cont'd)

- If the request reaches the IB after the expiration of 30 months, the change will not be recorded and the applicant will have to proceed with such request before each designated or elected Office concerned
- If the applicant wishes that a particular change be taken into account for the international publication of the international application, the request for recording of that change must reach the IB before the completion of technical preparations for international publication (normally, 15 days before the actual date of publication)
- If the request for recording of a change reaches the IB too late to be reflected in the international publication, the IB will notify all designated or elected Offices concerned

Recording of a change in the person of the applicant under Rule 92*bis*

- Where the request for recording the change is made by a person not yet named in the PCT Request form (“the new applicant”) without the written consent of the (“old”) applicant, the International Bureau will require that a copy of an assignment or other documentary evidence supporting the change in person be filed with the request for the change
- Where such request is made by an agent of the new applicant, a power of attorney signed by the new applicant must be furnished at the same time
- Where such request is made by the agent of record, the new applicant should sign a power of attorney appointing the agent

Provisional protection

- International publication entitles applicants to provisional protection in the designated States, if such protection is granted for published national applications
 - such protection may be made conditional
 - on the furnishing of a translation (which may be of the claims only)
 - on receipt by the designated Office of a copy of the international application as published under the PCT, and/or
 - in the case of early publication under Article 21(2)(b), on the expiration of 18 months from the priority date
 - for further information on the specific requirements of a given Office, see the *PCT Applicant's Guide*, International Phase, General Information (Annexes B1/B2)

Patent Prosecution Highway (PPH)



Michael Neas
Deputy Director
International Patent Legal Administration



Types of PPH Agreements

- IP5
 - Paris & PCT
- Global
 - Paris & PCT
- Bilateral Agreements
 - Paris or PCT



Global/IP5 PPH Countries



Australia (IPAU)



Canada (CIPO)



Denmark (DKPTO)



European Patent Office (EPO)



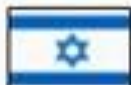
Finland (NBPR)



Hungary (HPO)



Iceland (IPO)



Israel (ILPO)



Japan (JPO)



Korea (KIPO)



Nordic Patent Institute (NPI)



Norway (NIPO)



People's Republic of China (SIPO)



Portugal (INPI)



Russia (ROSPATENT)



Spain (SPTO)



Sweden (PRV)



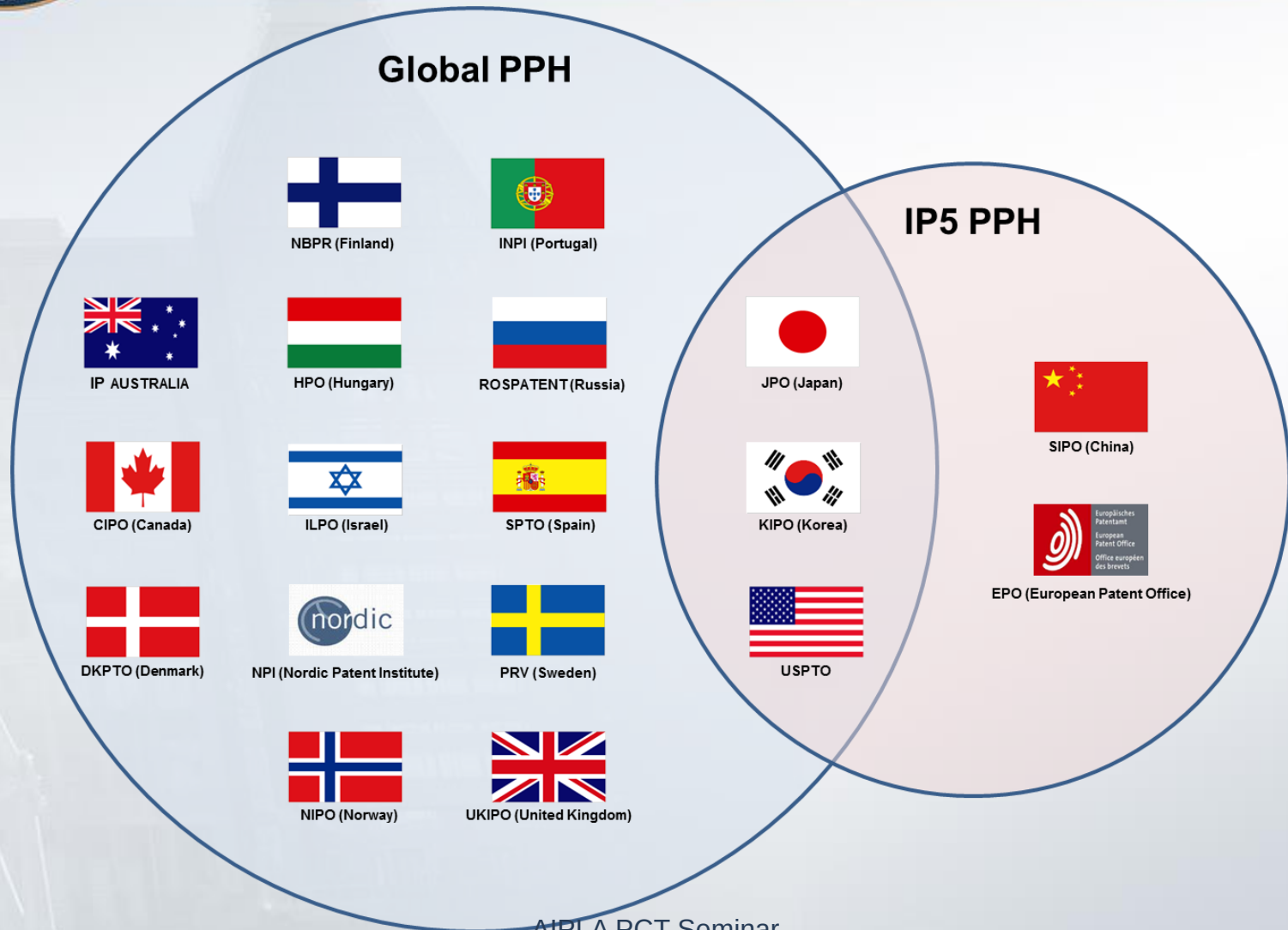
United Kingdom (UKIPO)



United States (USPTO)



Global PPH and IP5 PPH





Bilateral PPH Agreements

- Paris
 - Austria
 - Colombia
 - Czech Republic
 - Germany
 - Mexico
 - Nicaragua
 - Philippines
 - Singapore
 - Taiwan
- PCT
 - Austria



How Do I Submit a PPH Request?

- All claims in each U.S. application must sufficiently correspond to the allowable claims in the application in the OFF.
- Refer to the PPH Web site for the request form and more information.
- e-File the Request/Petition to Make Special Form and the supporting documents via EFS-Web.



PPH Web Site for Global / IP5 PPH and Other PPH Forms

- PPH Web site for the request form and more information

www.uspto.gov/web/patents/pph/index.html

uspto.GOV
The United States Patent and Trademark Office
an agency of the Department of Commerce

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Announcements

Patent Prosecution Highway (PPH) - Fast Track Examination of Applications

The Patent Prosecution Highway (PPH) speeds up the examination process for corresponding applications filed in participating intellectual property offices.

Under PPH, participating patent offices have agreed that when an applicant receives a final ruling from a first patent office that at least one claim is allowed, the applicant may request fast track examination of corresponding claim(s) in a corresponding patent application that is pending in a second patent office. PPH leverages fast-track examination procedures already in place among participating patent offices to allow applicants to reach final disposition of a patent application more quickly and efficiently than standard examination processing.

There is no fee under the PPH programs. For further information, please see this [Federal Register notice](#).

For more information on the PPH in general, please see these PPH resources:

- [Form for the Global PPH and IP5 PPH pilot programs](#)
- [Other Countries Request Forms](#)

PPH PATENT PROSECUTION HIGHWAY
Fast Track Examination of Applications



Example of Global / IP5 PPH Form (1)

- Application Number and Filing Date
- First Named Inventor
- Attorney Docket Number and Title of the Invention
- **Office of earlier examination (OEE)***
- OEE application number
- Both the OEE application and identified U.S. application have the earliest filing or priority date
- **Type of OEE work product relied upon***
- Mailing date of OEE work product

* **Drop down for selection**



Doc Code: PPH.PET.652

Document Description: Petition to make special under Patent Pros Hwy

PTO/SB/20GLBL (01-14)

Approved for use through 01/31/2015. OMB 0651-0058

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REQUEST FOR PARTICIPATION IN THE GLOBAL/IP5 PATENT PROSECUTION HIGHWAY (PPH) PILOT PROGRAM IN THE USPTO			
Application No.:		First Named Inventor:	
Filing Date:		Attorney Docket No.:	
Title of the Invention:			
THIS REQUEST FOR PARTICIPATION IN THE PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT HTTP://WWW.USPTO.GOV/PATENTS/PROCESS/FILE/efs/ .			
APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PATENT PROSECUTION HIGHWAY (PPH) PILOT PROGRAM AND PETITIONS TO MAKE THE ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PPH PILOT PROGRAM.			
Office of earlier examination (OEE):			
OEE application number: _____			
Both the OEE application and the above-identified U.S. application have the following earliest date (filing or priority date): _____			
Type of OEE work product relied upon:			
Mailing date of OEE work product: _____			
I. Required Documents:			
a. A copy of the most recent office action prior to the decision to grant a patent or the most recent PCT work product (along with an English translation, if not in the English language):			
☐ is attached.			
☐ is already present in the U.S. application.			
☐ is not attached because it is available to the USPTO via the Dossier Access System or WIPO's PATENTSCOPE system.			
☐ is not attached because the decision to grant a patent was the first office action.			
b. (1) An information disclosure statement listing the documents cited in the OEE work product:			
☐ is attached.			
☐ has already been filed in the U.S. application.			
☐ is not attached because no references were cited in the document in section a. above.			
(2) Copies of all cited documents (except for U.S. patents or U.S. patent application publications)			
☐ are attached.			
☐ have already been filed in the U.S. application.			
☐ are not attached because no references were cited in the document in section a. above.			

[Page 1 of 2]

This collection of information is required by 35 U.S.C. 119, 37 CFR 1.55, and 37 CFR 1.102(d). The information is required to obtain or retain a benefit by the public, which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS.



Example of Global / IP5 PPH Form (2)

Doc Code: PPH.PET.652

Document Description: Petition to make special under Patent Pros Hwy

PTO/SB/20GLBL (01-14)

Approved for use through 01/31/2015. OMB 0651-0058

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REQUEST FOR PARTICIPATION IN THE GLOBAL/IP5 PATENT PROSECUTION HIGHWAY (PPH) PILOT PROGRAM IN THE USPTO			
Application No.:		First Named Inventor:	
Filing Date:		Attorney Docket No.:	
Title of the Invention:			
THIS REQUEST FOR PARTICIPATION IN THE PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT HTTP://WWW.USPTO.GOV/PATENTS/PROCESS/FILE/EFS/ .			
APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PATENT PROSECUTION HIGHWAY (PPH) PILOT PROGRAM AND PETITIONS TO MAKE THE ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PPH PILOT PROGRAM.			
Office of earlier examination (OEE):			
OEE application number:			
Both the OEE application and the a	Australia (IP Australia) Canada (Canadian Intellectual Property Office) P.R. China (State Intellectual Property Office of the People's Republic of China) Denmark (Danish Patent and Trademark Office) European Patent Office Finland (National Board of Patents and Registration of Finland) Hungary (Hungarian Intellectual Property Office) Iceland (Icelandic Patent Office) Israel (Israeli Patent Office)		
the following earliest date (filing or			
Type of OEE work product relied up			
Mailing date of OEE work product:			
I. Required Documents:			



Example of Global / IP5 PPH Form (3)

Doc Code: PPH.PET.652

Document Description: Petition to make special under Patent Pros Hwy

PTO/SB/20GLBL (01-14)

Approved for use through 01/31/2015. OMB 0651-0058

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REQUEST FOR PARTICIPATION IN THE GLOBAL/IP5 PATENT PROSECUTION HIGHWAY (PPH) PILOT PROGRAM IN THE USPTO			
Application No.:		First Named Inventor:	
Filing Date:		Attorney Docket No.:	
Title of the Invention:			
THIS REQUEST FOR PARTICIPATION IN THE PPH PILOT PROGRAM ALONG WITH THE REQUIRED DOCUMENTS MUST BE SUBMITTED VIA EFS-WEB. INFORMATION REGARDING EFS-WEB IS AVAILABLE AT HTTP://WWW.USPTO.GOV/PATENTS/PROCESS/FILE/EFS/ .			
APPLICANT HEREBY REQUESTS PARTICIPATION IN THE PATENT PROSECUTION HIGHWAY (PPH) PILOT PROGRAM AND PETITIONS TO MAKE THE ABOVE-IDENTIFIED APPLICATION SPECIAL UNDER THE PPH PILOT PROGRAM.			
Office of earlier examination (OEE):			
OEE application number:			
Both the OEE application and the above-identified U.S. application have the following earliest date (filing or priority date):			
Type of OEE work product relied upon:			
Mailing date of OEE work product:			
I. Required Documents:		Decision to grant a patent	
a. A copy of the most recent of work product (along with an		Notice of refusal to grant a patent (where such notice indicates allowable claims)	
		Written Opinion of the International Searching Authority (WO/ISA)	
		Written Opinion of the International Preliminary Examining Authority (WO/IPEA)	
		International Preliminary Examination Report (IPER)	



Global / IP5 PPH Form Requirements (1)

I. Required Documents:

- a) A copy of the most recent office action prior to the decision to grant a patent or the most recent PCT work product (along with an English translation)
- b) An information disclosure statement listing the documents cited in the OEE work product
- c) Copies of all cited documents (except for U.S. patents or U.S. patent application publications)

II. Claims Correspondence Table

III. All the claims in the U.S. application sufficiently correspond to the patentable/allowable claims in the OEE application





Other PPH Request Forms (1)

- In addition to the Global PPH and IP5 PPH pilot programs, the USPTO has PPH agreements with the following Intellectual Property Offices around the world
- These offices are not yet included in the Global PPH, so applicants must use the special forms noted in the table



Other PPH Request Forms (2)

	PPH between USPTO and Austria	↔	Request Form (SB/20AT) [PDF]
	PCT-PPH between USPTO and Austria	↔	Request Form (SB/20PCT-AT) [PDF]
	PPH between USPTO and Colombia		Request Form (SB/20CO) [PDF]
	PPH between USPTO and Czech Republic		Request Form (SB/20CZ) [PDF]
	PPH between USPTO and Germany		Request Form (SB/20DE) [PDF]
	PPH between USPTO and Mexico		Request Form (SB/20MX) [PDF]
	PPH between USPTO and Nicaragua		Request Form (SB/20NI) [PDF]
	PPH between USPTO and Philippines		Request Form (SB/20PH) [PDF]
	PPH between USPTO and Singapore		Request Form (SB/20SG) [PDF]
	PPH between USPTO and Taiwan Intellectual Property Office		Request Form (SB/20TW) [PDF]

- For more information, requirements and the request form for each of the PPH programs, click at the links provided
- Paris-Route PPH Form
- PCT-PPH Form

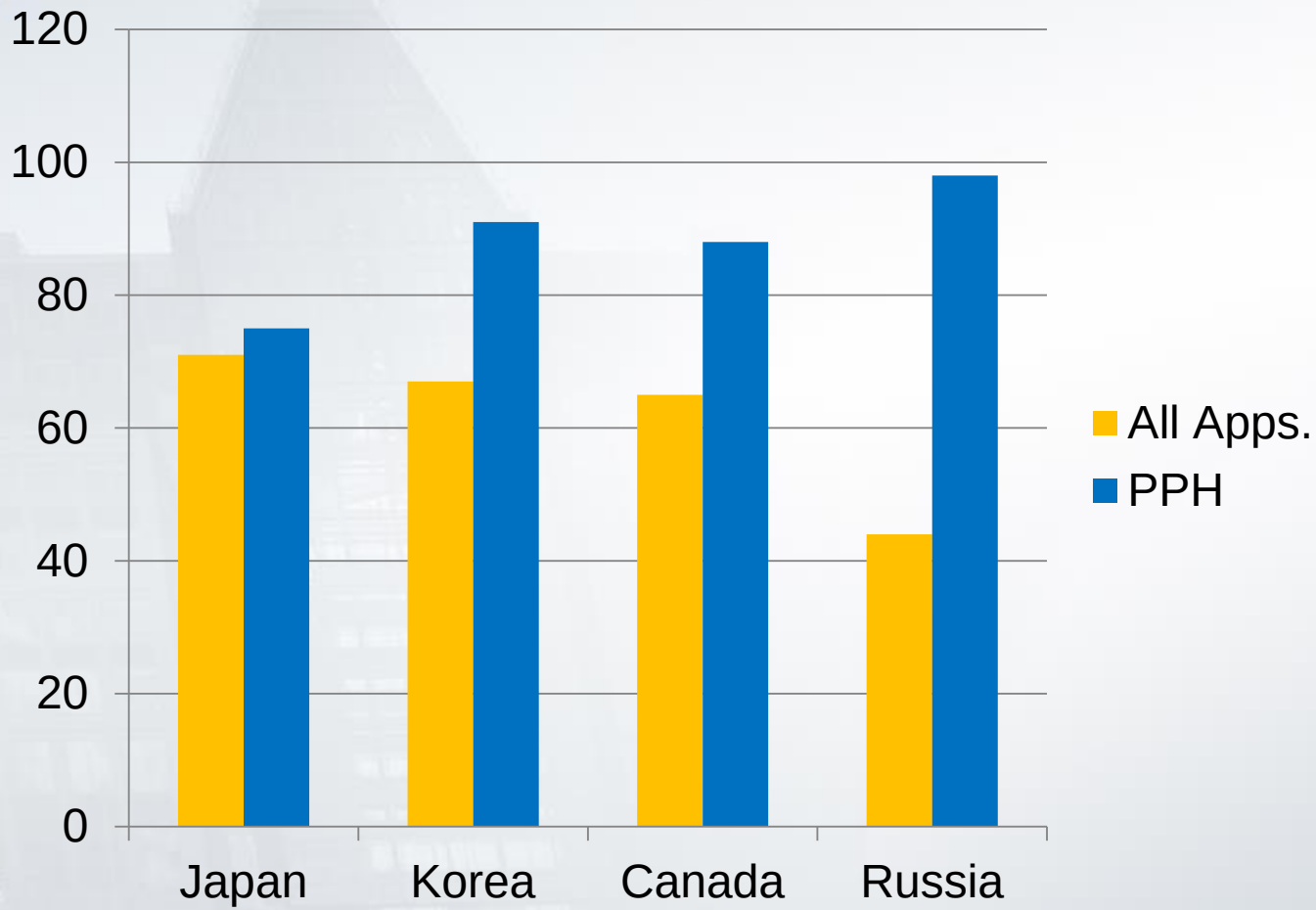


[Page 1 of 2]

[Page 2 of 2]



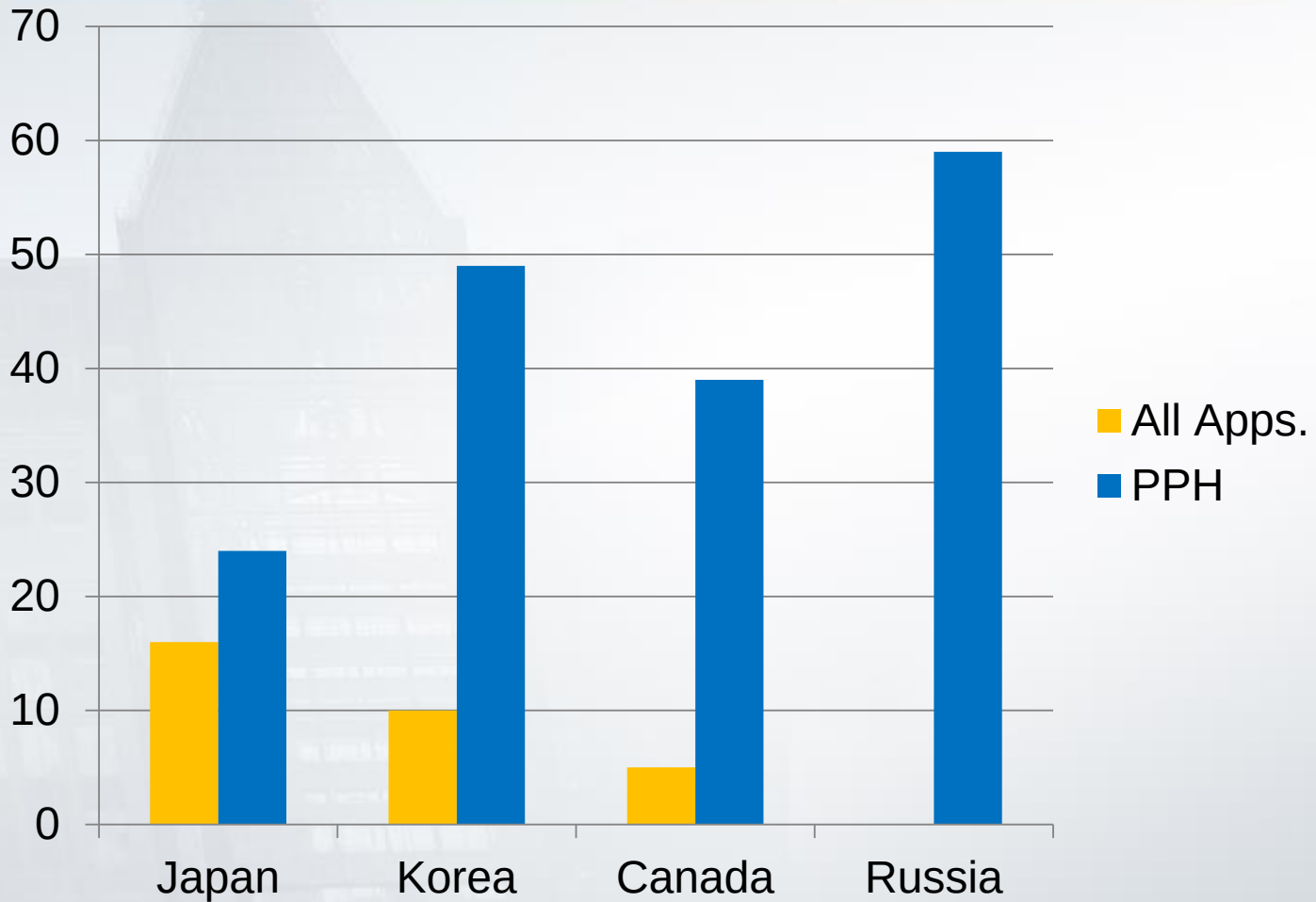
Foreign PPH Grant Rates



<http://www.jpo.go.jp/ppph-portal/statistics.htm>



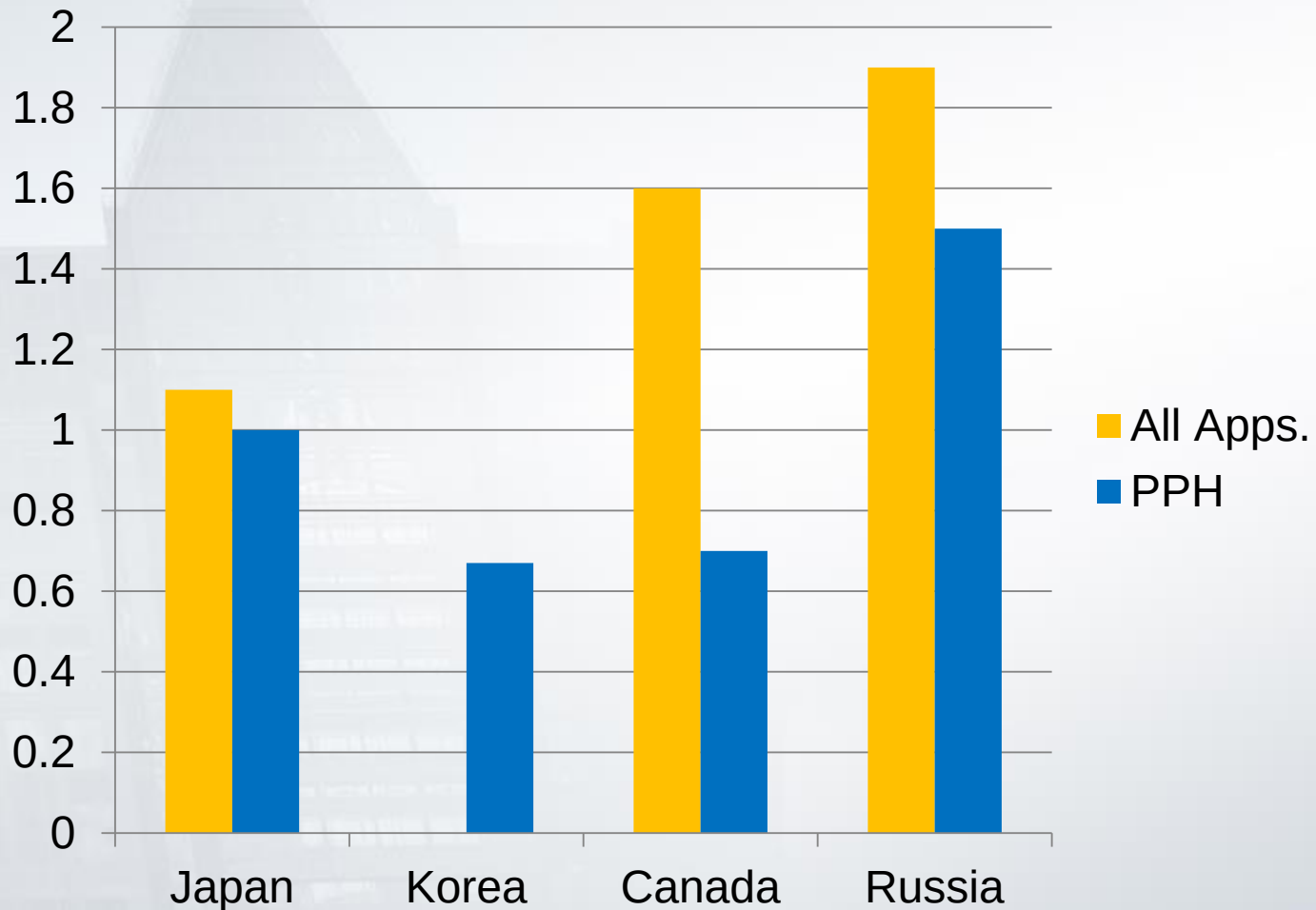
First Action Allowance Rates



<http://www.jpo.go.jp/ppph-portal/statistics.htm>



Average Number of Office Actions



<http://www.jpo.go.jp/ppph-portal/statistics.htm>



PPH Statistics – IP5 Offices

New Applications with PPH requests among the IP5 offices (as of December 2013)

	Office of Later Examination						
Office of Earlier Examination		EPO	JPO	KIPO	SIPO	USPTO	Total
	EPO	---	1,004	---	---	3,221	4,225
	JPO	2,148	2,486	3,308	3,477	10,304	21,453
	KIPO	---	344	117	503	4,341	5,305
	SIPO	---	82	25	---	713	820
	USPTO	1,097	2,931	1,347	1,560	420	7,355
	Total	3,245	6,847	4,527	5,540	18,999	39,158



Terminal Disposal Comparison between PPH and non-PPH Prosecution – FY 2013

USPTO	Percent of Applications with at least one RCE	Examination Actions per Application Disposal	Overall Allowance Rate	First Action Allowance Rate
Non PPH Applications	25%	3	66.3%	12.6%
PPH Applications	12%	2.2	83%	36.8%

Actions include restrictions, non-final rejection, final rejection, ex parte Quayle, allowance, Interference, SIR disposal, Rule 105 requirement, examiner's answer, advisory action, miscellaneous action with SSP, first action interview actions, examiner initiated suspension and abandonment after PTAB decision



PPH Cost Savings Estimate

Savings due to reduced number of actions

- **Reply/amendment of minimal complexity**

Average Cost per response to Action = \$2,086

(Source: AIPLA Report of the Economic Survey, 2011*)

For each non-PPH application: $(\$2,086/\text{response} \times 3.0 \text{ actions}) = \$6,258$

For each PPH application: $(\$2,086 \times 2.18 \text{ actions}) = \$4,547 \rightarrow$ **\$1,711 SAVINGS**

- **Relatively complex reply/amendment**

Average Cost per response to Action = \$3,434

(Source: AIPLA Report of the Economic Survey, 2011*)

For each non-PPH application: $(\$3,434/\text{response} \times 3.0 \text{ actions}) = \$10,302$

For each PPH application: $(\$3,434 \times 2.18 \text{ actions}) = \$7,486 \rightarrow$ **\$2,816 SAVINGS**

* Estimates are based on 2011 figures. Cost savings in 2014 are expected to be greater.

(Estimate of cost savings data provided by the AIPLA)



PPH Cost Savings

Added Cost Savings for reduced RCEs and Appeals

- **Applicable USPTO Fees**

RCEs - **\$1,200**

Appeals - **\$1,300** (\$800 Appeal and \$500 Brief)

- **Hypothetical complex case (assumes cost savings of \$3,434 per action and avoidance of RCE and appeal filings)**

Savings on Action \$ 3,434

Savings on RCE fees 1,200

Savings on Appeal fees 1,300

Savings on Appeal services 4,931

(without oral argument)

Total savings = \$10,865



Other PPH Benefits

- **Special status**

PPH applications are advanced out of turn for examination, reducing the amount of time to receive office actions and patents.

- **Improved search/examination quality**

Search results are shared among offices. E.g., a JP examiner is normally more adept than a US examiner at searching Japanese art. The JP search results are used by the US examiner to produce a more thorough examination.

- **Reduced overall pendency**

The efficiencies gained by work sharing help patent offices to reduce the overall application backlog, which affects all cases.



For More Information

- For general information concerning PPH, visit www.uspto.gov/web/patents/pph/index.html
- If you have specific questions about PPH, please e-mail PPHfeedback@uspto.gov
- To receive future USPTO updates on PPH, sign up for USPTO's e-Commerce e-Alerts by visiting: <http://www.uspto.gov/ebc/optin.html>

Tab 6B

PCT-PPH practice tips

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Oppedahl Patent Law Firm LLC
www.oppedahl.com

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Filing a Demand?

- PCT-PPH provides a strong incentive to file a Demand in the event of a less than fully favorable WO.
- If by some chance the IPRP is more favorable than the WO, then this permits a more favorable PCT-PPH result.

Things you have to e-file in your PPH request to USPTO

- All references from the ISR/WO/IPRP-II
- A copy of the ISR
- A copy of the WO/IPRP-II (most recent work) if not already in the file
- An IDS (form PTO/SB/08A) listing all of the above
- If not already in English ...
 - A translation of WO (or IPRP) into English (WIPO will translate these documents by 30 months)
 - A translation of the favorably treated claims (in the WO or IPRP) into English
 - An accuracy statement for the claims

Trap for the unwary

- Many filers will put off filing thorough IDSs until months after getting the US application number.
- But when you file a PCT-PPH petition, you might get a Notice of Allowance at any time thereafter, perhaps within mere days.
- Make sure that all of your IDSs (not only the IDS required by the PCT-PPH procedure) have been filed ***before*** you file your PCT-PPH petition.

Most commonly made mistakes when petitioning for PCT-PPH status

- failing to provide all references from the ISR
- failing to file an IDS detailing those references
- failing to cancel claims that were not treated favorably
- failing to address Box VIII observations
- failing to e-file
- failing to index the petition correctly - "Petition to make special under PCT-Patent Pros Hwy"
- failing to provide a copy of the WO
- failing to cause the US claims to “sufficiently correspond”

Dealing with Box VIII

- Box VIII is nowhere mentioned in the official USPTO form. It is thus easy to overlook a Box-VIII problem if there is one. Be vigilant. Look at the WO or IPRP-Chapter-II to see if it has anything in Box VIII.

If a petition is dismissed?

- Trap for the unwary: If the Examiner picks up the file while you are sitting around not responding to the dismissal, you lose your chance for PCT-PPH. So don't let the whole month go by. Respond sooner.

Searching authorities

- What Searching Authorities do PCT-PPH applicants use in USPTO?
 - Most often ISA/KR, then ISA/EP, also ISA/JP
 - Other ISAs are used less often

Double-dipping on the Highway

- You can double-dip. If the US can be construed as the Office of First Examination ... then you can use a favorable Office Action, or Notice of Allowance, from the USPTO as the trigger for PPH benefit in one or more foreign countries!
- A typical double-dip sequence is to use PCT-PPH followed by regular PPH

International Search and Preliminary Examination



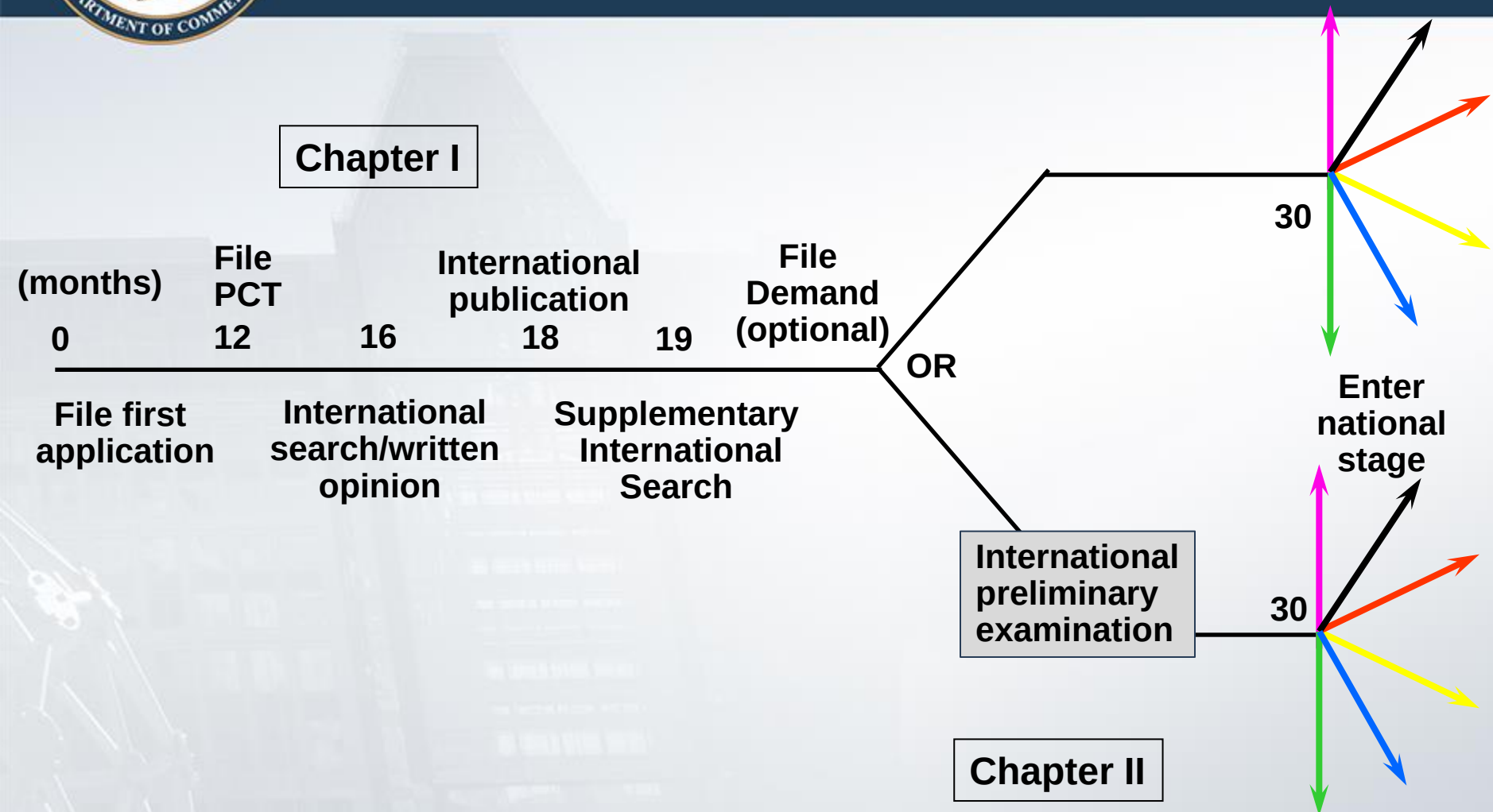
Michael A. Neas

Deputy Director

International Patent Legal Administration



PCT System





Chapter I Procedures

- The receiving Office sends a “search copy” of the international application to the International Searching Authority (ISA) after
 - completion of the formalities review
 - granting of the foreign filing license and
 - payment of the search fee
- The ISA mails Form PCT/ISA/202 to applicant and the IB notifying the date of receipt of the search copy



The International Searching Authority (1)

- Checks for the presence of multiple inventions
 - if more than one invention present, invites applicant to pay for the search of the additional inventions
- Checks the title of the invention
 - establishes one if the title is not short and precise
- Checks the abstract
 - establishes one if the abstract
 - is not concise (more than 150 words)
 - is not present



The International Searching Authority (2)

- Searches the claimed invention for relevant prior art
- Takes into account earlier search results where the applicant has so requested and the required copies have been supplied
- Prepares an international search report and a written opinion of the ISA



Relevant Prior Art for the International Search (1)

- For the ISR
 - must have been made available to the public
 - anywhere in the world
 - by means of written disclosure
 - prior to the international filing date
- For the WOISA
 - must have been made available to the public
 - anywhere in the world
 - by means of written disclosure
 - prior to the “relevant date” which is
 - the international filing date or
 - the priority date if the international application has a valid priority claim to a prior application



Relevant Prior Art for the International Search (2)

- Includes applicant's own work
 - there is no one year grace period
- Also includes “admitted prior art”
- Exceptions to the prior art definition
 - Written document published on or after the international filing date which describes an earlier oral disclosure, use or exhibition – “O” reference
 - US or foreign patent or patent application published on or after the international filing date but having a filing or priority date prior to the international filing date – “E” reference
 - cited in the ISR but not applied in the WOISA



International Search Report (ISR) Form PCT/ISA/210

- Indicates the International Patent Classification (IPC) for the claimed invention
 - also indicates the U.S. classification if searched by ISA/US
- Indicates any finding of lack of unity
- Lists the relevant prior art documents
 - categorizes the references found as to their relevance
 - cites the references
 - lists the claims to which the references are relevant



Declaration Under Article 17(2)(a)

- In very rare instances the ISA may not be able to issue an ISR because
 - all the claims are directed to subject matter for which no searches are carried out, e.g., excluded subject matter under PCT Rule 39
 - USPTO will search all subject matter in an international application as it would in a U.S. patent application
 - the description, claims or drawings fail to meet a requirement such as clarity or support of the claims to such an extent that no meaningful search can be carried out
 - a complaint sequence listing is not provided in response to Form PCT/ISA/225 – Invitation to Furnish Nucleotide and/or Amino Acid Sequence Listing and to Pay, Where Applicable, Late Furnishing Fee
- The ISA would issue a form PCT/ISA/203 (Declaration of Non-Establishment of International Search Report)



Written Opinion of the ISA Form PCT/ISA/237

- The ISA establishes a written opinion at the same time that it establishes the international search report (or declaration under Article 17(2)(a))
- The written opinion of the ISA
 - indicates whether the international application
 - satisfies the criteria of novelty, inventive step and industrial applicability; and
 - complies with the requirements of the Treaty and the Regulations (so far as checked by the ISA)
 - notifies applicant that if a demand for international preliminary examination is made, the written opinion may be considered to be the written opinion of the IPEA



Unity of Invention (Rule 13)

- An international application must relate to
 - one invention only or,
 - if there is more than one invention, those inventions must be so linked as to form a single general inventive concept



Unity of Invention

- Inventions are considered linked so as to form a single general inventive concept only when there is a technical relationship involving one or more of the same or corresponding special technical features
 - the expression “special technical features” means those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art (Rule 13.2)

For further explanation and examples concerning unity of invention see Chapter 10 of the PCT International Search and Preliminary Examination Guidelines found on the WIPO Internet site: (<http://www.wipo.int/pct/en/texts/gdlines.htm>)



Example

Claim 1: A method of making chemical substance X

Claim 2: Substance X

Claim 3: A method of using chemical substance X

The special technical feature common to all of the claims is substance X. Unity exists among claims 1, 2 and 3 where substance X is applicant's contribution over the prior art.

However, if substance X is known in the prior art, then unity would be lacking.



When lack of unity of invention is found

- The first mentioned invention will always be searched
- Applicant can pay for the search of additional inventions
 - all of the additional inventions
 - some of the additional inventions or
 - none of the additional inventions
- Applicant has the right to protest the lack of unity requirement so long as the fees are paid for each invention that is being protested
 - Protest fee is required by some ISAs
 - for example, EP, KR, RU



Main Features of the International Search and Preliminary Examination System

- International search report (or declaration under Article 17(2)(a)) plus written opinion of ISA is issued for every international application
- International preliminary report on patentability (IPRP) is issued for every international application
 - IPRP (Chapter I) = repackaged written opinion of the ISA
 - IPRP (Chapter II) = IPER
- Main distinction:
 - IPRP (Chapter I) issued when no demand for IPE filed:
 - based on application as originally filed
 - IPRP (Chapter II) is issued when demand is filed:
 - timely filed amendments and/or arguments taken into account before establishment of IPRP (Chapter II)



IPRP (Chapter I)

- If applicant does not file demand
 - IB will establish “International Preliminary Report on Patentability” IPRP (Chapter I) by placing form PCT/IB/373 onto the written opinion of the ISA
- IPRP (Chapter I) and any comments on the written opinion filed by applicant
 - are sent to designated Offices by the IB
 - are made publicly available by the IB (but not “published” like application and ISR)
 - but not before the expiration of 30 months from the priority date



International Preliminary Examination Chapter II

- Is an optional process
 - a demand for international preliminary examination (form PCT/IPEA/401) electing at least one eligible State is made with a competent International Preliminary Examining Authority (IPEA)
- Results in examination of the international application
 - IPEA issues a non-binding opinion on the novelty, inventive step and industrial applicability of the claimed invention (international preliminary examination report)
 - applicant has an opportunity to amend the description, claims and drawings



Time Limit for Making a Demand

- Time limit for filing a Demand
 - three months from the date of transmittal of the international search report (or declaration referred to under Article 17(2)(a)) and written opinion of the ISA or
 - 22 months from the priority date
whichever is later
 - however, a demand made after expiration of this time limit will be considered as not having been submitted
- A demand should be filed before 19 months from the priority date in order to delay the time limit for national phase entry to at least 30 months in all PCT Contracting States
 - Chapter I national phase entry deadline for Luxembourg, United Republic of Tanzania and Uganda is still 20 months
 - all are members of regional Offices with 31 month national phase entry deadline from Chapter I



Amendments

- Applicant has the opportunity to amend the description, claims and drawings under Article 34 during the preliminary examination
- Amendments shall not go beyond the disclosure in the international application as originally filed
- Applicant may file Article 34 amendments
 - with the Demand or within the time period under PCT Rule 54*bis*
 - this may be a response to the written opinion of the ISA
 - entry of amendments filed at other times is at the discretion of the examiner



Claims Eligible for International Preliminary Examination

- Only claims relating to the inventions searched by the International Searching Authority (ISA) are eligible for examination by the International Preliminary Examining Authority (IPEA)



Lack of Unity

- The IPEA applies the same lack of unity criteria as the ISA
 - the IPEA issues an invitation to restrict or pay additional fees where unity is lacking
 - applicant can decide which invention is the “main invention”
 - applicant must pay fees in order to have the additional inventions examined
 - applicant has the right to protest the lack of unity requirement so long as the fees are paid for each invention that is being protested
 - Some IPEAs require a protest fee
 - » For example, EP, KR, RU



Start of International Preliminary Examination

- The international preliminary examination starts only after the IPEA has received
 - the demand
 - the international search report (or declaration of non-establishment thereof) and written opinion of the ISA
 - the preliminary examination fee and the handling fee
 - see Rule 69.1
- The IPEA cannot start examination before the expiration of the time limit under Rule 54bis.1(a) unless applicant expressly requests an earlier start



International Preliminary Examination (1)

- Written opinion of the ISA will be considered as the written opinion by IPEA
 - IPEA may decide not to accept written opinions by certain ISAs
 - IPEA/US will accept written opinions issued by ISA/AU, ISA/EP, ISA/KR and ISA/RU
- IB does not send the applicant's "informal" comments on written opinion of the ISA to the IPEA
 - applicant may submit formal response to the Written Opinion of the ISA in the form of arguments and/or amendments under Article 34 directly to the IPEA



International Preliminary Examination (2)

- “New” written opinion of IPEA (form PCT/IPEA/408) will be issued only in rare circumstances by IPEA/US
 - Some IPEAs issue written opinion in Chapter II where IPRP would otherwise be negative
- International Preliminary Report on Patentability (Chapter II) or IPRP (Chapter II) will usually be the only office action prepared by the IPEA



IPRP (Chapter II)

- The IPRP (Chapter II) is sent to the applicant and the International Bureau (IB)
 - the IB forwards copies to the elected Offices
 - where the IPRP (Chapter II) is in a language other than English, the IB translates it into English and forwards to elected Offices where required
 - the IB does not translate the annexes* to the IPRP (Chapter II)
- Once the IPRP (Chapter II) has been issued, there is no provision for appeal or further prosecution during the international phase

** Annexes are the amendments taken into account in preparing the report and, as of 01 July 2011, any letter accompanying the amendment as provided for in Rules 46.5 and 66.8*



Competent International Authorities for U.S. Applicants Filing International Applications with RO/US or RO/IB*

- ISA/US
 - IPEA/US, KR, RU
- ISA/AU
 - IPEA/AU, KR, RU, US
- ISA/EP
 - IPEA/EP, KR, RU, US
- ISA/KR
 - IPEA/KR, RU, US
- ISA/RU
 - IPEA/RU, KR, US
- ISA/IL**
 - IPEA/IL, RU, KR, US

* this chart applies where all applicants are U.S. nationals and residents

** from 01 October 2014



ISA Competency Considerations

- Not competent to act as ISA for international applications filed by U.S. applicants in RO/US or RO/IB
 - ISA/AU
 - with one or more claims directed to mechanical engineering or analogous technologies, including business methods
 - see 1337 OG 263 for details
 - may change soon
 - ISA/EP
 - with one or more claims directed business methods
 - see PCT Gazette No. 07/2005, page 4432 and No. 38/2006, page 19070 for details
 - ISA/IL*
 - with one or more claims directed business methods
 - determined through classification in IPC G06Q
 - for more than 75 applications per quarter

*beginning 01 October 2014



Choice of ISA for International Applications filed in RO/US

	ISA/US	ISA/EP	ISA/KR	ISA/AU	ISA/RU
FY2009	34%	39%	27%	0%	N/A
FY2010	33%	37%	29%	1%	N/A
FY2011	34%	35%	30%	1%	N/A
FY2012	32%	35%	31%	0.7%	2%
FY2013	29%	38%	29%	<1%	4%
FY2014 to date	32%	38%	27%	<1%	3%



Selecting a Searching Authority

Jay Erstling

William Mitchell College of Law – St. Paul, MN

Patterson Thuent IP – Minneapolis, MN

erstling@ptslaw.com

Knowing Which ISAs Are Available

- For international applications filed in RO/US, or in RO/IB with only US applicants, the available ISAs are: AU, EP, KR, RU, US
 - But keep AU and EP limited competencies in mind
 - IL to become an ISA as of October 1, 2014
- If the IA is filed in RO/IB and applicants include those from other countries, check the PCT Applicant's Guide for additional ISAs:
 - <http://www.wipo.int/pct/en/appguide/index.jsp>
- If using PCT-SAFE, the software will provide a drop-down list of available ISA's based on the nationality and residence of each applicant based on RO selected



Factors to Consider in Choosing an ISA

- PPH benefit
- Cost
- Timeliness
- Effect on later national/regional stage
- Characteristics of ISRs from the different ISAs
- Language competency
- Who does the work (outsourcing)
- Provision of cited references
- Competencies

Keep in mind that some clients do not care at all about the ISR/WO



PPH Benefit

- US, KR, AU, RU [and IL] are all part of the Global PPH pilot. Positive results from any of those ISAs may form the basis for PPH status in:
 - US, JP, KR, UK, CA, AU, DK, FI, RU, HU, ES, SE, PT, IL, NO, and IS
- The EP, US and KR are part of the IP5 PPH pilot. Positive results from any of those ISAs may form the basis for PPH status in:
 - US, EP, JP, CN, and KR
- In addition, the US has a separate PCT-PPH agreement with Austria



Search Fee Payable to RO/US (as of June 17, 2014)

- AU: \$1,972
- EP: \$2,545
- KR: \$1,212
- RU: \$795
- US: \$2,080
 - \$1,040 if the applicant is a small entity
 - \$520 if the applicant is a micro-entity
- [IL: Currently \$1,021]



Additional Search Fees in the Event of Lack of Unity of Invention

- Where there is lack of unity the ISA will only search the first invention
- To have the additional inventions searched, applicant has to pay an additional search fee for each invention in the ISA's local currency
- Consider the comparative cost of search if there is a likelihood of lack of unity



Timeliness (in 2013)

- Transmitting ISRs from the ISA to the IB
 - Percent transmitted within 16 months from the priority date
 - AU: 90.7%
 - EP: 65.5%
 - KR: 68.0%
 - RU: 77.5%
 - US: 64.9%
 - [IL: 69.3%]



Effect on Later National/Regional Stage

- If you pick ISA/EP and later enter the EP regional stage, you don't have to pay a search fee to the DO/EP
- If you pick ISA/US and get a favorable WO or pick IPEA/US and get a favorable IPRP (Chapter II) and later enter the US national stage, you get out-of-order examination and reduced search and examination fees
- If you pick IPEA/AU¹, you get reduced examination fee in EO/AU

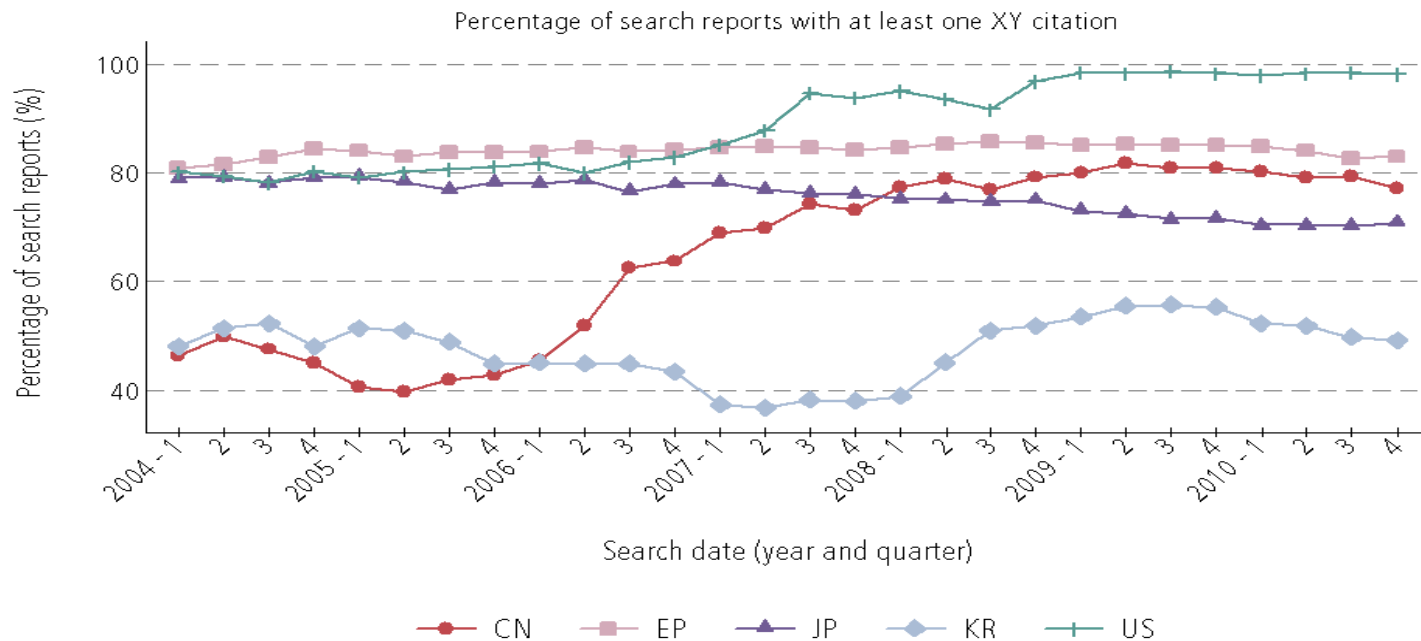
¹ only possible if AU was ISA



Characteristics of ISRs

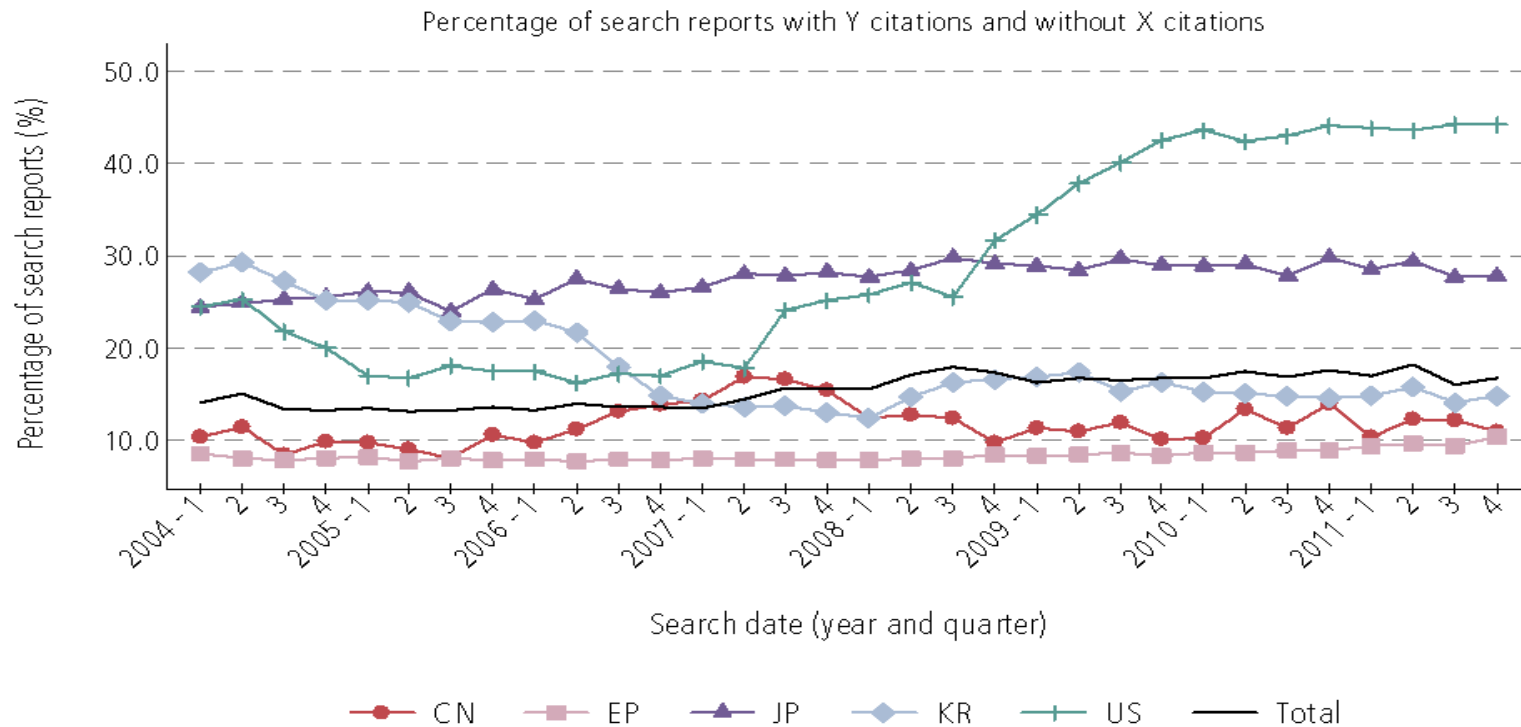
Source: WIPO Circular C. PCT 1398 measuring characteristics of ISRs from different ISAs

■ X/Y Citation Rate:



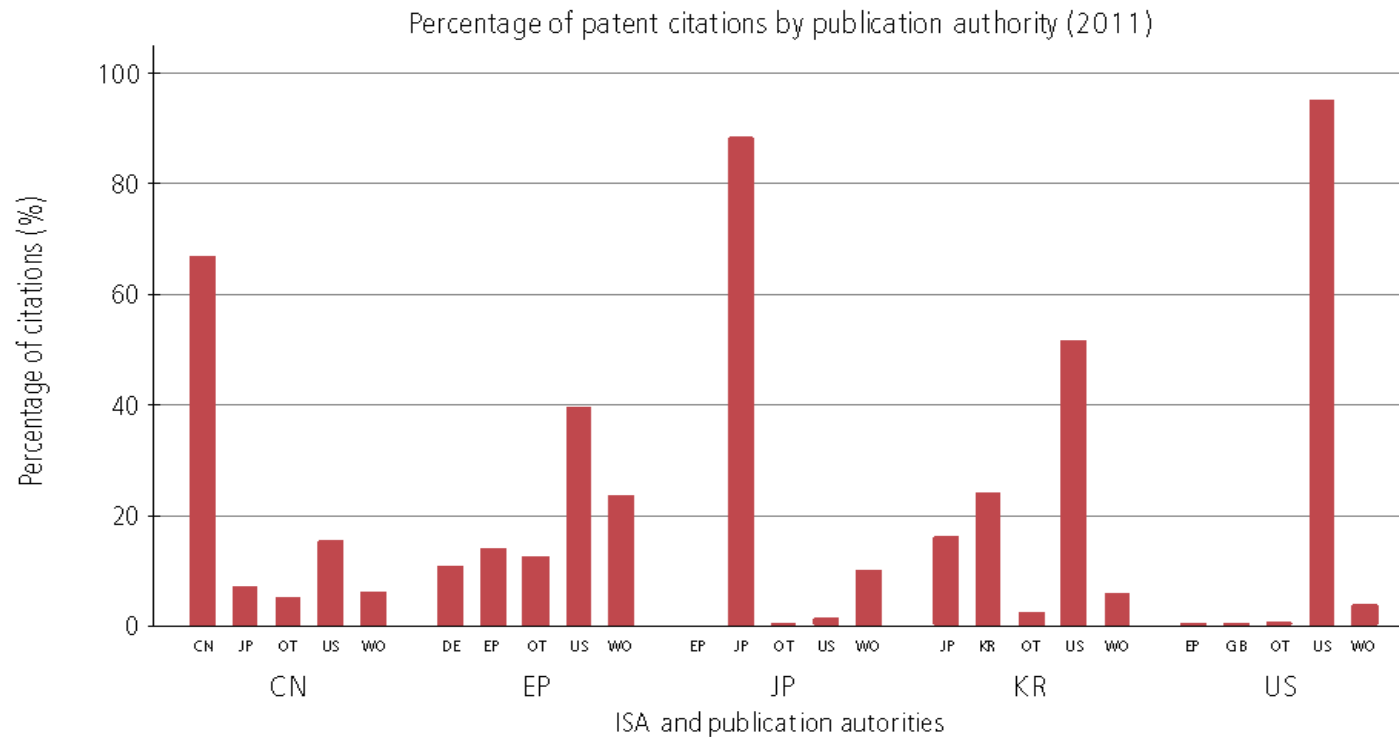
Characteristics of ISRs

■ Y Without X Citation Rate



Characteristics of ISRs

■ Choice of Citations



Language Competency

- An ISA/AU or ISA/US searcher might read only one language
- ISA/KR searchers read at least Korean and English and most also read Japanese
- ISA/EP searchers read at least English, German, and French, and some also read additional languages
- ISA/RU searchers read at least Russian and English and some also read additional languages
- [ISA/IL searchers read Hebrew and English and most also read Russian]



Excluded subject matter and subject matter not required to be searched

- An International Authority may exclude certain subject matter from its agreement with WIPO to act as an ISA and IPEA
- Additionally PCT Rule 39 specifies that no ISA can be required to search certain subject matter in an international application
 - Scientific and mathematical theories
 - Plant or animal varieties
 - Schemes, rules or methods of doing business, performing purely mental acts or playing games
 - Methods for treatment of the human or animal body by surgery or therapy
 - Mere presentation of information
 - Computer programs to the extent that the ISA is not equipped to search the prior art concerning such programs
- If all the claims are directed to such subject matter, ISA will issue an Article 17(2)(a) declaration of non-establishment of the ISR



AU: Excluded Subject Matter

A01- AGRICULTURE; FORESTRY; ANIMAL HUSBANDRY; HUNTING; TRAPPING; FISHING, all classes except A01H, A01N, A01P (ie new plants or processes of obtaining them thereof, preservation of human, animals bodies or plants, biocidal, pest repellent, pest attractant or plant growth regulatory activity of chemical compounds or preparations)

A21- BAKING; EQUIPMENT FOR MAKING OR PROCESSING DOUGHS; DOUGHS FOR BAKING all classes except A21D, (ie. Treatment of flour or dough for baking)

A22- BUTCHERING; MEAT TREATMENT; PROCESSING POULTRY OR FISH

A23N- MACHINES OR APPARATUS FOR TREATING HARVESTED FRUIT, VEGETABLES OR FLOWER BULBS IN BULK

A23P- SHAPING OR WORKING OF FOODSTUFFS

A24- TOBACCO; CIGARS; CIGARETTES

A41-47 PERSONAL AND DOMESTIC ARTICLES (e.g. headgear (A42), footwear (A43), haberdashery (A44))

A61- MEDICAL OR VETERINARY SCIENCE, all classes except A61K, A61L, A61P and A61Q (ie preparations for medical, dental or toilet purposes, methods, apparatus for sterilising materials or objects, chemical aspects of bandages, dressings, absorbent pads, or surgical articles, therapeutic activity of chemical compounds, use of cosmetics or similar toilet preparations)

A62- LIFE-SAVING all classes except A62D (ie chemical means for extinguishing fires, processes for making harmful chemical substances harmless, or less harmful, by effecting a chemical change, composition of materials for coverings or clothing for protecting against harmful chemical agents; composition of materials for transparent parts of gas-masks, respirators, breathing bags or helmets; composition of chemical materials for use in breathing apparatus)

A63- SPORTS; GAMES; AMUSEMENTS



AU: Excluded Subject Matter

B06- GENERATING/TRANSMITTING MECHANICAL VIBRATIONS IN GENERAL

B21, B23-B27 all except B23K (ie soldering or unsoldering; welding; cladding or plating by soldering or welding; cutting by applying heat locally, e.g. flame cutting; working by laser beam)

B31- MAKING PAPER ARTICLE WORKING PAPER

B60-B68 all except B60L, B60M and B60Q (ie electric equipment or propulsion of electrically-propelled vehicles; magnetic suspension or levitation for vehicles; electrodynamic brake systems for vehicles, in general, power supply lines, or devices along rails, for electrically-propelled vehicles, arrangement of signalling or lighting devices, the mounting or supporting thereof or circuits therefor, for vehicles in general)

D01-D07 Textiles all except D06L, D06M, D06N, D06P, D06Q (ie bleaching, treatment of fabrics, dyeing or printing textiles, decorating textiles)

E01-E06 FIXED CONSTRUCTION

E21- EARTH OR ROCK DRILLING; MINING

F01-F04 MACHINES

F15-F17 ENGINEERING ELEMENTS, ACTUATORS, STORAGE OR DISTRIBUTION OF GASES OR LIQUIDS

F41-F42 WEAPONS, AMMUNITION

G04- HOROLOGY

G06- COMPUTING; Calculating; Counting

G10- MUSICAL INSTRUMENTS

G11- INFORMATION STORAGE



EP: Excluded Subject Matter

Official Journal EPO 3/2009, page 206

- Where the IA is filed by a national or resident of the US ...
 - and where the application was filed in RO/US or RO/IB ...
 - and where the application contains one or more claims relating to the field of business methods ...
- then ISA/EP and IPEA/EP will not act.



EP: Excluded Subject Matter

Official Journal EPO 3/2009, page 206

- How is “the field of business methods” defined?
 - G06Q
 - G06Q 10/00
 - G06Q 30/00
 - G06Q 40/00
 - G06Q 50/00
 - G06Q 90/00
 - G06Q 99/00



EP: Limitation on Number of Independent Claims in a Category

- Where there are two or more independent claims in a category of invention (product, process of making the product, use of the product, etc.) that share a special technical feature, for example, Claim 1 A chair with a lifting mechanism, Claim 2 A chair with a mechanical screw lifting mechanism and Claim 3 A chair with a hydraulic lifting mechanism
 - ISA/EP may issue an informal communication telling applicant that the description, claims or drawings fail to comply with the PCT requirements to such an extent that a meaningful search cannot be carried out because the plurality of independent product claims lack conciseness as required by PCT Article 6
 - Applicant will need to choose which independent claim should be searched
 - Unlike a unity of invention requirement, applicant cannot pay for the search of the other independent claims in that category



Subject Matter Not Searched

■ AU

- Methods of treatment
- Plant and animal varieties

■ KR

- Methods of treatment by means of surgery or therapy

■ RU

- Methods of doing business
- Software per se
- BUT RU does search methods of treatment of the human or animal body by surgery or therapy, as well as diagnostic methods (PCT Rule 39.1 (iv))



Outsourcing

- ISA/US searches are outsourced
- Continued user concern that USPTO examiners in US national stage may not give full faith and credit to outsourced ISA/US searches and written opinions
- USPTO focus on ensuring the quality of work from ISA/US contractor



Provision of Cited References

- ISA/EP provides copies of cited references
- ISA/US provides copies of cited non-US patent documents and non-patent literature
- ISA/KR provides a temporary link to a web page containing electronic copies of cited references
- ISA/AU provides copies of cited references upon payment of AUD 50 per document
- ISA/RU provides copies of cited documents



Objective

- In the end, your primary objectives/goals/concerns will inform your choice of ISA
 - PPH
 - Search quality
 - Geographic/language focus
 - Subject matter
 - Speed
 - Cost



Selecting an IPEA

- A Demand for international preliminary examination must be filed within three months of the ISR/WO mailing date, or within 22 months of the priority date, whichever is later
- Percentage of IPRPs Transmitted to the IB within 28 Months (in 2013)
 - AU: 81.3%
 - EP: 79.6%
 - KR: 51.1%
 - RU: 40.6%
 - US: 33.2%
 - [IL]: 77.7%



When to Seek International Preliminary Examination

- To take advantage of PPH by perfecting the IPRP
- To amend your description or drawings (and/or claims) in the international phase (Article 34 amendments)
- To amend your claims, but you failed to do so within the time limit for filing Article 19 amendments (two months from receipt of the ISR/WO)
- To enter the national phase directly in LU, UG, TZ at 30 months, you need to file a Demand within 19 months of the priority date to extend the national phase entry deadline





Amending the International Application and Filing Informal Comments

Carol Bidwell
July 2014

Comparison of Article 19 and Article 34 amendments

Chapter I (Article 19)

- claims only
- one opportunity only
- for provisional protection and to overcome prior art applied by ISA
- effective in all DOs
- filed within the later of 2 mos. of transmittal of the ISR or 16 mos. from the priority date
- filed directly with IB
- formality review by IB
- published together with the international application as filed
- serve as basis for examination by IPEA where a demand is filed unless reversed

Chapter II (Article 34)

- description, claims, drawings
- multiple opportunities possible*
- to overcome prior art applied by ISA and IPEA
- effective in all EOs
- filed together with the demand or within the 54bis.1 time limit for filing a demand; later amendments possible
- filed directly with IPEA
- formality review and substantive examination by IPEA
- are not published but are available in PATENTSCOPE after 30 mos.
- serve as basis for examination by IPEA unless superseded

* Amendments need not be considered if received after examiner has begun to prepare another written opinion or the report

How to make amendments to the claims (Rules 46.5 and 66.8)

- Where claims are amended under Article 19 or 34, they must be presented in the form of replacement sheets containing a complete set of claims
- In case of cancelation of certain claims, no renumbering of the remaining claims is required
- A letter, signed by the applicant or the agent, must accompany the amendment that
 - ❑ identifies claims that differ because of the amendment from the original claims
 - ❑ draws attention to the differences between the original claims and the amended claims
 - ❑ identifies claims that are canceled and
 - ❑ indicates the basis for the amendments in the application as filed

How to make amendments to the description and drawings (Rule 66.8)

- Where the description or drawings are amended under Article 34, replacement pages are required for every sheet which differs from the sheet previously filed
- A letter, signed by the applicant or the agent, must accompany the amendment that
 - ☐ draws attention to the difference between the replaced sheets and the replacement sheets
 - ☐ indicates the basis for the amendments in the application as filed and
 - ☐ preferably explains the reasons for the amendment

Additional remarks on amendments

- Article 19 and Article 34 amendments must not go beyond the disclosure of the international application as filed
 - Article 19 amendments are not reviewed by the IB for compliance
 - if Article 34 amendments go beyond the disclosure of the international application, the international preliminary report on patentability (Chapter II)
 - will be established as if that amendment had not been made
 - will indicate the reasons why the amendment is considered to go beyond the disclosure in the international application as filed
 - will include the amended sheets as annexes
- If the letter indicating the basis for the amendments in the application as filed is missing, the international preliminary report on patentability by the IPEA may be established as if the amendments had not been made

Amendments upon entry into the national phase (Articles 28 and 41; Rules 52 and 78)

- All parts of the international application may be amended (including title and abstract)
- Time limit = normally at least one month from the date of fulfillment of the requirements for entry into the national phase (i.e. not from the time limit under Article 22 or 39(1))
- Any later time limits under the national law apply
- Different amendments possible for different DOs and EOs
- Generally any claims fee due for the national phase will be calculated on the basis of the number of claims valid at the time of entry into the national phase

Informal comments on the written opinion of the ISA

- Applicant may file informal comments on the written opinion of the ISA with the IB
- Informal comments should be filed by 28 months from the priority date
- The IB will send the informal comments to the DOs together with the IPRP (Chapter I) but not before 30 months from the priority date
- It is up to the DOs to decide whether and to what extent to take the informal comments into account in the national phase
- DOs may require translation of informal comments
- Where a demand is filed, the IB will not forward any informal comments to the IPEA
- Informal comments will be open to public inspection as part of the file of the international application at the IB but not before 30 months from the priority date

PROSECUTING YOUR INTERNATIONAL APPLICATION

Samson Helfgott
Katten Muchin Rosenman LLP
New York, NY

AIPLA
PCT Seminar
July 2014

RECOMMENDATIONS ON AMENDING THE PCT APPLICATION

- **Use Article 19 Amendments:**
 - If you find errors in claims
 - If you want to claim additional items not previously claimed
 - If you want to modify claims to address competitors' products
 - If you find that your claims are clearly anticipated (citation in ISR of a good "X" reference)
 - Article 19 Amendments will be included in Publication
 - For Provisional Protection where the claims that publish are substantially identical to claims that ultimately issue, thus allowing applicant to go after an infringer for reasonable royalties between the publication of the claims and the issuance of the patent.

- However – Your amended claims will not be addressed by the Examiner in the international stage unless you file a Demand under Chapter II. If no Demand, the IPRP will be the same as the Written Opinion and will be addressing the unamended claims.

- **Entering into Chapter II – Article 34 Arguments and Amendments**
 - Article 34 Amendments are not Published
 - If you believe claims are anticipated and you want the Examiner to consider the amended claims to hopefully get a “clean” IPRP
 - If you believe the Search Report cited inapplicable references (bad search), enter Chapter II with arguments, even without amendments, to hopefully get a “clean” IPRP
 - If you are planning to enter many non-prosecuting countries in the National Phase, since they grant the PCT claims, clean them up in Chapter II
 - If you plan to file in many prosecution countries and uniform amendments are needed

- If you believe a “clean” IPRP will help in licensing or other exploitation of the invention
- If you are going to enter the National Phase in US and think you can get a “clean” IPRP prepared by the IPEA/US, the application will be “taken out of order” under the provisions of 37 CFR 1.496. Also search and examination fees will be \$0. If only some claims get a “clean” IPRP, you can cancel the other claims in a preliminary amendment. Note that this also applies to a “clean” written opinion issued by the ISA/US
- Use of PCT-PPH to get accelerated prosecution in PPH member countries on “clean” claims
- One amendment in International Phase is easier than making the same amendment in many Elected Offices

- **Caveat**
 - Like any other amendment, any additions/modifications cannot contain new matter.
- **Default Case**
 - Do not use Chapter II
 - If only “Y” reference cited, consider waiting for National/Regional Phase prosecution, since other amendments may be necessary in response to any additional references that may be cited

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Disclaimer: This presentation does not constitute any specific legal or business advice.



ePCT

AIPLA PCT Roadshow

Denver / Arlington
July 2014

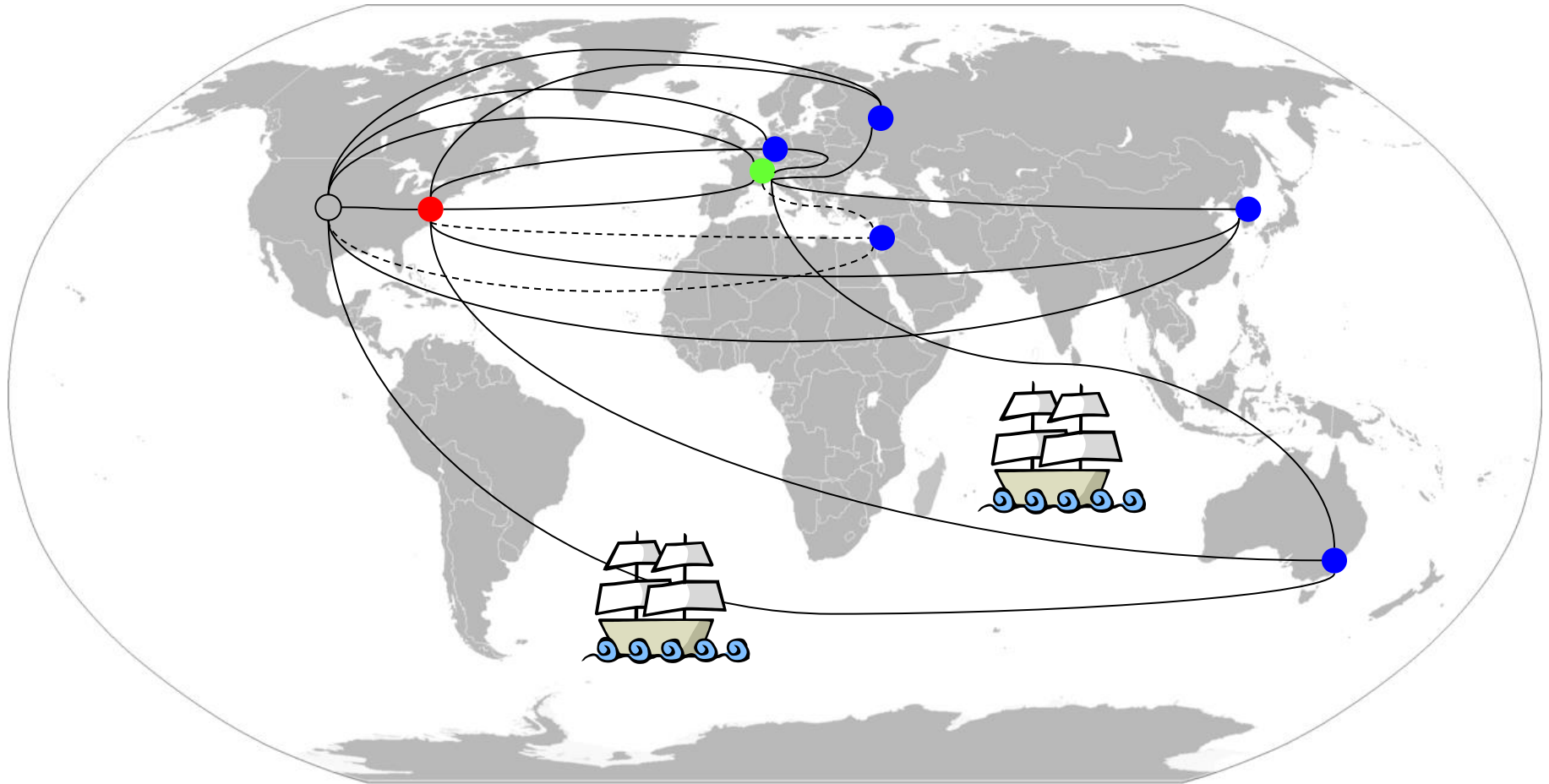
Michael Richardson
Deputy Director, PCT Business Development Division, WIPO

WHY ePCT?

What is ePCT?

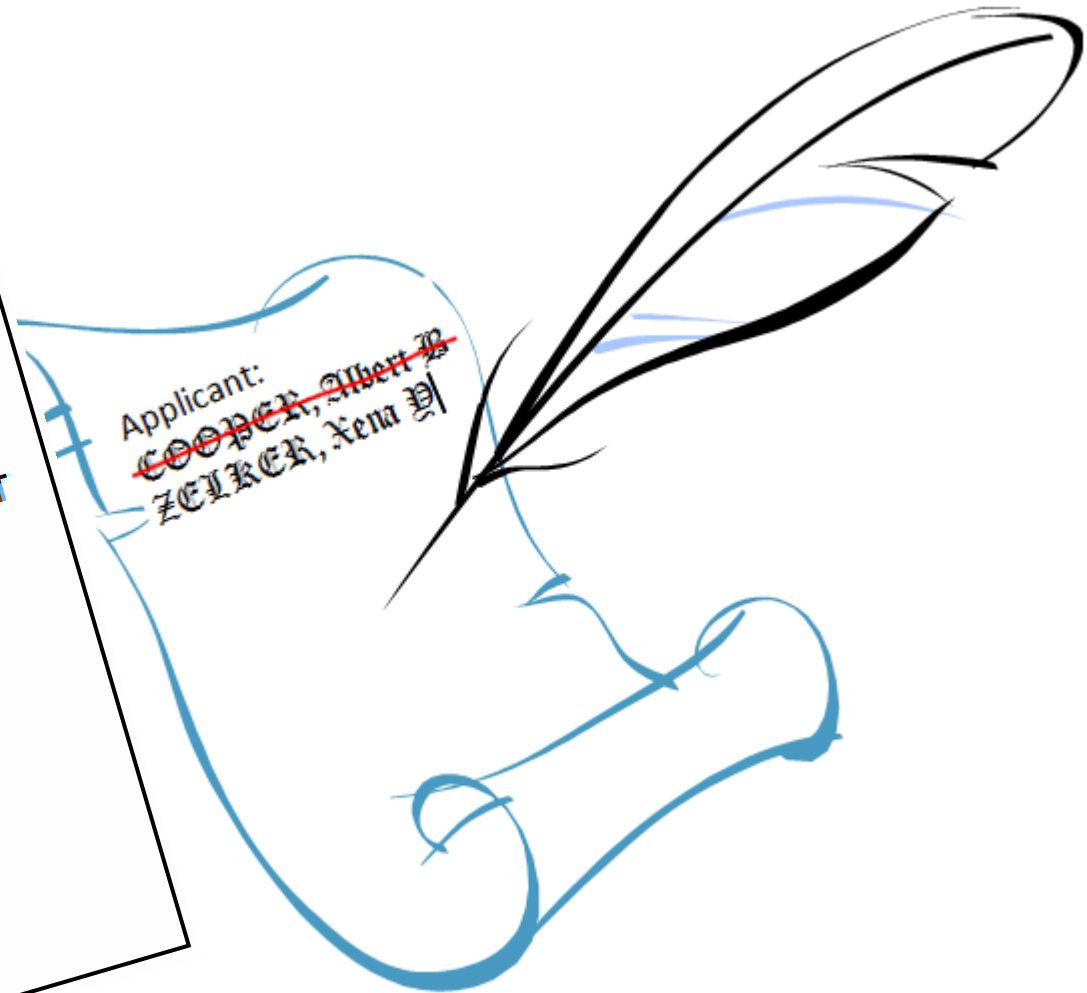
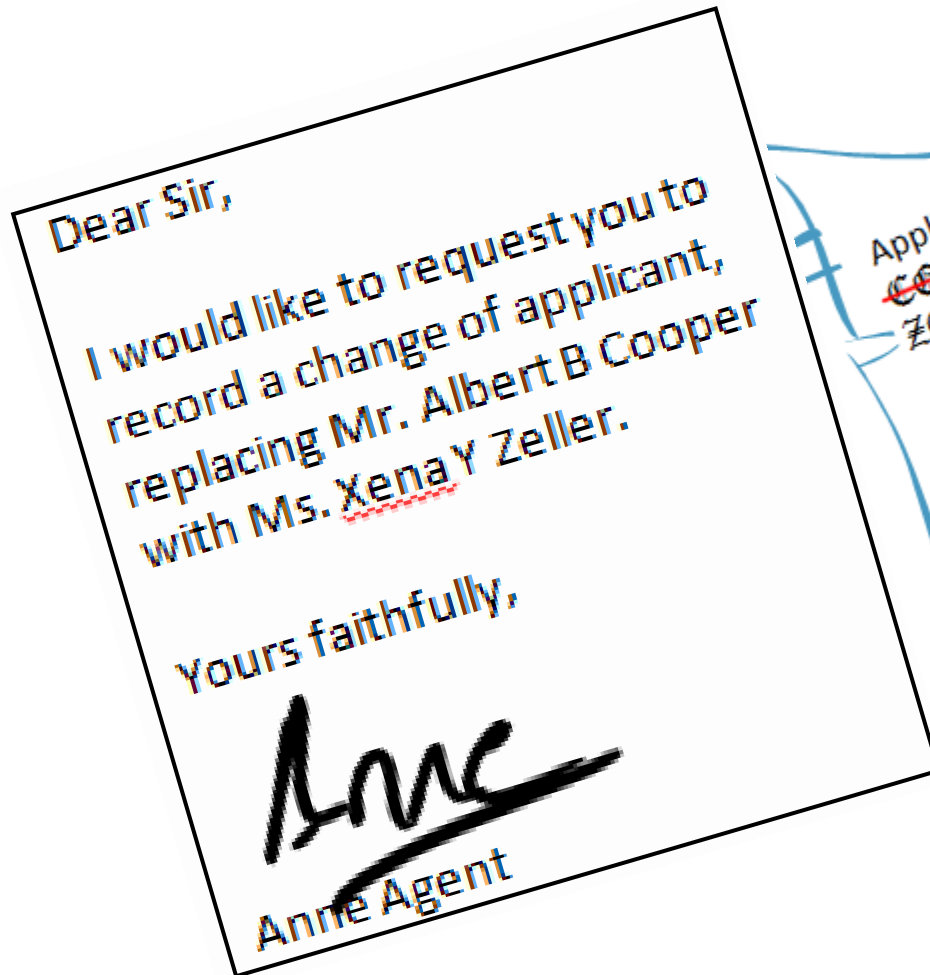
- Yet another online file inspection system to log into?
- What's wrong with Private PAIR?
- Does ePCT offer more than just file inspection and document uploads?

What's happening to my application?



USPTO doesn't have all the information

Is my data being processed quickly and accurately?



By post, you'll probably find out – eventually

Aims of ePCT

- Secure window on and effective tools for managing entire PCT international phase, irrespective of competent Office
- Encourage submission (and retrieval) of directly usable data, rather than letters with information to be transcribed
- Provide applicants with same tools and reference data used by Offices – eliminate surprises
- Notifications customizable to individual needs
- Allow sharing of information on a per-case basis with trusted partners

CASE-BY-CASE SHARING

Sharing Model – Different for a Reason

- Share
 - Draft applications
 - Filed applications
 - Draft documents/actions
 - Address books
- “E-handshakes” define list of people you know and may want to trust
- Set default access rights – adjust to the needs of the individual case

ePCT-FILING

ePCT-filing

- File to RO/IB or increasing range of other Offices

Create new IA

File reference * AIPLA-TEST

Receiving Office * IB - International Bureau of WIPO

AM - Intellectual Property Agency of the Republic of Armenia (WIPO hosted)
AT - Austrian Patent Office (WIPO hosted)
AU - Australian Patent Office (WIPO hosted)
BR - National Institute of Industrial Property (WIPO hosted)
CA - Canadian Intellectual Property Office (WIPO hosted)
CH - Swiss Federal Institute of Intellectual Property (WIPO hosted)
CN - State Intellectual Property Office of the People's Republic of China (WIPO hosted)
CZ - Industrial Property Office (Czech Republic) (WIPO hosted)
DE - German Patent and Trade Mark Office (WIPO hosted)
DK - Danish Patent and Trademark Office (WIPO hosted)
EP - European Patent Office (EPO)
ES - Spanish Patent and Trademark Office (WIPO hosted)
FI - Finnish Patent and Registration Office (WIPO hosted)
GB - United Kingdom Intellectual Property Office (an operating name of the Patent Office)
IB - International Bureau of WIPO
IN - Patent Office (India) (WIPO hosted)
IS - Icelandic Patent Office (WIPO hosted)
LV - Latvian Patent Office (WIPO hosted)
MX - Mexican Institute of Industrial Property (WIPO hosted)
MY - Intellectual Property Corporation of Malaysia (WIPO hosted)

eOwner New

- Like PCT-SAFE but always up to date and many interactive features

ePCT-filing – Shared drafts

- Allow colleagues to share access to the draft application
 - different access rights levels
 - same model applies to filed international applications
 - unless specifically changed, users will retain rights to access the application after filing

Users with existing rights	
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- Import an address book from PCT-SAFE
- Share with others – read only or editable

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Name	Address	Nat	Res	Telephone
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BRIDGEOVERTHEWATER LTD	1 Tamise Square London 6AV 2BE	GB	GB	



Access Rights

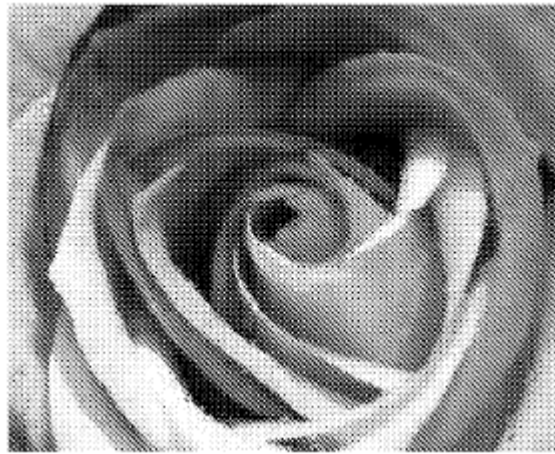
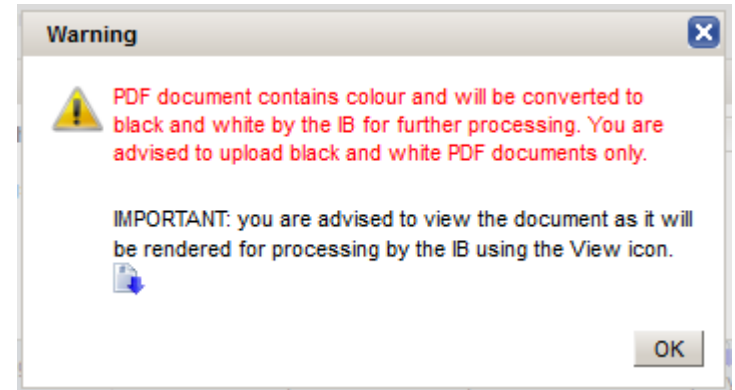
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ePCT-filing – Checks on drawings

- Detects most color/greyscale problem drawings
- Shows how drawings will be converted for publication – using actual IB publication conversion tools



ePCT-filing – DAS Integration

■ Real time check for problems

Type *	National
Country/Office *	US - United States of America
Filing Date *	14/01/2014
Application number *	13/123,456 priority claim data does not match any document in DAS.
Option(s) for providing the priority document to the IB *	☐ Receiving Office to prepare and transmit to the International Bureau ☐ To be provided by the applicant ☐ An electronic copy of the priority document is attached (certified by the issuing Office) ☒ International Bureau to obtain from a digital library
DAS access code *	1234
✖ Please correct the errors indicated above or select a different option for providing the priority document	
☐ The receiving Office is requested to restore the right of priority for this earlier application.	

VIEW FILED INTERNATIONAL APPLICATIONS

Workbench

- All applications which you have access to
- Or filter to find the rights ones

Status

☐ Publication:
☐ Withdrawn
☐ Access suspended
☐ Receipt of Search Copy at ISA confirmed to the IB

Names

Documents

☐ With document(s) containing a business error
☐ With outstanding priority document(s)
☒ With new documents added to the file view

New Docs in the last days

With document type

(IB/301) Notification of receipt of record copy

(IB/302) Notification to the Designated Office of Receipt of Record Copy

(IB/304) Notification Concerning Submission or Transmittal of Priority Document

(IB/305) Notification of Late Submission of Application Number of Earlier Application

☐	IA Number	IA Status	File
☐	PCT/IB2014/080117	Not yet Published	AIP
☐	PCT/FI2013/080006	New IA - RO Phase	Ann
☐	PCT/IB2012/051890	Published WO/2012/140631	E963
☐	PCT/US2012/038864	Not yet Published	
☐	PCT/IB2013/101015	Not yet Published	A
☐	PCT/IB2013/100198	Not yet Published	A
☐	PCT/IB2012/050104	Not yet Published	
☐	PCT/IB2012/051587	Published WO/2012/137119	71
☐	PCT/IB2012/000733	Published WO/2012/127324	808
☐	PCT/RU2011/000562	Not yet Published	
☐	PCT/IB2011/053960	Published WO/2012/032499	Z85
☐	PCT/IB2011/053822	Published WO/2012/035458	A
☐	PCT/US2011/049435	Not yet Published	
☐	PCT/GB2011/001251	Not yet Published	SJKE
☐	PCT/US2011/045999	Published WO/2012/016206	220481
☐	PCT/US2011/001338	Withdrawn	RTL
☐	PCT/IB2011/500001	Not yet Published	
☐	PCT/IB2011/030274	Withdrawn	41
☐	PCT/SE2011/050770	Published WO/2011/162683	IR3
☐	PCT/JP2011/003352	Published WO/2011/158485	P6
☐	PCT/IB2011/000021	Not yet Published	1
☐	PCT/EP2011/058023	Published and Withdrawn WO/2011/147720	IR3
☐	PCT/CA2011/000662	Published WO/2011/137531	80

File View

- All documents available to the IB
- In some cases, including RO/ISA/IPEA documents not traditionally held by IB

PCT/IB2014/080117 - File ref. AIPLA-TEST IA Status: Not yet Published Send ePCT Message

File View Upload Documents Time Line Access Rights History Actions Bibliographic Data

Applicant(s) NEAS, Michael
Inventor(s) NEAS, Michael
Int. Filing Date 03 Jun 2014 IA Status Report Warning
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Search Copy Status Not yet sent
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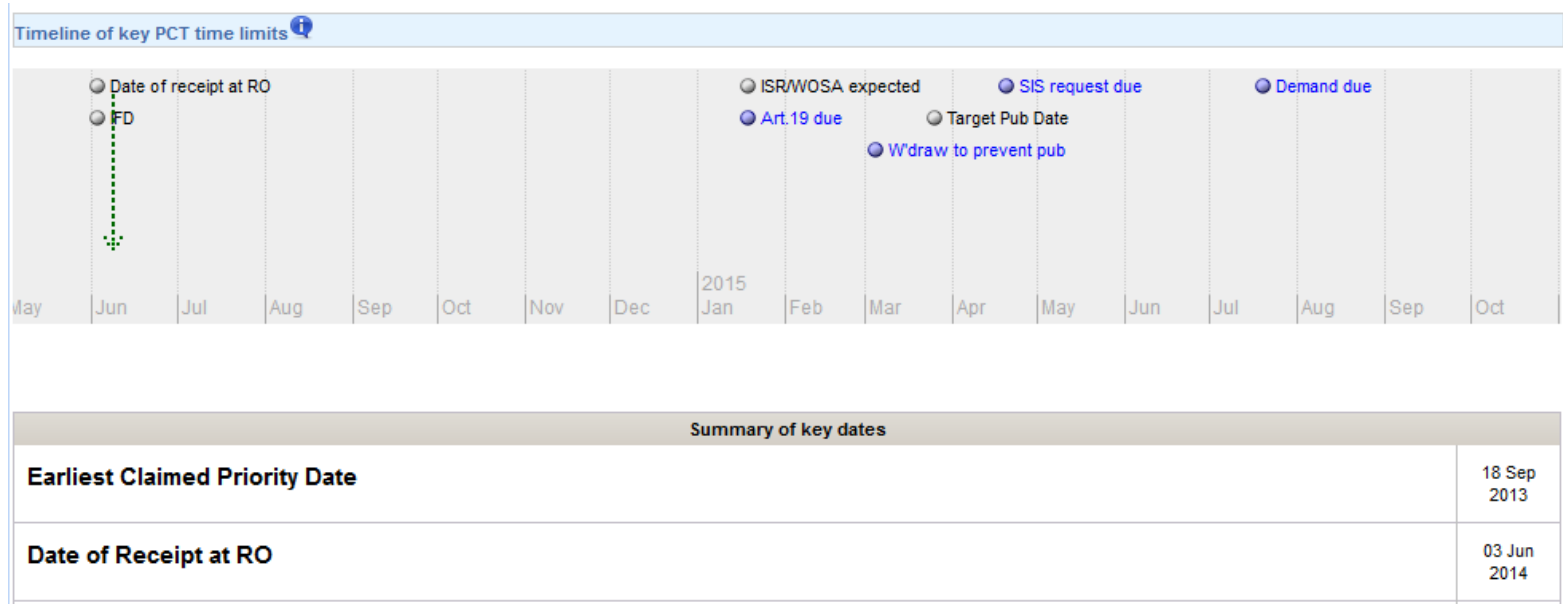
Record as held by the IB Documents for ISA/AU Documents for IPEA

☐	Documents [Doc ID]	Date	Status	Pages		
☐	Related Documents					
☐	Fee Calculation Sheet [7]	03 Jun 2014		1		
☐	Validation Log [5]	03 Jun 2014		1		
☐	(RO/101) Request form [4]	03 Jun 2014		3		
☐	Application Body as Filed [3]	03 Jun 2014		4		
☐	RO WASP File [2]	03 Jun 2014		0		
☐	E Filing Transmission Receipt [1]	03 Jun 2014		1		

Multiple Downloads

Timeline

- Generated based on latest bibliographic data known to the IB
- Available as graphical or table view



TEST

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(72) Inventor: and
(71) Applicant: NEAS, Michael [US/US], Randolph Building,
401 Dulany Street, Alexandria, Virginia 22314 (US).

(81) Designated States (unless otherwise indicated, for every
kind of national protection available): AE, AG, AL, AM,
AO, AT, AU, AZ, BA, BB, BG, BR, BN, BR, BW, BY,
BZ, CA, CH, CL, CN, CO, CR, CU, CZ, DE, DK, DM,
DO, DZ, EC, EE, EG, ES, FI, GB, GD, GE, GM, GT,
HN, HR, HU, ID, IL, IN, IR, IS, JP, KE, KG, KN, KP, KR,

KZ, LA, LC, LK, LR, LS, LT, LU, LV, MA, MD, ME,
MG, MK, MN, MW, MX, MY, MZ, NA, NG, NI, NO, NZ,
OM, PA, PE, PG, PH, PL, PT, QA, RO, RS, RU, RW, SA,
SC, SD, SE, SG, SI, SJ, SM, ST, SV, SY, TH, TJ, TM,
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ZW.

(84) Designated States (unless otherwise indicated, for every
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TM), European (AT, BE, BG, CH, CY, CZ, DE, DK,
EE, ES, FI, FR, GB, GR, HR, HU, IE, IS, IT, LT, LU, LV,
MC, MK, MT, NL, NO, PL, PT, RO, RS, SE, SI, SK, SM,
TR), OAPI (BF, BJ, CF, CG, CI, CM, GA, GN, GQ, GW,
KM, ML, MR, NE, SN, TD, TG).

Published:
without international search report and to be republished
upon receipt of that report (Rule 48.2(ii))

<ns2:file-reference-id>AIPLA-TEST</ns2:file-reference-id>

<ns2:invention-title lang="EN">AN INVENTION</ns2:invention-title>

- <ns2:parties>

- <ns2:applicants>

- <ns2:applicant sequence="1" app-type="applicant-inventor" designation="all">

- <ns2:addressbook lang="EN">

<ns2:name name-type="natural">NEAS, Michael</ns2:name>

- <ns2:address>

- <ns2:address-1>

Randolph Building 401 Dulany Street Alexandria, Virginia 22314

WIPO | PCT
The International
Patent System

(54) Title: AN INVENTION

(57) Abstract: Abstract Something concrete.

INTERACT WITH FILED INTERNATIONAL APPLICATIONS

One Tool – All Offices (Eventually)

- Upload documents through same tool to RO, ISA, IPEA as well as IB (if participating)
- System knows what's possible

1. Select recipient >>

Recipient	Electronic routing method	Current date and time at recipient Office
☒ IB	ePCT ⓘ	Wednesday, 18 June 2014, 17:20 CEST
☐ RO	ePCT Notification ⓘ	Wednesday, 18 June 2014, 17:20 CEST
ISA	No electronic routing	

2. Select document type >>

Select document type:

- +  Article 19 Amendments
- +  Supplementary International Search
- +  Other
- +  Declarations under Rule 4.17
- +  Corrections/Rectifications
- +  Withdrawal under Rule 90bis

Maximum upload limit - 20MB per file

 Add Document (.pdf)

Where We Want to Go – Using Data

- Enter your data
- Save and review
- Submit
- Quick response
- No transcription errors
- Data immediately available to all Offices

Data to be changed	Data currently on file
Applicant and inventor Deceased	Applicant and inventor
All	All
Michael	Michael
RICHARDSON	RICHARDSON
Change in person	
3 Low Road Little Puddingthorpe	1 High Street Scunthorpe DN15 8TD
GB - United Kingdom	GB - United Kingdom
XY - XY Demo Office	XY - XY Demo Office
GB - United Kingdom	GB
01724 123456	01724 123456
Paper & Email	Paper & Email
test@test.fake	test@test.fake

WE'RE NOT THERE YET

Many features depend on other Offices

- Working with all of the Offices which act as competent International Authorities for the US
- Full integration will take several years, but modular system allows switching on of services for Offices as they become ready

Coming Soon

- File word processor documents instead of PDF
- Improved reuse of information from your earlier applications
- Integrated credit card payments
- Improved information on status of processing
- Improved portfolio management
- Improved identity management system (end of problems with digital certificates?)
- Options to allow machine integration for some features (exchange data directly with your own patent management systems)
- Improved look and feel

ePCT doesn't have feature X

- It's not the same as EFS-Web
- We can't please everybody
- We don't have infinite resources
- But try it – it's useful
- We do listen – let us know what you think

epct@wipo.int

Tab 9B

Practitioner perspective on ePCT

Carl Oppedahl
Oppedahl Patent Law Firm LLC
www.oppedahl.com

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Avoiding looking stupid in front of the client

- It is easy to look stupid in front of the client
- There are many ways a PCT filer could look stupid
- PCT-SAFE FM carries out many validations that protect the filer from looking stupid later
- ePCT carries out all of the validations that PCT-SAFE FM carries out, plus many more
- If you are filing in RO/IB, use ePCT rather than PCT-SAFE FM

Avoiding looking stupid in front of the client

- ePCT lets you generate a report of all of your cases that have priority-document problems
- You can generate this report every few weeks
- You can then get to work trying to get the priority document problem fixed

Avoiding looking stupid in front of the client

- ePCT lets you generate a report of all of your cases that are missing Form PCT/ISA/202
- You can generate this report every few weeks
- You can then get to work trying to get the ISA to admit that they received the Search Copy

Avoiding looking stupid in front of the client

- ePCT can be configured to send you an email when the end of the 30-month period is near (indeed this is a default behavior)
- This can be part of a multilayered approach to minimizing the risk of missing the 30-month date

Best Practice for filing a Demand

- Filing a Demand in IPEA/KR?
- Best Practice is to e-file it in ePCT rather than faxing it to IPEA/KR
- Wire the money using a good bank wire system, mentioning the international application number

Best Practice for filing a 92*bis* request

- E-filing in EFS-Web is not a Best Practice
- Faxing to WIPO is not a Best Practice
- E-filing to WIPO as a “document upload” is not a Best Practice
- The Best Practice is to do an “action” in ePCT

Best Practice for filing an Article 19 amendment

- E-filing in EFS-Web is not a Best Practice
- Faxing to WIPO is not a Best Practice
- E-filing to WIPO as a “document upload” is not a Best Practice
- The Best Practice is to do an “action” in ePCT

Permitting clients, colleagues, and inventors to see filed PCT applications

- ePCT allows you to give access in ePCT to clients, foreign colleagues, and inventors for PCT applications that you have filed
- This permits them to check the status of the case
- They will be notified when papers are filed
- They will be notified of communications from Offices

Permitting clients and inventors to see submission packages that have not yet been e-filed

- ePCT allows you to give access in ePCT to clients and inventors for e-filing submission packages that have not yet been e-filed
- This permits clients and inventors to review the Request and the Application Body for correctness

Same-day corrections

- EPCT now offers a “same-day corrections” button

Submit same-day corrections

Time remaining for same-day corrections : 12:20

STRATEGIES FOR PCT FILING

Samson Helfgott
Katten Muchin Rosenman LLP
New York, NY

AIPLA
PCT Seminar
July, 2014

DIFFERENT LAWS IN DIFFERENT COUNTRIES

- Historically US had a number of differences than the rest of the world
 - First-to-invent vs. First-to-file
 - Grace Period
 - What constitutes prior art (local novelty vs. absolute novelty)
 - Commercialization vs. Divuligation
 - e.g. Experimental use
 - Offer for sale
- AIA has made US law substantially similar to the rest of the world – but still some differences.
 - Grace Period
 - Secret Prior Art
- However, we will have essentially 2 sets of laws at least until March 15, 2034

CAVEATS FOR FILING

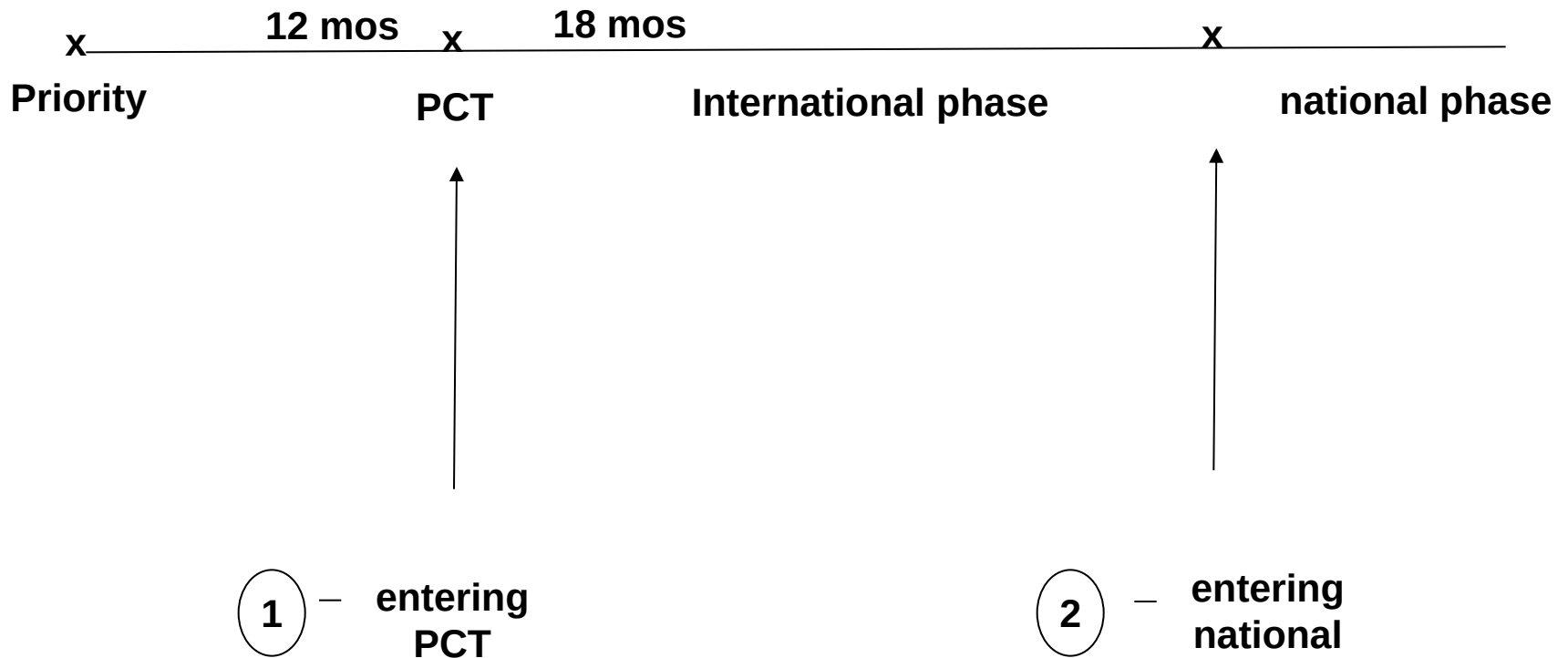
- Do not delay – don't rely on the Grace Period
- Consider using Confidential Agreements if disclosure is required
- File application quickly – “race to the patent office”
- However, still need full disclosure
- Can't think of just US – must think globally

STRATEGIES FOR PCT FILING

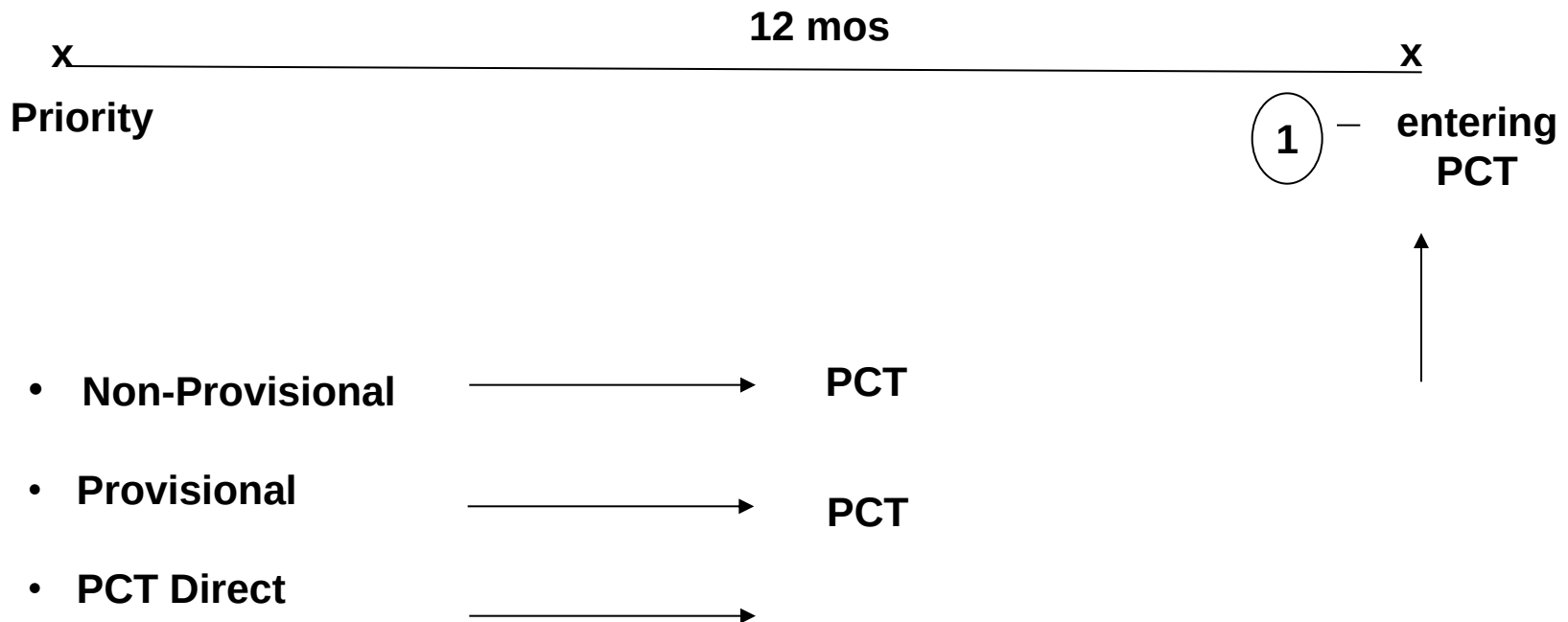
- There are different available routes for foreign filing, even using the PCT
- We must be able to combine available “tools”
 - Provisional Application
 - PCT
 - EPC
 - Paris Convention
 - Bilateral Treaties, e.g. Taiwan
- Each case should be analyzed to determine best strategy for filing

FILING PCT

- Two “access” points:

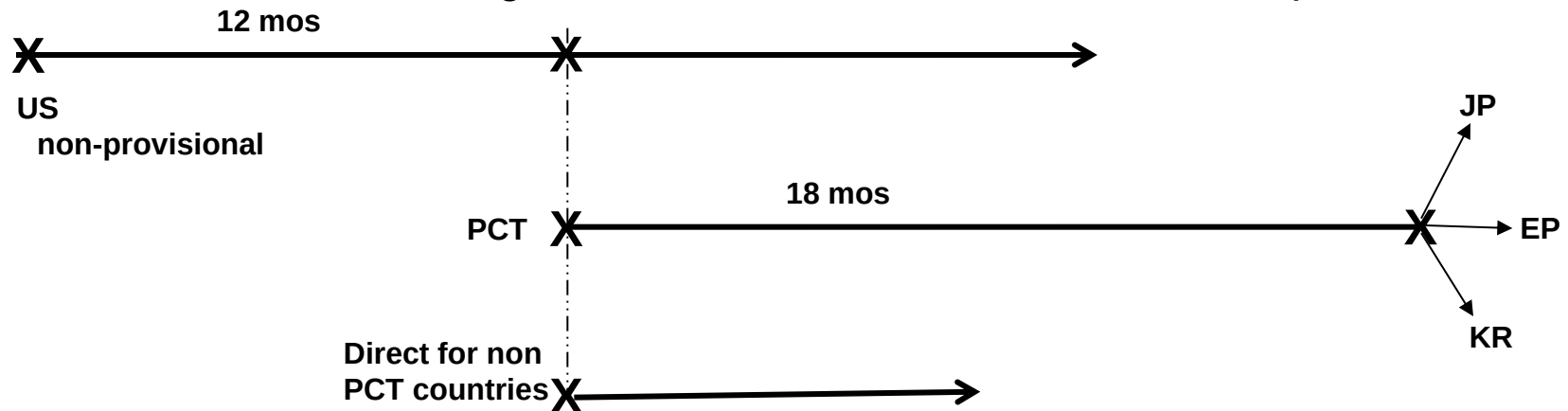


ENTERING PCT



CLASSICAL ROUTE

- File US as Non-provisional
- File PCT within year & Paris for non PCT countries
- Use PCT for foreign countries and continue with US non-provisional



Benefits

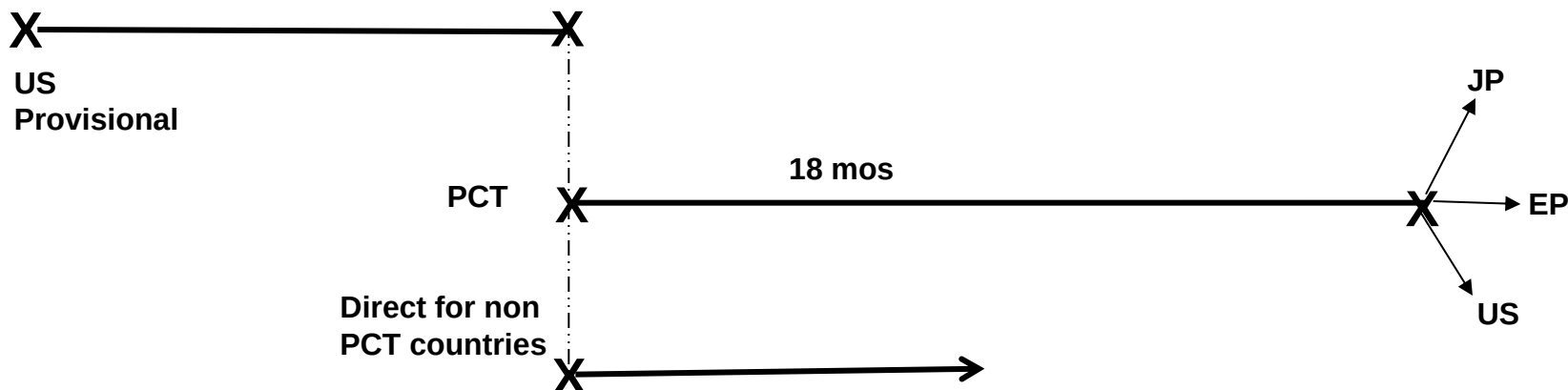
- PCT search may get earlier search results than US case
- Can get PCT search from another Patent Office
- Can still use PCT into US for a second US case

Concerns

- Significant upfront costs for complete US preparation and prosecution
- Term of US patent one year less than foreign

PROVISIONAL AND PCT

- File US as Provisional but do not file the US non-provisional at 12 months
- File PCT within year and Paris for non PCT countries
- Use PCT for US and foreign filing



Benefits

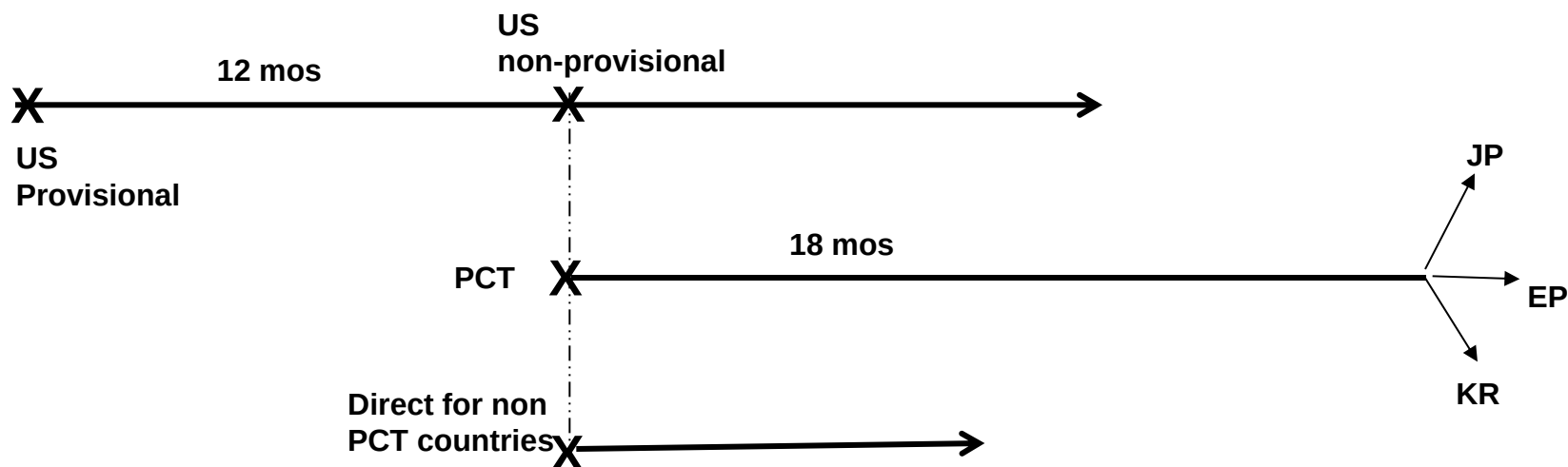
- Lower up front costs
- Can choose when to prosecute in US
- May get search results before big investment
- Get benefit of extra year of term of US Patent. All patents will expire at same time

Concerns

- May delay prosecution in US

PROVISIONAL, THEN NON-PROVISIONAL AND PCT

- File US as provisional and within year file both US non-provisional and PCT, and Paris for non PCT countries



Benefits

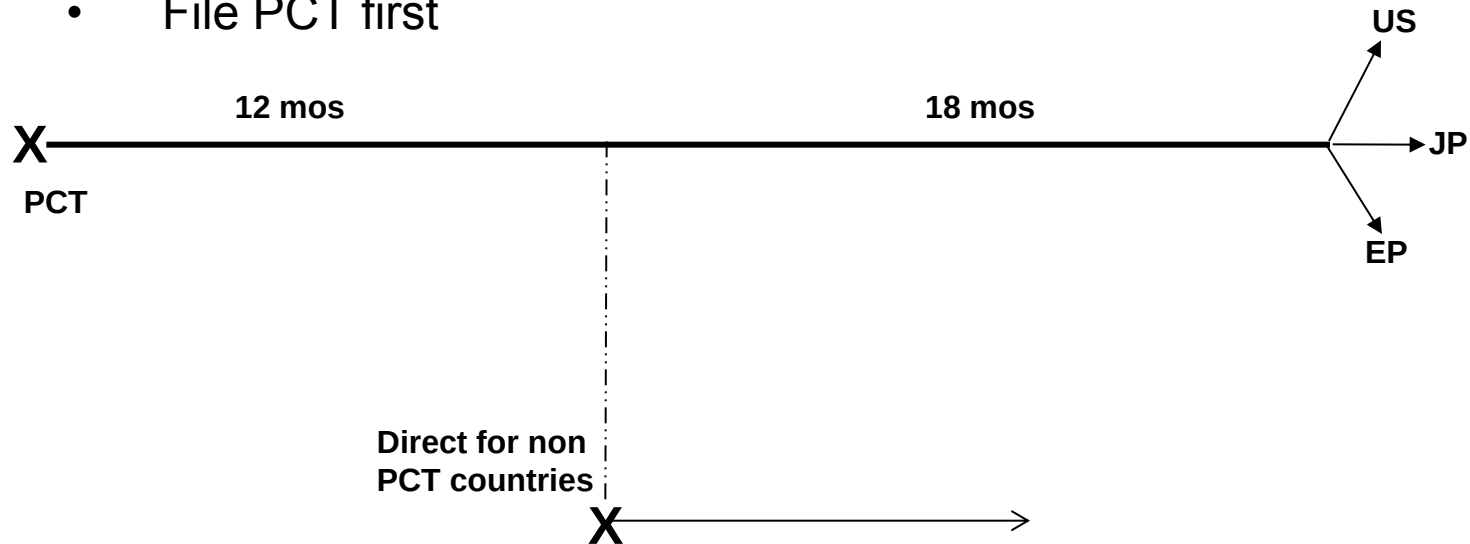
- Limited front end costs
- PCT search may get earlier result than US case
- If use EPO for PCT search can get US & EPO search before foreign filing
- Can still get a second US case from the PCT
- All patents will expire at the same time

Concerns

- Must invest in US filing without benefit of search
- More expenses come sooner

PCT FIRST

- File PCT first



Benefits

- Can get search before any real investment
- Longest time for amending claims
- Can file US case during International Phase, do not need to wait 30 months

Concerns

- Will lose one year on term for all patents in PCT countries
- Delay in getting US patent

FILING PCT

- Using a Provisional as priority
 - 35 USC 119(e) for US
 - Internal Priority for US
 - Paris convention priority for other countries
- Using a Non-Provisional as priority
 - 35 USC 120 for US
 - PCT is actually a continuing application for US
 - Paris convention priority for other countries

FILING PCT

Using a Provisional as priority for PCT

- Include priority information on Request Form for US (domestic benefit under 35 USC 119(e)) and foreign priority outside the US

Box No. VI PRIORITY CLAIM				
The priority of the following earlier application(s) is hereby claimed:				
Filing date of earlier application (day/month/year)	Number of earlier application	Where earlier application is:		
		national application: country or Member of WTO	regional application:* regional Office	international application: receiving Office
item (1) 26 JANUARY 2012 (26.01.12)	60/349,014	US		
item (2)				
item (3)				

☐ Further priority claims are indicated in the Supplemental Box.

The receiving Office is requested to prepare and transmit to the International Bureau a certified copy of the earlier application(s) *(only if the earlier application was filed with the Office which for the purposes of this international application is the receiving Office)* identified above as:

☐ all items ☒ item (1) ☐ item (2) ☐ item (3) ☐ other, see Supplemental Box

* Where the earlier application is an ARIPO application, indicate at least one country party to the Paris Convention for the Protection of Industrial Property or one Member of the World Trade Organization for which that earlier application was filed (Rule 4.10(b)(ii)).

FILING PCT

Using a Non-Provisional as priority for PCT

- Include priority information on Request Form for foreign countries and US; use supplemental box for domestic benefit (35 USC 120)

Box No. VI PRIORITY CLAIM				
The priority of the following earlier application(s) is hereby claimed:				
Filing date of earlier application (day/month/year)	Number of earlier application	Where earlier application is:		
		national application: country or Member of WTO	regional application: * regional Office	international application: receiving Office
item (1) 26 JANUARY 2012 (26.01.12)	13/349,014	US		
item (2)				
item (3)				

☐ Further priority claims are indicated in the Supplemental Box.

The receiving Office is requested to prepare and transmit to the International Bureau a certified copy of the earlier application(s) (only if the earlier application was filed with the Office which for the purposes of this international application is the receiving Office) identified above as:

☐ all items ☒ item (1) ☐ item (2) ☐ item (3) ☐ other, see Supplemental Box

* Where the earlier application is an ARIPO application, indicate at least one country party to the Paris Convention for the Protection of Industrial Property or one Member of the World Trade Organization for which that earlier application was filed (Rule 4.10(b)(ii)).

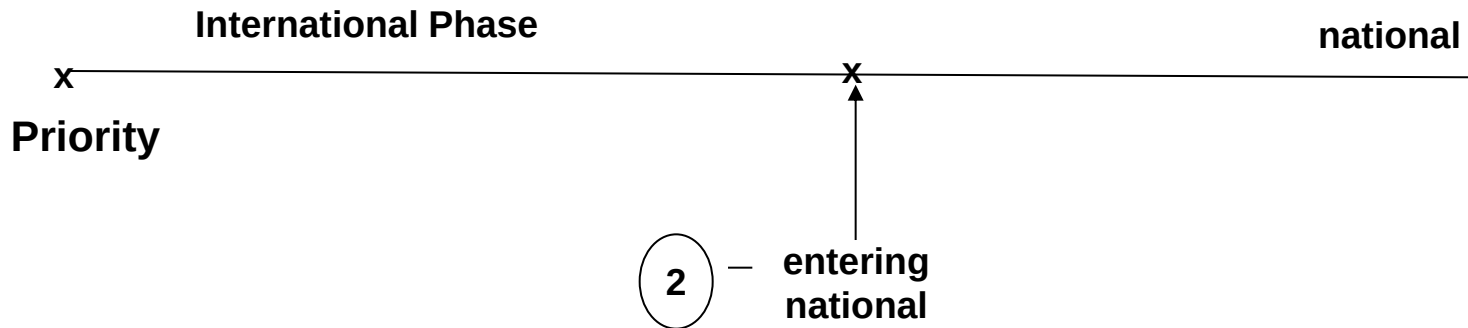
- Where the PCT is to be treated in the US as a continuation or a continuation-in-part of an earlier US non-provisional application under 35 USC 120, the PCT should include domestic priority information in the Supplemental Box 3, item 3.
- Supplemental Box on the request form should include:
 - “US” or “United States of America”
 - the indication of continuation or continuation-in-part
 - the application number and the filing date

3. **If the applicant intends to make an indication of the wish that the international application be treated, in the United States of America, as a continuation in continuation-in-part of an earlier applicant: in such case, write “United States of America” or “US” and the indication “continuation” or “continuation-in-part” and the number and the filing date of the parent application (Rules 4.11(a)(iv) and 49 bis.1(d)).**

US, continuation-in-part,
13/349,014, 28 January 2012
(28.01.2012)

- Note: This is not needed for the PCT; applicant should include this data to preserve rights if he decides to use by-pass route because that the intermediate application (i.e., PCT) must include continuity information.

ENTERING US



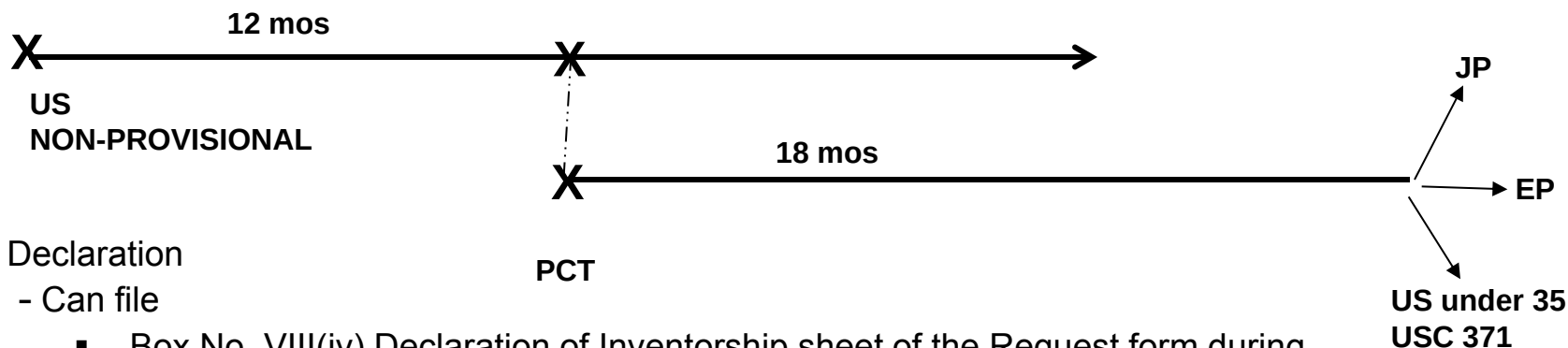
- Can enter USPTO in 2 ways:
 - National Phase Entry: (35 USC 371) – i.e. same case
 - By-Pass Route: (35 USC 111(a)) – i.e. – new case (con, cip or div of the PCT)
- Upon Entry into USPTO, must provide:
 - Declaration unless Application Data Sheet is provided
 - Fees
 - “Pedigree” – How you got here

ENTERING US

US Non-Provisional-PCT-371 US National Phase Application

When entering into the US from PCT Non-Provisional Priority

- National Phase Entry

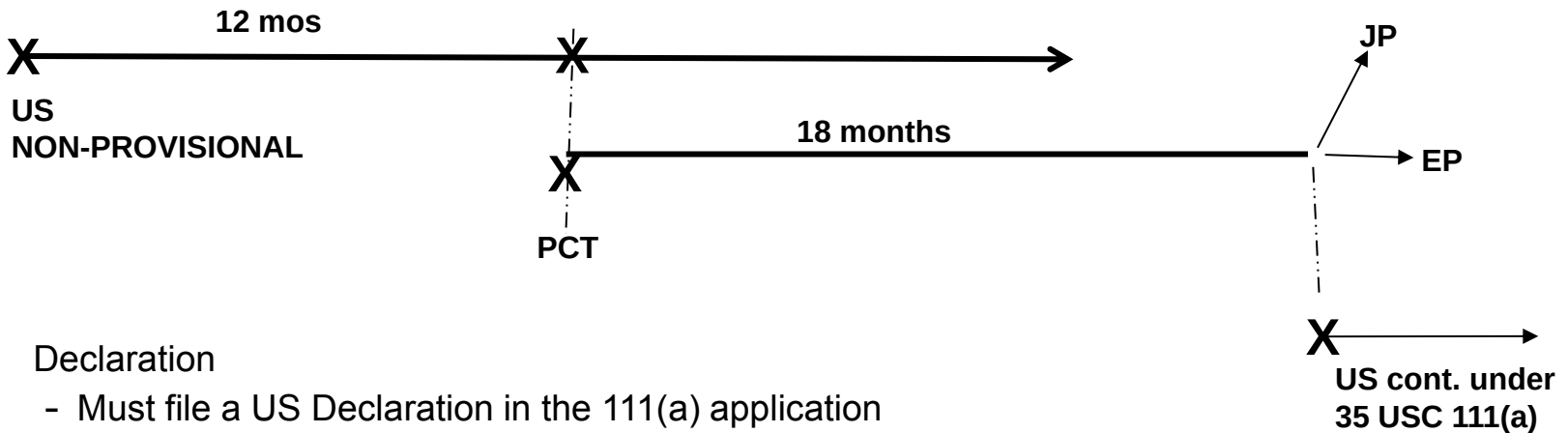


- Declaration
 - Can file
 - Box No. VIII(iv) Declaration of Inventorship sheet of the Request form during the International Phase or
 - US Declaration in the 371 National Phase Application
- “Pedigree”
 - Must include domestic benefit claim to the earlier US non-provisional, e.g., where the PCT is a CIP of the earlier US non-provisional, either
 - in Supplemental Box, item 3* or
 - in Application Data Sheet
- Basic national fee
 - Must pay on entry

* USPTO will get domestic benefit data from the face of WO publication

US Non-Provisional-PCT-US Continuing (bypass) Application

- **By-Pass**

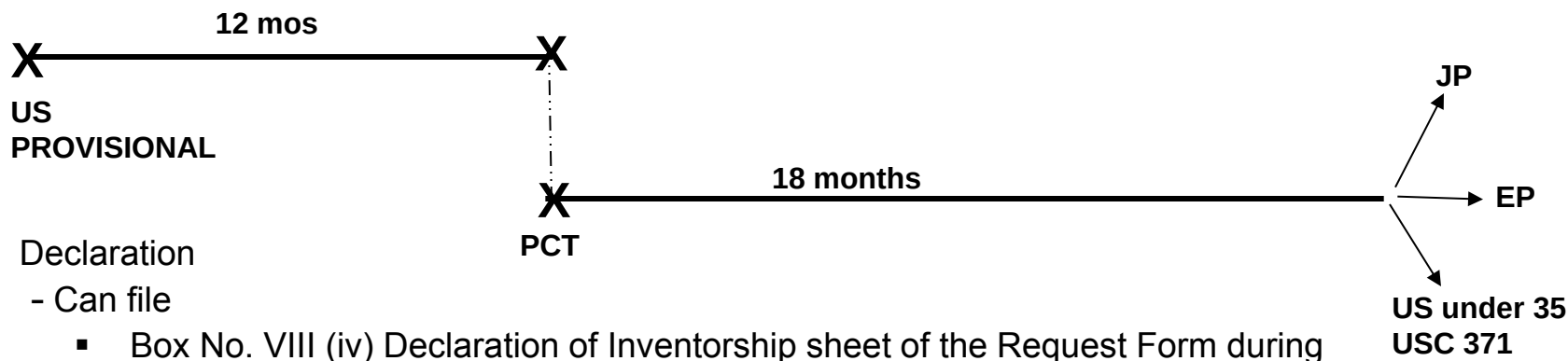


- Declaration
 - Must file a US Declaration in the 111(a) application
- “Pedigree”
 - Must make domestic benefit claim to earlier US non-provisional and PCT in Application Data Sheet, a continuation of PCT which is, e.g., a CIP of the earlier US non-provisional
 - Must have filled out Supplemental Box, item 3 when filing PCT
- Fees
 - Can be delayed

US Provisional-PCT-371 US National Phase Application

When entering into the US from the PCT-Provisional Priority

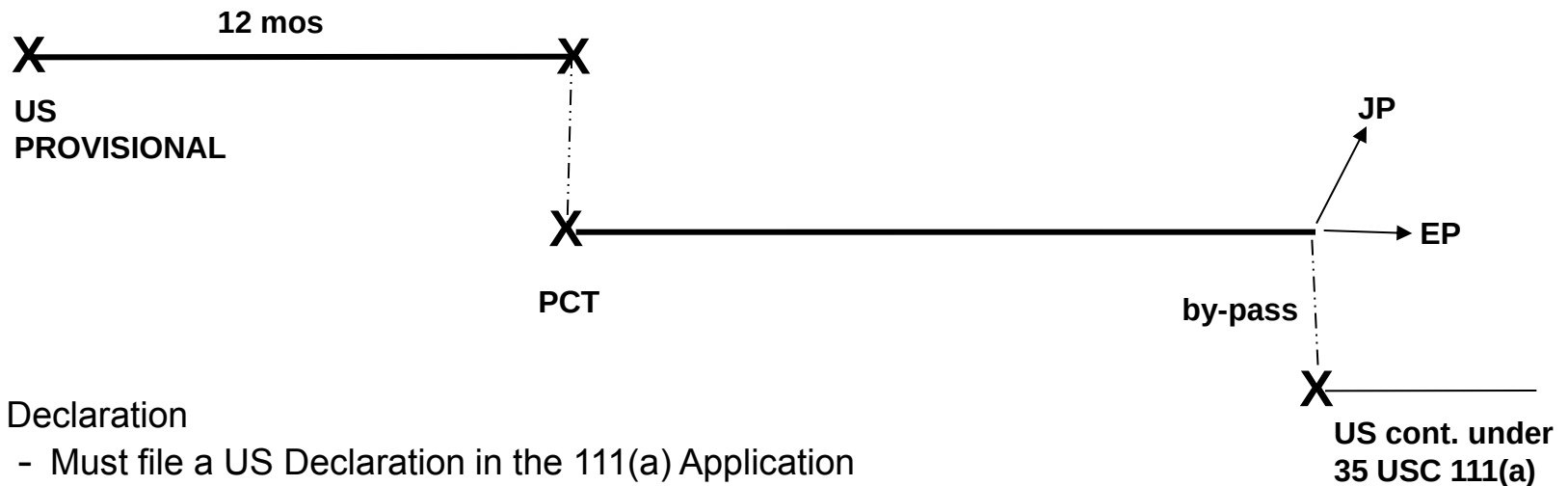
- **National Phase Entry**



- Declaration
 - Can file
 - Box No. VIII (iv) Declaration of Inventorship sheet of the Request Form during the International Phase or
 - US Declaration in the 371 National Phase Application
- “Pedigree”
 - Must include domestic benefit claim to earlier US provisional either
 - in Box No. VI of the Request Form as a priority claim or
 - in Application Data Sheet
- Basic national fee
 - Must be paid on entry

US Provisional-PCT-US Continuing (bypass) Application

- **By-Pass**



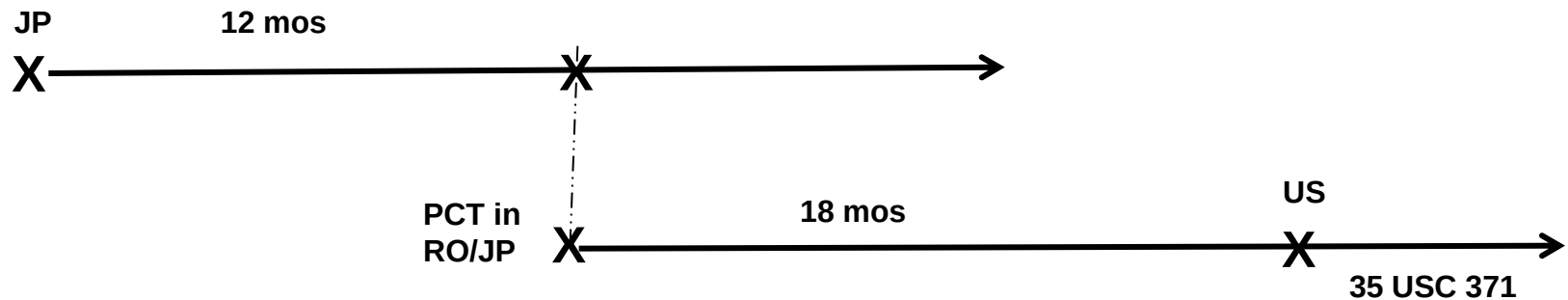
- Declaration
 - Must file a US Declaration in the 111(a) Application
- “Pedigree”
 - Must make domestic benefit claim to earlier US provisional and PCT in Application Data Sheet, where this application is a continuation of the PCT which claims benefit of the earlier US provisional
- Fees
 - Can be delayed

PCT FILING BY FOREIGN ENTITY

- Can file PCT in RO/US as long as one applicant is indicated as a national or resident of US, or
- Can name a person who is a US national or US resident as an “applicant of convenience” on the Request form

FILING IN US – FOREIGN PRIORITY AND PCT

National Phase Entry



- Declaration
 - Can file
 - Box No. VIII(iv) Declaration of Inventorship sheet of the Request form during the International Phase or
 - US Declaration in the 371 National Phase application
- “Pedigree”
 - USPTO will get Foreign Priority claims from the face of the WO publication
- Basic national fee
 - must be paid on entry

- List foreign priority in Request Form

Box No. VI PRIORITY CLAIM				
The priority of the following earlier application(s) is hereby claimed:				
Filing date of earlier application (day/month/year)	Number of earlier application	Where earlier application is:		
		national application: country or Member of WTO	regional application: * regional Office	international application: receiving Office
item (1) 25 JANUARY 2012 (25.01.12)	IT XXXXXX	IT		
item (2)				
item (3)				

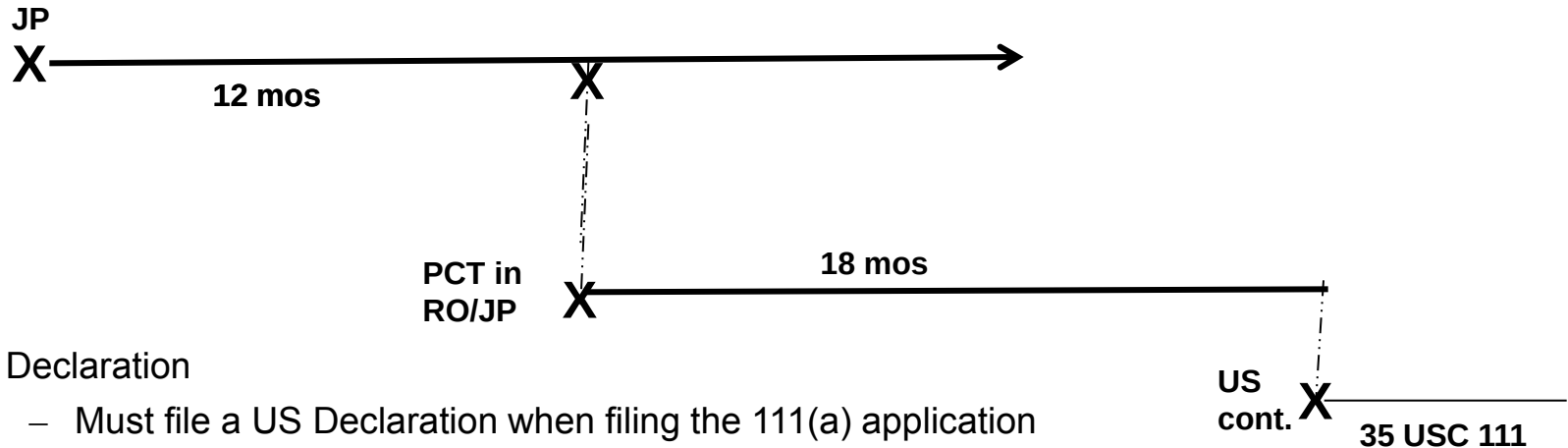
☐ Further priority claims are indicated in the Supplemental Box.

The receiving Office is requested to prepare and transmit to the International Bureau a certified copy of the earlier application(s) (only if the earlier application was filed with the Office which for the purposes of this international application is the receiving Office) identified above as:

☐ all items ☐ item (1) ☐ item (2) ☐ item (3) ☐ other, see Supplemental Box

* Where the earlier application is an ARIPO application, indicate at least one country party to the Paris Convention for the Protection of Industrial Property or one Member of the World Trade Organization for which that earlier application was filed (Rule 4.10(b)(ii)).

By-Pass



- Declaration
 - Must file a US Declaration when filing the 111(a) application
- “Pedigree”
 - Must claim Foreign Priority under 35 USC 119(a)-(d) to the earlier JP application and domestic benefit to the PCT in Application Data Sheet, as this is a continuation of the PCT
 - Must file a certified copy of foreign patent application (unless Office of priority country is a DAS/PDX Participating Office)
- Fees
 - Can be delayed

SUMMARY

- Benefit of a Provisional application is made under 35 USC 119(e)
- Benefit of a Non-Provisional application is made under 35 USC 120
- Use of Application Data Sheet to claim priority to all foreign applications claimed during the International Phase or domestic benefit of all US provisional and US non-provisional applications under 35 USC 119 (e) and 35 USC 120, respectively (i.e. Application No., filing date, and relationship)
 - Mandatory for bypass
 - May not be necessary for national phase entry but recommended
- By-pass applications are continuing applications (con's, c-i-p's or div's) under 35 USC 120, 121 and 365(c).

CONCLUSION

- Many available filing strategies for use of PCT
- Examine which way is best for particular cases and particular applicants
- Must become familiar with procedures of using each strategy

FOR MORE INFORMATION

- MPEP Section 211.01(a) on claiming the benefit of a provisional application
- MPEP Section 211.01(b) on claiming the benefit of a non-provisional application
- MPEP Section 211.01(c) on claiming the benefit of an international application designating the US
- MPEP Section 213 on the right of priority of a foreign application
- MPEP Section 213.06 on claiming priority in a national stage application
- MPEP Sections 1895 and 1896 on Continuation, Divisional or CIP application of a PCT designating the US

UTILITY MODELS

An alternative type of protection at national phase entry

- A second-tier patent system that offers a quick, no-examination, inexpensive protection system for inventions that may not meet the traditional patent requirements
 - Available in a considerable number of countries, including China, Germany, Korea, Russia, Ukraine, Japan, Spain, Brazil, Czech Republic, and Australia
 - Benefits from 12-month right of priority
 - Novelty a requirement, but sometimes a relaxed standard of non-obviousness
 - Shorter duration (6-15 years)
 - Registration required
 - Examination only for formalities, not for substance
 - Limited subject matter scope

ALTERNATIVE IP RIGHTS

- Design Patents
- Utility Models
- Trade Secrets
- Inventor's Certificates

**Contact Information for
Samson Helfgott
Director of Patents
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New York, N.Y., 10022
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Samson.Helfgott@kattenlaw.com**

Disclaimer: This presentation does not constitute any specific legal or business advice.

Incorporation by Reference, Restoration of the Right of Priority, Reinstatement of Rights

**Carol Bidwell
July 2014**

Incorporation by reference of missing elements and parts of the international application

■ Objective:

To enable inclusion of accidentally omitted elements or parts that are contained in priority application without affecting the international filing date

- ☐ element = all of the description or all of the claims

- ☐ part = part of the description, part of claims or part or all of pages of drawings

■ Conditions:

- ☐ priority application contains the element or part (Rule 20.6(b))

- ☐ request contains statement of (conditional) incorporation by reference (Rule 4.18)

- ☐ timely confirmation of incorporation by reference (Rules 20.6 and 20.7)

■ Competent Authority: RO

Confirmation of incorporation by reference (1) (Rules 20.6 and 20.7)

- Time limit: 2 months from filing or from invitation to correct (Rule 20.7)
- Documents to be filed (Rule 20.6):
 - ☐ notice of confirmation
 - ☐ missing sheets
 - ☐ copy of earlier application as filed unless priority document already submitted
 - ☐ translation if not in language of international application
 - ☐ indication as to where in the priority document (and translation) the missing sheets are contained

Confirmation of incorporation by reference (2) (Rules 20.6 and 20.7)

- If not all requirements for incorporation by reference are fulfilled (for example, if a missing element or part is not entirely contained in the earlier application):
 - the international application is assigned a later filing date (date of receipt of missing element or part),
 - applicant may request that missing part be disregarded (Rule 20.5(e))

Invitation by RO to correct defect under Article 11(1) (Rule 20.3)

- Where entire description or all claims are missing, the RO invites applicant to either:
 - ☐ furnish a correction under Article 11(2) and international application is accorded a later filing date or,
 - ☐ confirm under Rule 20.6(a) that the element is incorporated by reference under Rule 4.18 and the international filing date is maintained

Effect of incorporation by reference in national phase (Rule 82ter.1(b))

- DOs may, to a limited extent, review decision allowing the incorporation by reference
- Declarations of incompatibility with national law (reservations) were made by a number of ROs and DOs
See WIPO web site at:
http://www.wipo.int/pct/en/texts/reservations/res_incomp.html

Incorporation by reference

Declarations of incompatibility with national law

- The following Offices have notified the International Bureau of the incompatibility of Rules 20.3(a)(ii) and (b)(ii), 20.5(a)(ii) and (d), and 20.6 with its national/regional law:

- ☐ Incompatibility as RO (Rule 20.8(a)):

BE, CU, CZ, DE, ID, IT, ~~JP~~^{*}, KR, MX

- ☐ Incompatibility as DO (Rule 20.8(b)):

CN, CU, CZ, DE, ID, ~~JP~~^{*}, KR, LT, MX, TR

* JP withdrew its reservation with effect from 1 October 2012; the withdrawal applies to international applications filed on or after 1 October 2012

Restoration of the right of priority

- Competent Authorities:
 - RO during the international phase (Rule 26*bis*.3)
 - DO during the national phase (Rule 49*ter*.2)

Criteria for restoration of the right of priority

- Two possible criteria for restoration:
 1. failure to file the application within the priority period occurred in spite of due care required by the circumstances having been taken
 2. failure to file the application within the priority period was unintentional
- All Offices must apply at least one of these criteria and may apply both; designated Offices may also apply a more favorable criterion in accordance with their national law
 - ☐ RO/US will apply the unintentional criterion only
 - ☐ RO/IB will apply both criteria

Restoration by RO (Rule 26*bis*.3)

■ Conditions:

- ☐ request to restore must be filed with the RO
- ☐ time limit: within a period of 2 months from the date of the expiration of the priority period
- ☐ filing of statement of reasons for failure to comply with the time limit
- ☐ statement should preferably be accompanied by a declaration or other evidence to support such statement
- ☐ where applicable, payment of the required fee
 - RO/US fee for requesting restoration is \$1700*
 - RO/IB does not charge a fee for requesting restoration

* Reducible by 50% for small and micro-entities

Effects if priority right is not restored by RO (Rule 26bis.3)

- Any priority claim to an earlier application filed less than 14 months before the international filing date
 - ☐ will not be declared void even if priority is not restored by the RO
 - ☐ will serve as a basis to calculate time limits during the international phase
- The validity of such a priority claim in the national phase is not assured

Effect of RO restoration in the national phase (Rule 49ter.1)

- RO restoration based on the “due care” criterion is effective in all DOs
- RO restoration based on the “unintentional” criterion is effective in those DOs which apply that criterion (or a more lenient one)
- RO restoration is not conclusively binding on DOs: limited review by DOs is possible
- RO refusal to restore is not binding on DOs
- Declarations of incompatibility with the national law (reservations) can be found on the WIPO website at:
www.wipo.int/pct/en/texts/reservations/res_incomp.html
- A chart of the restoration of the right of priority by ROs and DOs can be found on the WIPO website at:
www.wipo.int/pct/en/texts/restoration.html

Reservations to restoration of priority

- The following Offices have notified the International Bureau of the incompatibility of Rule 26*bis*.3(a) to (i), Rule 49*ter*.1(a) to (d) and/or Rule 49*ter*.2(a) to (g) with their national/regional law:
 - ❑ Incompatibility as RO (Rule 26*bis*.3(j)):
BE, BR, CO, CU, CZ, DE, DZ, GR, ID, IN, IT, JP, KR, NO, PH
 - ❑ Incompatibility of the effect of decision of RO on DO (Rule 49*ter*.1(g)):
BR, CA, CN, CO, CU, CZ, DE, DZ, ID, IN, JP, KR, LT, MX, NO, PH, TR, ~~US~~ *
 - ❑ Incompatibility as DO (Rule 49*ter*.2(h)):
BR, CA, CN, CO, CU, CZ, DE, DZ, ID, IN, JP, KR, MX, NO, PH, TR, ~~US~~ *

* The Official Notices (PCT Gazette) of 3 April 2014 announced that the US withdrew its reservation with effect from 18 December 2013

Reinstatement of rights by DO/EOs (Rule 49.6) (1)

- Available in certain DO/EOs, where the applicant has missed the time limit under Article 22 or 39(1) to enter the national phase:
 - ☐ unintentionally
 - or, at the option of the Office,
 - ☐ in spite of due care required by the circumstances
- Applicants may submit a request for reinstatement and enter the national phase within:
 - ☐ 2 months from the date of removal of the cause of the failure to meet the time limit to enter national phase; or
 - ☐ 12 months from the date of expiration of the time limit to enter national phase;whichever period expires first

Reinstatement of rights by DO/EOs (Rule 49.6) (2)

- Longer time limits and/or further requirements may apply depending on the applicable national law
- For further details, see for each DO/EO, the relevant National Chapter in the PCT Applicant's Guide, National Phase

DO/EOs to which Rule 49.6 does not apply

- Notifications of incompatibility with respective national law were filed in accordance with Rule 49.6(f) :

CA Canada	LV Latvia
CN China	MX Mexico
DE Germany	NZ New Zealand
IN India	PH Philippines
KR Republic of Korea	PL Poland

- Nevertheless the national law applicable by some of these Offices may provide for other forms of protection against loss of rights
 - for further details, see the relevant National Chapter in the PCT Applicant's Guide, National Phase for each DO/EO

Entry Into The U.S. National Phase



Michael A. Neas

Deputy Director

International Patent Legal Administration



35 U.S.C. 371 (c) Requirements

- (1) National stage fees
- (2) Copy of the IA* and an English translation (if not in English)
- (3) Copy of Article 19 amendments and translation (if not in English)
- (4) Oath or declaration of inventor(s)
- (5) Translation of annexes** to the IPER (if not in English)

* not required if the IA was filed in RO/US or published by the IB

** amendments that formed the basis of the Report

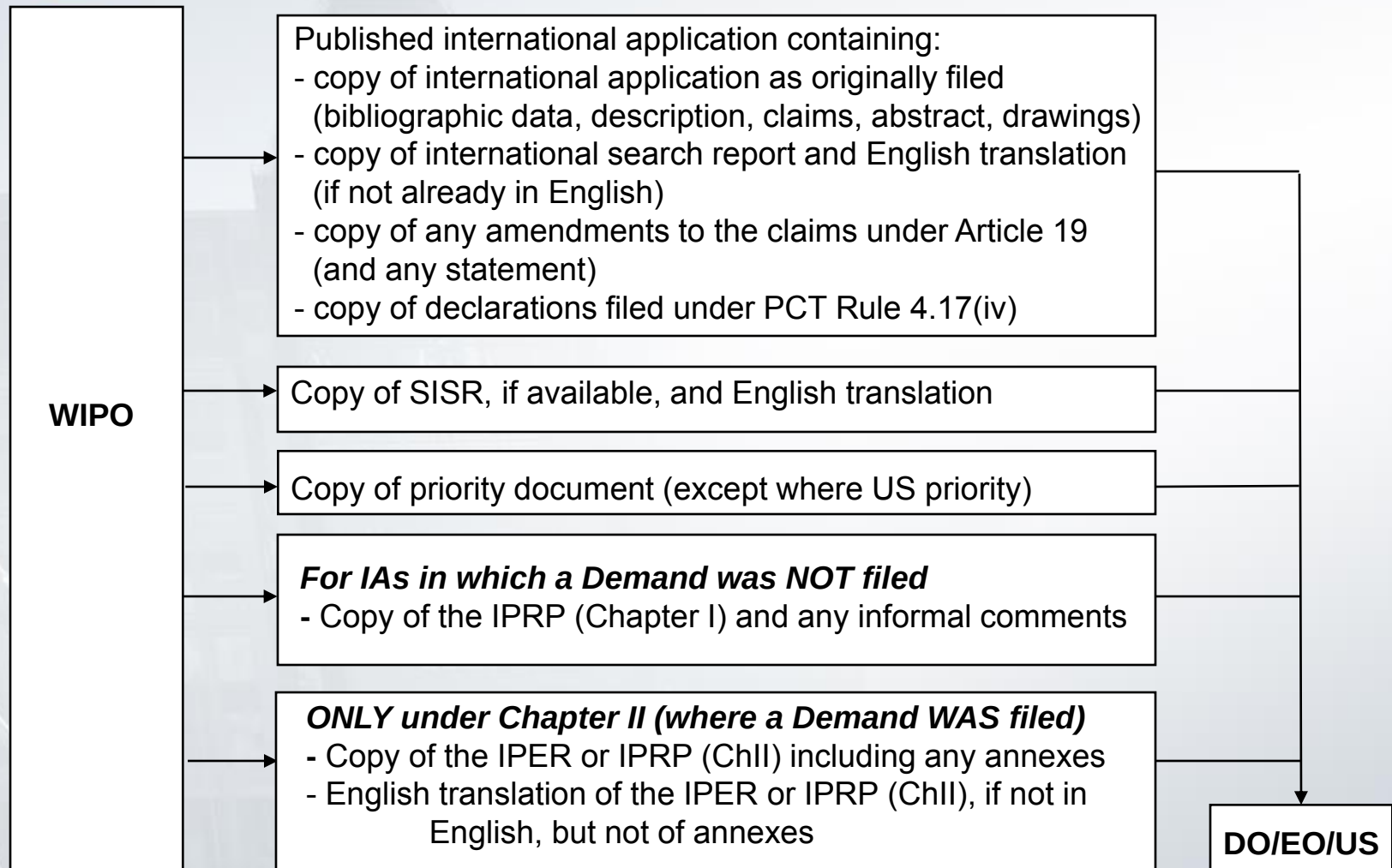


Commencement of U.S. National Stage

- 30 months from earliest priority date
 - from either Chapter I or Chapter II
 - 37 CFR 1.495
- Early commencement
 - at applicant's express request
 - 35 U.S.C. 371(f)
- See PCT Applicant's Guide, National Stage, National Chapter (US)



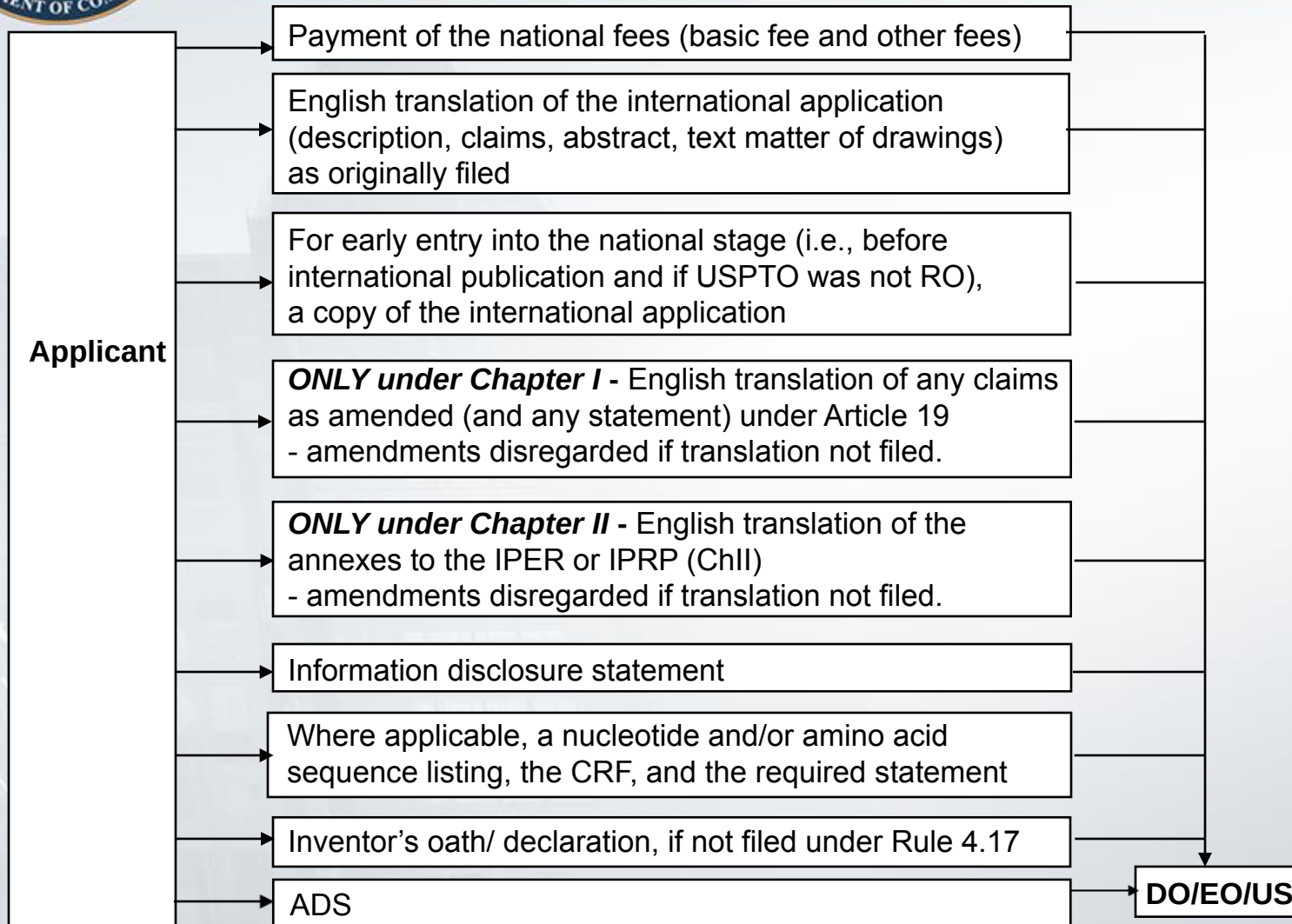
Entry into National Stage WIPO Transmission to DO/EO/US





Entry into National Stage

Applicant Submission to DO/EO/US





National Stage Fees (1)

- Basic national fee..... \$280*
- Search Fee
 - WO of the ISA/US or IPER prepared by the IPEA/US indicates that all claims satisfy the provisions of Article 33(1)-(4)**.....\$0
 - international search fee paid to USPTO as ISA.....\$120*
 - ISR prepared by an ISA other than the US and provided to US or previously communicated to the US by the IB.....\$480*
 - all other situations.....\$600*

*reducible by 50% for small entity and 75% for micro entity

**novelty, inventive step and industrial applicability



National Stage Fees (2)

- Examination fee
 - WO of the ISA/US or IPER prepared by the IPEA/US indicates that all claims satisfy the provisions of Article 33(1)(4)**\$0
 - all other situations.....\$720*

*reducible by 50% for small entity and 75% for micro entity

**novelty, inventive step and industrial applicability



Other National Stage Fees

- For each independent claim in excess of 3..... \$420*
- For each claim in excess of 20..... \$80*
- For each application containing a multiple dependent claim..... \$780*
- For every 50 sheets or fraction thereof of the SPEC and DRW that exceeds 100 sheets (excluding any sequence listing or computer program listing filed in electronic medium)..... \$400*

*reducible by 50% for small entity and 75% for micro entity



English Translation of the International Application

- May be filed
 - by 30 months from the priority date
 - in response to a Notice of Missing Requirements
 - time limit set in Notice may be extended under 37 CFR 1.136(a)
 - after the 30-month date
 - with processing fee of \$140
 - reducible by 50% for small entity and 75% for micro entity
- Translation must be an accurate translation of the international application as originally filed
 - no changes permitted



Copy of Article 19 Amendments* and English Translation

- Due by 30 months from the priority date
- Canceled if translation not timely submitted
 - may still be made by preliminary amendment

* copy of the Article 19 amendment not required if communicated to the DO/EO/US by the IB



Oath or Declaration

- May be filed as
 - part of the PCT Request form, that is, Box No. VIII (iv), or within the time period set in PCT Rule 26*ter*
 - IB will provide DO/EO/US with PCT Request declaration of inventorship sheets upon national stage entry
 - USPTO generated
 - form PTO/SB/01 or PTO/SB/01A (pre-AIA (Oath/Dec))
 - form PTO/AIA/01 or PTO/AIA/08 (AIA (Oath/Dec))
 - applicant created form
 - for AIA (Oath/Dec) applications
 - substitute statements
 - assignment as the oath/declaration



Time for Filing of Oath/Declaration (Pre-AIA (Oath/Dec))

- By 30 months from the priority date
- In response to Notice of Missing Requirements
 - time limit set in Notice may be extended
 - (37 CFR 1.136(a))
- After 30 months from the priority date
 - with a surcharge of \$140 (37 CFR 1.492(h))
 - reducible by 50% for small entity and 75% for micro entity



Time for Filing of Oath/Declaration (AIA (Oath/Dec))

- May file after 30 months from the priority date
 - with a surcharge of \$140* (37 CFR 1.492(h))
 - reducible by 50% for small entity and 75% for micro entity
- May postpone submission until application is in condition for allowance (37 CFR 1.492(c))
 - if an ADS is filed identifying
 - each inventor by his or her legal name
 - for each inventor, a mailing address where the inventor customarily receives mail
 - and residence, if the inventor lives at a location different than the mailing address
 - if postponed, must be filed no later than the time period set in the “Notice of Allowability” to avoid abandonment



English Translation of Annexes to the IPRP (Chapter II)

- Due by
 - 30 months from the priority date or
 - within any time period set to furnish
 - translation of application
 - oath or declaration
 - any outstanding national stage fee
- Canceled if not timely submitted
 - may still be made by preliminary amendment
- If provided after 30-month date
 - processing fee of \$140
 - reducible by 50% for small entity and 75% for micro entity



37 CFR 1.492(h)

- A surcharge of \$140 is required if any of
 - the search fee
 - the examination fee
 - the oath or declarationis filed after the date of commencement
 - the surcharge is reducible by 50% for small entity and 75% for micro entity



Abandonment in the United States

- Abandonment results from failure to
 - submit by the 30-month date
 - basic national fee
 - a copy of the international application
 - if not published by the IB or
 - if not filed in RO/US
 - timely furnish
 - the proper reply to the Notice of Missing Requirements and other notices
- May be possible to revive (37 CFR 1.137)



Preliminary Amendments

- Made in accordance with 37 CFR 1.121
 - may be used in lieu of translating
 - Article 19 amendment and/or annexes to the IPER
 - to eliminate multiple dependent claims
 - to reduce the number of claims
- See ***PCT Applicant's Guide – National Stage - National Chapter – US, The Procedure in the National Phase, paragraph US.34***
 - for details regarding amendments and claim status identifiers
 - <http://www.wipo.int/pct/guide/en/gdvol2/annexes/us.pdf>



Dates in a National Stage Application

- International filing date
- 35 U.S.C. 371(c) date



International Filing Date

- 35 U.S.C. 363 states that
 - an IA designating the United States shall have the effect,
 - from its IFD,
 - of a national application for patent regularly filed in the Patent and Trademark Office



35 U.S.C. 371(c) Date

- Pre-AIA (Oath/Dec)
 - date of completion of 35 U.S.C. 371(c)(1), (2), (4) requirements
 - date listed as the “filing or 371(c) date” on the filing receipt
- AIA (Oath/Dec)
 - the “filing or 371(c) date” on the filing receipt no longer based on date of receipt of oath/declaration



Foreign Priority Claims in a National Stage Application

- Under 35 U.S.C 365(b) - must be in accordance with
 - 35 U.S.C 119(a)
 - the PCT and its Regulations
- Must have been made
 - in Box No. VI of the Request, or
 - within the time limit set forth in PCT Rule 26*bis*
- Can be added during the national stage on petition under 37 CFR 1.55(e)



Certified Copy of Foreign Application

- WIPO will provide a copy to DO/EO/US
 - if timely filed during the international stage
 - the copy satisfies the requirement of 37 CFR 1.55(f)(2)
 - the Notice of Acceptance will indicate presence
- If a certified copy was not filed during the international stage
 - applicant will be given the opportunity to provide one during the national stage
 - see 37 CFR 1.55(f)(2)



Domestic Benefit Claims in National Stage Application

- Domestic benefit may be claimed to
 - a provisional application under 35 U.S.C. 119(e)
 - a non-provisional application under 35 U.S.C. 120 or 35 U.S.C. 121
 - an IA designating the US under 35 U.S.C. 365(c)



How to Claim Domestic Benefit

- In the PCT Request form
 - or as otherwise shown on the front page on the international publication

OR

- On an Application Data Sheet within the later of
 - 4 months from commencement
 - 4 months from the initial submission under 35 U.S.C. 371
 - 16 months from the filing date of the prior application



Restoration of Right of Priority

- Restoration of right of priority is now effective for all applications in the U.S.
 - since 18 Dec 2013, the effective date for the PLT provisions of the Patent Law Treaties Act of 2012
- Restoration by RO/US or any other RO under unintentional or due care standards
 - is effective in U.S. national stage applications



Restoration of Right of Priority in the International Stage

- For an IA filed on/after 01 Apr 2007
 - international filing date may be
 - more than 12 months from the priority date, but
 - within 2 months of the expiration of the priority period
 - under the PCT, a priority claim that is restoration eligible
 - establishes the PD for timeline purposes
 - remains in the IA, despite
 - failure to request restoration or refusal of a request for restoration



Restoration of Right of Priority in the National Stage

- Where priority was restored in the IA, the restoration is valid in the corresponding §371 application
 - form PCT/RO/159 issued during international phase
- Where priority was not restored in the IA, applicant can petition to
 - restore the right of priority to a foreign application
 - 37 CFR 1.55(c)
 - restore domestic benefit to a provisional application
 - 37 CFR 1.78(b)
 - The delay in filing the international application must have been unintentional



Restriction

- The unity of invention standard is applied
 - for restriction in a national stage application
 - more claims may be kept together if multiple inventions present

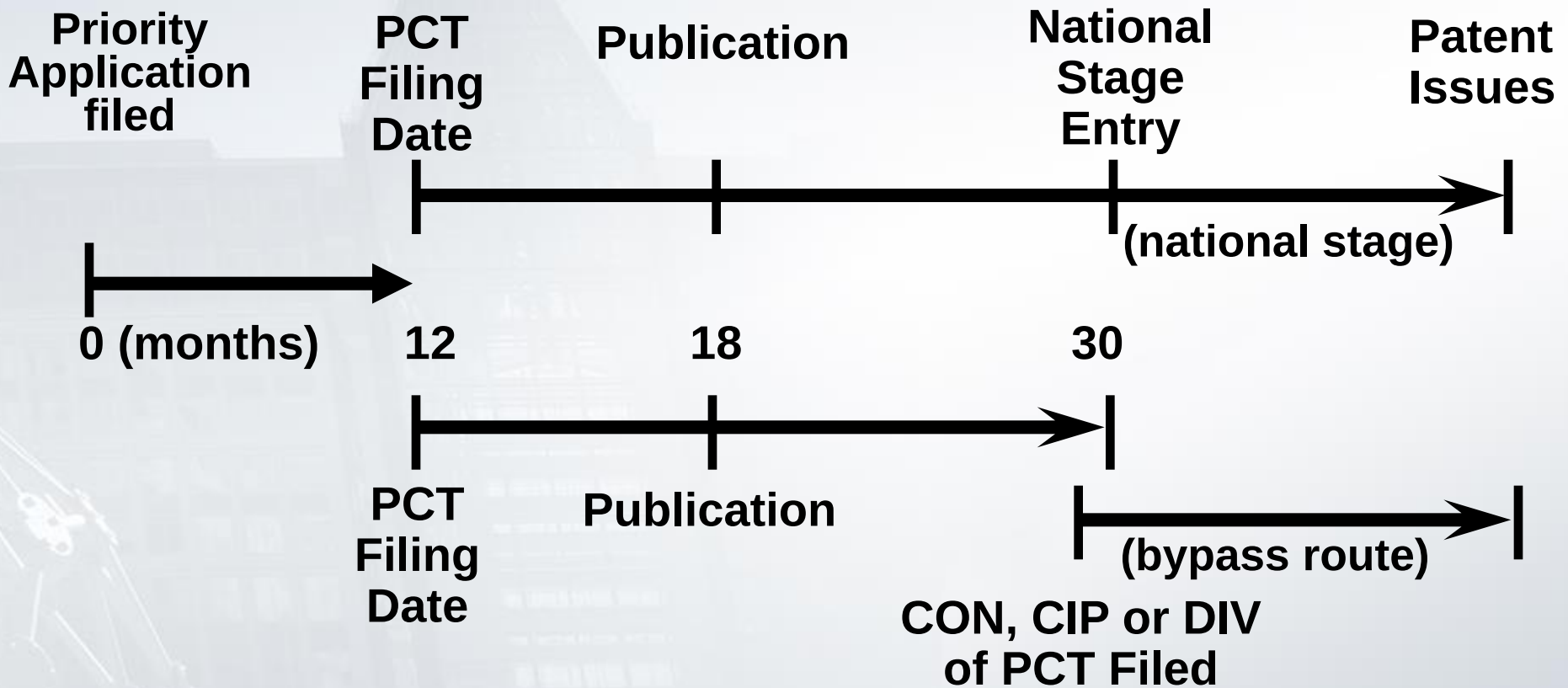


“Bypass Route” an Alternative to 35 U.S.C. 371

- A U.S. application under 35 U.S.C 111(a)
 - can claim benefit under
 - 35 U.S.C 365(c), 35 U.S.C 120, or 35 U.S.C. 121
 - of an IA that designates the US
- See MPEP sections 1895 and 1896



National Stage vs. Bypass Route





Conflicting Instructions

111(a) or 371

- Prior to 16 Sept 2012
 - an initial application submission containing conflicting information as to treatment under 35 U.S.C. 111(a) or 371 was treated as a new U.S. national patent application under 35 U.S.C. 111(a)
- On or after 16 Sept 2012
 - an initial application submission containing conflicting information as to treatment under 35 U.S.C. 111(a) or 371 will be treated as a U.S. national stage application under 35 U.S.C. 371
- 37 CFR 1.495(g)



Advantages of Bypass Route

- Exact translation of the international application not required
- New matter may be added to the disclosure by filing a CIP
- Extension of time for payment of basic filing fee (37 CFR 1.136(a))
- Foreign priority claim omitted in the IA may be added (37 CFR 1.55) without petition
- For international applications filed before 16 September 2012, Substitute statement can be filed as opposed to
 - status under 37 CFR 1.42 (deceased inventor) where legal rep cannot be identified or won't sign
 - petition under 37 CFR 1.47 (refuse to sign or cannot locate)
- Track 1 Prioritized Examination and Accelerated Examination procedures available



Disadvantages of Bypass Route

- A complete application must be filed
 - including any required formal drawings
 - Certified copies of any foreign priority documents must be filed *
 - Restriction based on the U.S. independent and distinct standard
 - instead of broader unity of invention standard
 - Petition under 37 CFR 1.78(d) required for benefit claim where
 - the IA claims benefit but does NOT specify its relationship to the earlier application filed under 35 U.S.C. 111(a)
- * EPO, JPO, and KIPO priority documents normally retrieved automatically via Priority Document Exchange Program (PDX)
- * AU, CN, DK, ES, FI, GB, SE and RO/IB priority documents can be retrieved automatically via WIPO's Digital Access Service (DAS)



Advantages of National Stage Entry Under 35 U.S.C. 371

- Restriction standard is unity of invention
 - more claims/inventions may stay together
- Ease of filing
 - applicant provides
 - transmittal letter
 - fees
 - IB provides
 - copy of the IA (if nationalized after publication)
 - priority document (if provided to IB at international stage)
 - ISR & IPRP
- Search fee and examination fees may be \$0
 - where WO of ISA/US or IPER of IPEA/US indicates all claims satisfy the criteria of Article 33(1)-(4)



Disadvantages of National Stage Entry Under 35 U.S.C. 371

- Cannot add subject matter
 - which goes beyond the IA as filed
- Literal English translation of IA required
- May need extensive preliminary amendment
 - clean up translation
 - reduce/eliminate multiple dependent claims
- Must pay basic national fee by 30 months



Helpful Hints (1)

- Use the national stage transmittal letter (PTO-1390)
 - two versions available
 - one with transition application check box for international applications filed on or after 16 March 2013
- Do not wait for a Notice of Missing Requirements (PCT/DO/EO/905)
 - supply the additional fees, translations, etc. as soon as possible
 - filing Receipt and Notification of Acceptance (Form PCT/DO/EO/903) issued more quickly
- File assignments using the Electronic Patent Assignment System (EPAS)
 - ensures timely recordation
 - EFS-Web Legal Framework does not allow the filing of assignments via EFS-Web
 - access EPAS via www.uspto.gov



Helpful Hints (2)

- Check PAIR and Notification of Acceptance (PCT/DO/EO/903)
 - to ensure that DO/EO received certain documents
 - e.g. preliminary amendment, IPER with Annexes, priority document, etc.
- If submitting translation of the annexes
 - ensure the translated annexed sheets can replace page by page of the translated application sheets



Helpful Hints (3)

- List the references on an IDS and
- Provide copies of any non-U.S. patent documents
 - foreign patent documents
 - Non-Patent Literature (NPL)

To ensure

- consideration of
 - references cited on the ISR/SISR
 - 3rd party observations made at international stage
- reference citation on any resulting patent

Tab 12B

Strategies for National Filing

Carl Oppedahl
Oppedahl Patent Law Firm LLC
www.oppedahl.com

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National-stage versus bypass

Is your case at risk of an n-way restriction requirement?

If so, use national stage

The Examiner will have to use unity-of-invention rather than domestic restriction practice

National-stage versus bypass

Missing or uncooperative inventor?

Consider using a bypass because you will be able to use Substitute Statement practice under AIA

National-stage versus bypass

Is your case a mess?

If so, clean up the mess and file it as a bypass
continuation

National-stage versus bypass

Do you want to add new matter?

If so, add the new matter and file it as a bypass
continuation-in-part

National-stage versus bypass

Do you want to take advantage of an opportunity to file without having to pay the money?

If so, file it as a bypass continuation

Have a favorable Written Opinion
or IPRP from an eligible ISA or
IPEA?

AT, AU, CA, CN, DK, EP, ES, FI, GB,
HU, IL, IS, JP, KR, NO, PT, RU, SE, XN

Use PCT-PPH

National-stage versus bypass

Recall the certified copies of the priority documents

You get to skip this if you use national stage

National-stage versus bypass

USPTO gives a filing-fee discount for those who
e-file (if they are a small entity)

But not for national-stage filings!

Scenarios

30-month time draws near, but there is already a pending US case

It may be smart to enter the US national stage anyway

You never know when you may run into an n-way restriction requirement in the pending US case

You never know when the pending US case may get abandoned by accident

(but see next slide)

The “short list” – the bare minimum to avoid abandonment at 30 months

Provide the PCT application number.

Pay base national-stage filing fee.

A copy of the IA if USPTO does not already have it. Note that if it was published at 18 months, USPTO almost certainly already has it. Note that if USPTO was the RO, then USPTO already has it.

So the likely bare minimum is to use EFS-Web, provide the PCT application number, check the national-stage box, pay the base fee.

The “long list” – what it takes to avoid a notice of missing requirements

All necessary fees (search fee, exam fee, extra claims fee, page count fee)

Translation of the application into English

Translation of the Annexes to the Chapter II IPRP, if any

Trap for the unwary – blanket fee authorizations

Some firms and patent departments choose to include with any new filing at USPTO a blanket authorization to charge any and all fees to a deposit account.

If you feel you must do this in an entry into the US national phase, then be vigilant about getting your preliminary amendment into the case by the date that DO/EO will commence processing of the case.

That date is the priority date plus 30 months, or the date that you expressly request national-stage processing, whichever is earlier.

If you don't pay attention to this, you can end up with USPTO charging extra-claims fees based upon the claims as they existed in the international phase ... and you will not be able to get those fees back

The better approaches are:

- avoid giving a blanket authorization to charge any and all fees to a deposit account, or
- make sure that your preliminary amendment is in the case by no later than the 30-month date (or the date of your express request is made)

National-stage best practices

AIA permits you to play “hide the ball” with your signed inventor declarations until payment of the Issue Fee

Do not do this!

Make sure to e-file your signed inventor declarations as early as possible – for example on the day after filing the IA in the first place

National-stage best practices

See if the foreign agent planned ahead and got a
US-style inventor's declaration signed and filed
(declaration iv of the Request)

It will be visible in PATENTSCOPE

If so, there is no need to get an inventor's
declaration signed now

Thank the foreign agent!

National-stage best practices

Best practice for inventor's declaration is the
“short-form” declaration of form SB01a or
AIA01

This is filed with an Application Data Sheet

National-stage best practices

Best practice is to include an Application Data Sheet in the initial filing (the filing that gets you your domestic application number)

This will auto-populate PALM and thus will auto-populate the continuity data in PAIR

This reduces the risk of keying errors or omissions at USPTO

There is no reason to postpone this. Do it the day after you file the PCT case.

National-stage best practices

File each item as soon as it is available. There is no good reason to postpone such filings to 30 months.

File the IDS as soon as you receive the ISR.

File the Declaration right away.

Record the Assignment right away.

National-stage best practices

Note that you are ***not*** required to provide an opening sentence in the specification reciting the 371 relationship. Nor are you required to provide an opening sentence reciting any domestic benefit claims.

Not only that, an opening-sentence recitation of domestic benefit claims will no longer satisfy Rule 78. You must do this in the ADS.

National-stage best practices

Corporate applicants should require that outside counsel *not* insert power of attorney or correspondence address instructions in the oath or declaration

Such language makes it much more difficult to discharge outside counsel (makes it harder to reuse the oath or declaration in a child case)

Such language risks a conflict of interest as between assignee and inventors

National-stage best practices

Are you entering the US national stage ***prior to*** the end of the 30 months?

Then you should file an “express request to begin national examination procedures” per 35 U.S.C. § 371(f)

What are the consequences of failing to file an “express request to begin national examination procedures”?

The application will sit “on ice” in DO/EO/US until the 30 months has run out

You may lose some Patent Term Adjustment

You will lose your place in line to be examined

Your “371 completion” date will be worse than it could have been

It's not enough merely to request immediate processing!

You also need to actually do everything that is required to perfect national-phase processing (translation, fees)

How do you file an “express request to begin national examination procedures”?

One choice is to file Form PTO-1390, and check box 1
(used to be box 3)

When Form PCT/DO/EO/903 arrives, review it closely to make sure USPTO gave you credit for making the “express request”.

This means reviewing the "371 completion date" on the form

Resources

EFS-Web list serve:

www.oppedahl.com/efswweb

PCT list serve:

www.oppedahl.com/pct

Entering the European Regional Phase, London Agreement, Divisionals & the Unitary European Patent

Thomas Leonard

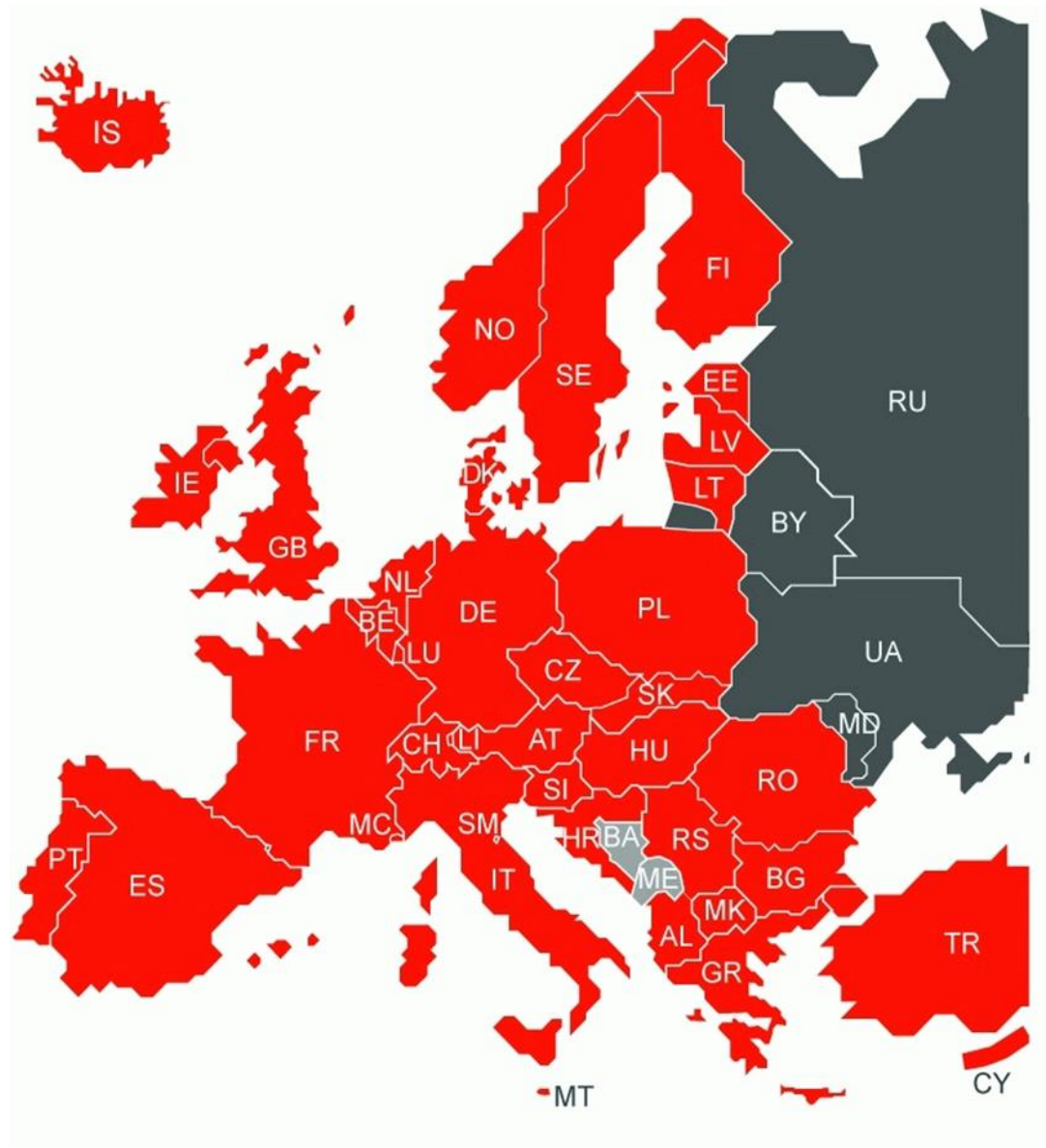
July 2014

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The European Patent Convention

European Patent System

- Single application, handled centrally by EPO
- EPO has offices in Munich, The Hague, Berlin, Vienna, Brussels
- On grant, separate validation in each country (“state”) – bundle of patents
- Contracting states:
AL, AT, BE, BG, CH, CY, CZ, DE, DK, EE, ES, FI, FR, GB, GR, HR, HU, IE, IS,
IT, LI, LT, LU, LV, MC, MK, MT, NL, NO, PL, PT, RO, RS, SE, SI, SK, SM, TR
- Extension states:
BA, ME
- Coming soon:
MA – any guesses?

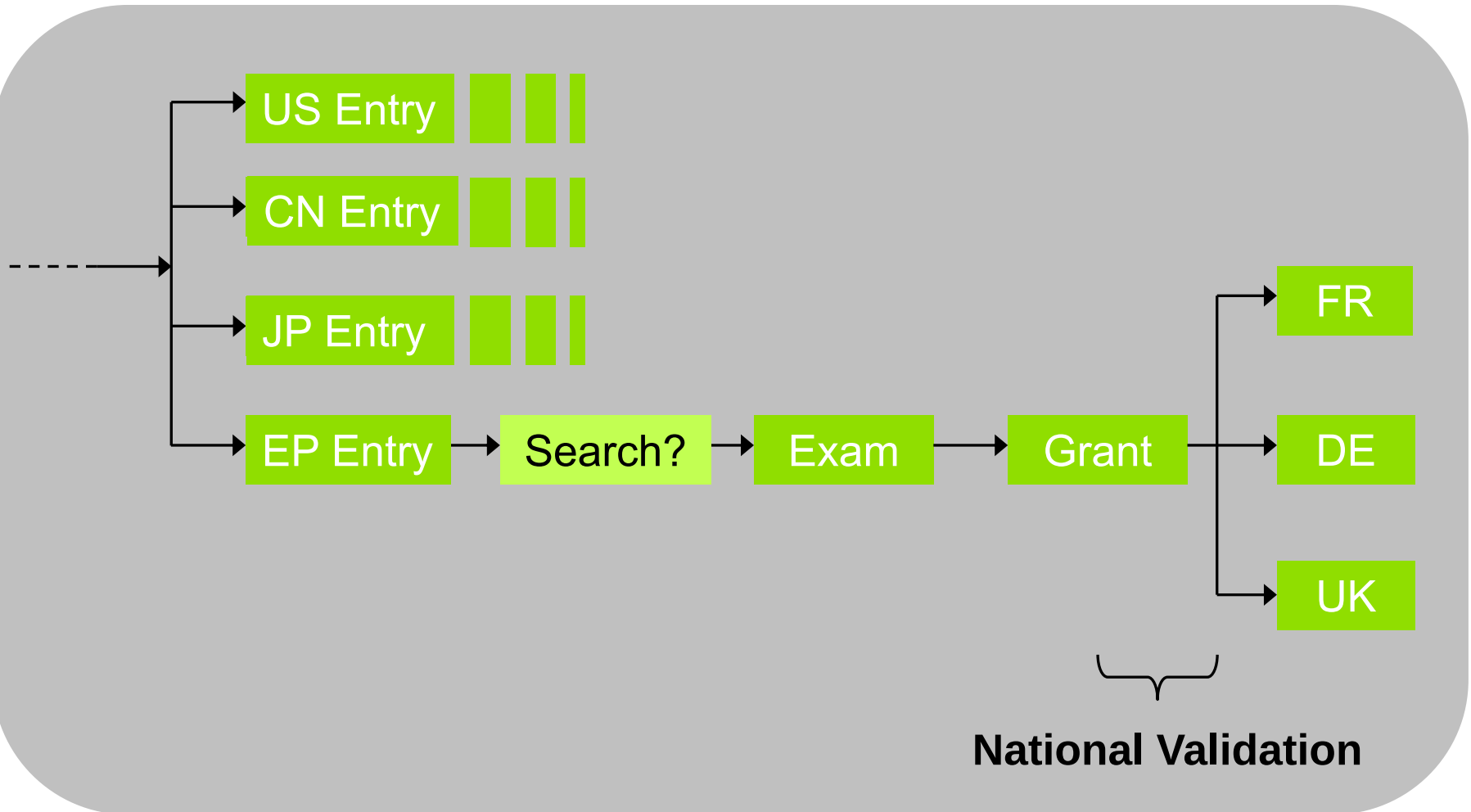


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**EP Regional Phase:
The Basics**

Regional Phase Procedure



Basic Procedure

- Deadline for entry: 31 months
- What has to be filed?
 - Simple form only
 - EP associate needs just the PCT or WO number from you
 - No copy of application needed, unless amendments being filed
 - Translation (if applicable)

Basic Procedure

- Fees due on entry:
 - Filing fee (includes a fee for each page over 35)
 - Search fee (if applicable)
 - Designation fee + extension fees if required (due on entry unless ISR published less than 6 months ago)
 - Examination fee (due on entry unless ISR published less than 6 months ago)
 - Any renewal fees due (due if entry after end of month in which 2nd anniversary of PCT filing date falls)
- Fees due after entry:
 - Excess claims fees (although you can pay them on entry)

Basic Procedure

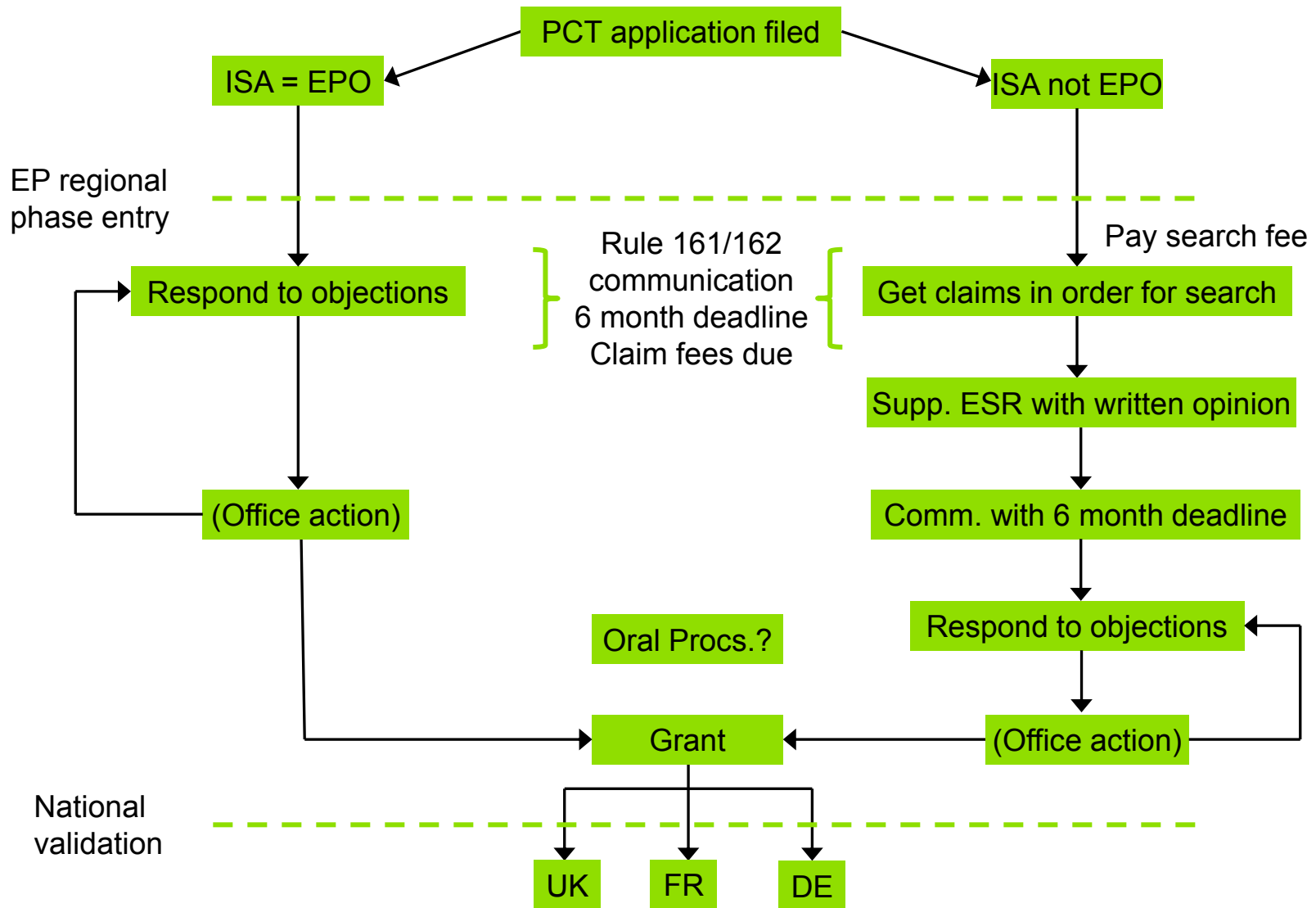
- Search Fee - €1285 (US \$1750)
 - No search in EP phase if EPO was ISA or SISA
 - €190 (US \$260) reduction if ISA or SISA was:
 - US, JP, KR, CN, RU, AU
 - €990 (US \$1350) reduction if ISA or SISA was:
 - AT, FI, ES, SE, XN
- Examination Fee - €1620 (US \$2200)
 - 50% reduction if EPO was IPEA
 - Rises to €1805 (US \$2450) if EPO was ISA but no IPE
- Excess Claims Fees
 - €235 (US \$320) for claims 15 to 49
 - €580 (US \$790) for claims 50+

1

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3

**EP Regional Phase:
Advanced**



EPO = ISA: After Entry

- Requirements:
 - Compulsory response to Written Opinion of ISA/IPEA [Rule 161 EPC]
 - Payment of excess claim fees [Rule 162 EPC]
 - Last opportunity for voluntary amendments
 - Further amendments at discretion of Examining Division
- 6 month period set by Rule 161/162 EPC Communication
 - Issued shortly after EPO entry
- Failure to respond = application deemed withdrawn
 - Further processing available

EPO not ISA: After Entry

- No response to WOISA/IPRP required
- Rule 161/162 EPC Communication sets 6 month period for:
 - Payment of excess claim fees
 - Last opportunity for voluntary amendments
- Supplementary European search carried out on your claims at this stage
 - Important to get claims in order for search – see next slide!

Supplementary European Searches – must get claims in order for search!

- Restrictions on voluntary amendments [Rule 137(2),(3) EPC]
- Multiple independent claims in same category [Rule 62a EPC]
 - Elect one claim in each category to be searched
- No meaningful search possible [Rule 63 EPC]
 - Statement can be filed in response
- Restrictions on amending to unsearched subject matter later [Rule 137 (5) EPC]
- Lack of unity? First mentioned invention only [Rule 164(1) EPC]

A note on Unity

- Only the first mentioned invention will be searched
 - Could include e.g. alternatives in a Markush grouping!
- **No opportunity to pay further search fees**
- But! As of 1st November 2014 the rules are changing such that Euro-PCT and direct European applications are treated equally
 - Will be given the opportunity to pay further search fees
 - Reduces costs for applicants (divisionals not needed)
 - Removes major obstacle to using the EPO as ISA
 - Gives early indication of prospects in EPO and can speed up EPO prosecution after regional phase entry

Tips and Tricks

- Delaying and accelerating entry
- Saving money
- Streamlining prosecution

Quick quick slow...

– **Delaying Entry**

- Further processing can be used
 - If 31 month date missed, letter noting “loss of rights” will issue (sent to applicant)
 - Two-month deadline from date of letter to enter regional phase
- But...50% surcharge on fees

– **Accelerating Entry**

- Complete the usual steps, but early
- Expressly request early regional phase processing
- Waive right to response to Rule 161/162 EPC communication

Saving \$\$\$ Before Entry

- Record any name changes and assignments at IB before 30 month date
- File replacement pages to reduce no. of pages, but note:
 - A4 paper only
 - Minimum text margins: 2.5cm (L), 2cm, 2cm and 2cm
 - 1.5 line spacing
 - Capital letters minimum 0.21cm (11 point Times New Roman is OK)

Saving \$\$\$ on Entry

- Avoid excess claims fees:
 - Use multiple claim dependencies and combine lesser claims
 - Think hard about multiple independent claims in the same category
 - Incorporate claim language into description?
 - EPO has lost money
- Amend claims to a single page
 - Amend claims later under Rule 161

Streamlining Prosecution

- Full response to Written Opinion of ISA/Search Opinion
- Provide detailed basis for amendments [r. 137(4) EPC]
- Use “problem-and-solution approach” to argue inventive step
- Give ground to Examiner in less-important areas?
- Use “auxiliary requests”?
- Speak with the Examiner
- Can ultimately save you money

1

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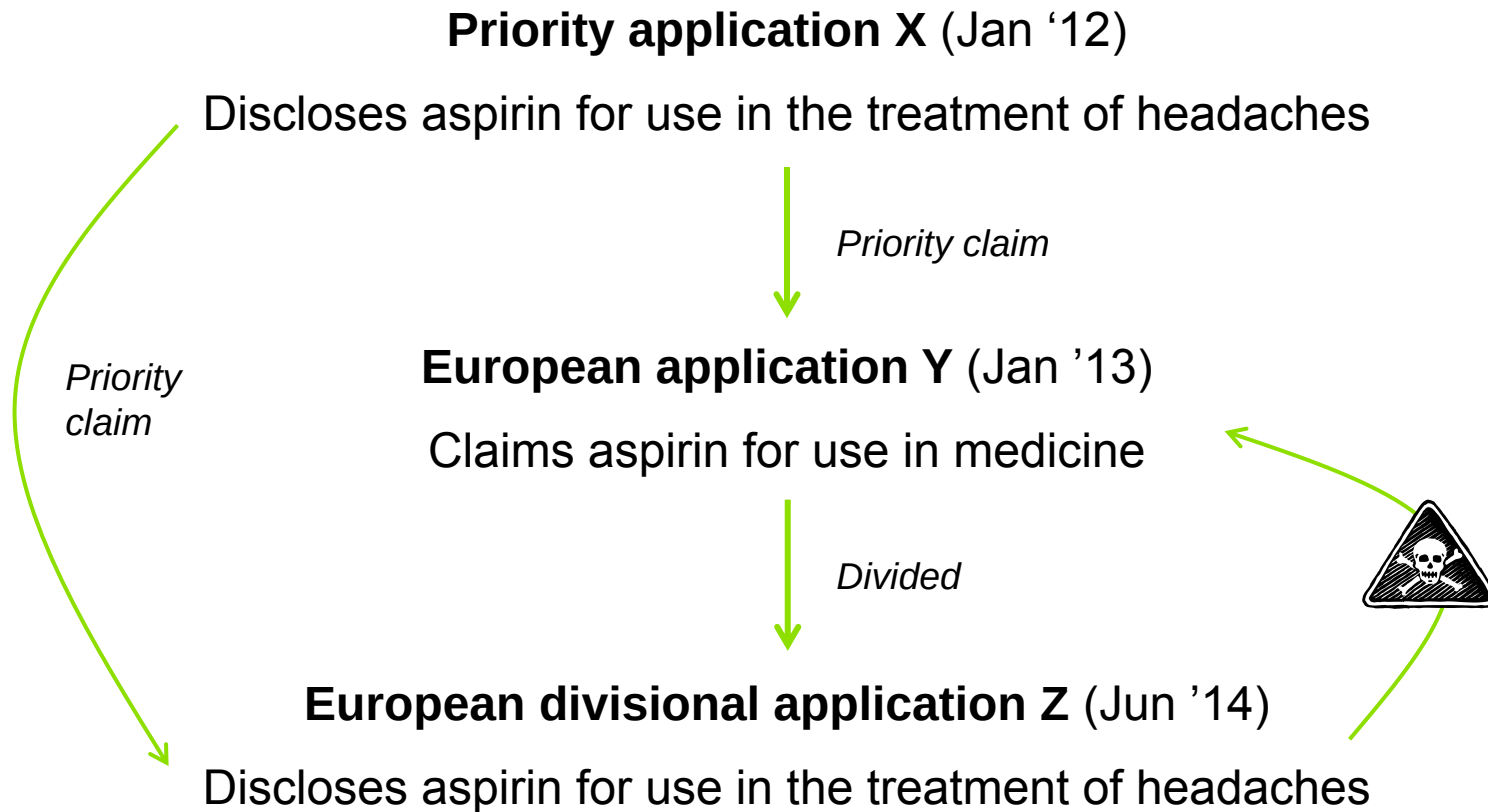
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Divisionals

Divisionals

- Previous two-year deadline for filing divisional applications abolished
- Divisional filing window re-opened for cases where previous two-year deadline had expired
 - Do you need to re-visit those European FTOs?
- Token increase in filing fee for 2nd and subsequent generation divisionals
 - Negligible compared to back renewal fees payable for the divisional

Divisional poisoning (T1496/11; Nestec vs Dualit¹)



¹Nestec SA & Ors v Dualit Ltd & Ors [2013] EWHC 923 (22 April 2013)

Partial priorities: maybe there is no issue at all?

Priority application X (Jan '12)

Discloses aspirin for use in the treatment of headaches



Priority claim

European application Y (Jan '13)

Claims aspirin for use in the treatment of headaches, MI and cancer



Divided

European divisional application Z (Jun '14)

Discloses aspirin for use in the treatment of headaches

- If the subject matter of the claim of European application Y can be split such that it has multiple effective dates (partial priorities), there is no problem
- Conflicting case law regarding partial priorities:
 - No: T1877/08, T476/09, T1127/00 (T1496/11 did not discuss partial priority)
 - Yes: T1222/11

1 2 3 4 5

**The London
Agreement**

London Agreement

Current Status

– No post-grant translation:



UK



Switzerland



Ireland



Germany



Liechtenstein



Albania



France



Monaco



Luxembourg

– Translation of claims only:



The Netherlands



Slovenia



Finland



Iceland



Denmark



Hungary



Latvia



Sweden



Republic of Macedonia



Croatia



Lithuania

Unitary Patent and Unified Patent Court

- Unitary Patent
 - Additional validation option for European applications
 - Renewal fees not yet known
 - Some EPC countries missing
- Unified Patent Court System
 - opt in / opt out
- Here by 2016...?

UNITARY PATENT

(Must be an EU member state)

Austria	Latvia
Belgium	Lithuania
Bulgaria	Luxembourg
Cyprus	Malta
Czech Rep.	Netherlands
Denmark	Portugal
Estonia	Romania
Finland	Slovakia
France	Slovenia
Germany	Sweden
Greece	UK
Hungary	
Ireland	

CURRENTLY NOT PART OF UP and/or UPC

Italy *

Poland **

Spain

Croatia

* Italy has signed the UPC Agreement, so EP(IT)s will be litigated at the UPC

** Poland has signed up to the UP but not the UPC Agreement

EPC MEMBERS BUT NOT EU MEMBERS

Iceland †

Serbia †

Macedonia †

Turkey †

Albania

Norway

Switzerland

Liechtenstein

Monaco

San Marino

† EU candidate country

AWAITING RATIFICATION

Bulgaria	Italy
Cyprus	Latvia
Czech Rep.	Lithuania
Estonia	Luxembourg
Finland	Netherlands
Germany	Portugal
Greece	Romania
Hungary	Slovakia
Ireland	Slovenia

RATIFIED

Austria
France
Sweden

Coming soon?

Belgium
Denmark
Malta
United Kingdom

- Need 13 countries to ratify the UPC Patent agreement for it to come into force
- Must include France, Germany and the United Kingdom

Thank you

Any questions?

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Entering the Chinese National Phase

AIPLA PCT Seminar
July, 2014

CHINA PAT Intellectual Property OFFICE
Beijing · Hong Kong

[Http://www.china-pat.com](http://www.china-pat.com)

- ❖ Lots of things are manufactured in China
- ❖ Two real examples (enforcement factor; Filing utility model even lack of novelty)
- ❖ Defensive publication

- ❖ Due date for entry: 30 months
- ❖ Two-month grace period with additional fees
- ❖ Unavoidable revival available
- ❖ No unintentional revival

❖ Chinese translation of specification and claims in the international publication

- 1. In the US, English translation is not required for avoiding the case going abandoned;*
- 2. Making good use of the traditional Chinese translation filed in Taiwan;*

❖ Type of patent application

- 1. Invention application (similar to utility application) or Utility model*
- 2. when you use the term “utility patent”, be careful, it might be misunderstood as “utility model” by people from a country which has utility model*

❖ Application fee, publication fee and fee for grace period

- ❖ Invention patent (similar to utility patent in the US)
 - subject matter: machine, manufacture, process, composition of matter;
 - term: 20 years from Chinese filing date (international filing date);

- ❖ Utility model (no such category in the US)

	Year 2005	2006	2007	2008	2009	2010	2011
From domestic applicants	138,085	159,997	179,999	223,945	308,861	407,238	581,303
From foreign applicants	1481	1369 [~]	1325	1641	1910	2598	4164

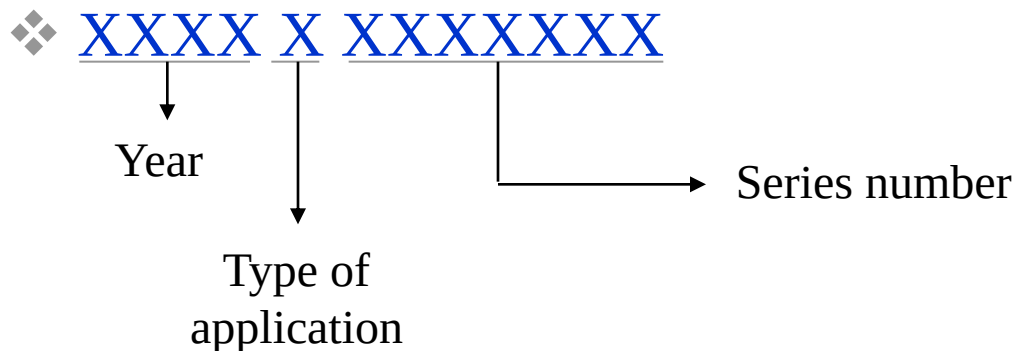
Number of utility model applications filed recently

- subject matter: fixed shape and/or structure (exclude process, microstructure, unfixed shape or structure);
- preliminary examination (between formality review and substantive examination);
- no prior art search;
- lower inventive step requirement;
- low cost;
- short pendency: three years (invention) v. eight months (utility model);
- enforce patent earlier;
- term: 10 years from Chinese filing date (international filing date);
- good for short-life product;
- the largest damage ever granted by a Chinese court was awarded to an utility model patentee (Schneider v. Chint USD47 million);
- filing invention and utility model on the same day is not available for Chinese national stage cases;



Number of Chinese national phase cases

- ❖ In 2013, SIPO received 73,583 Chinese national phase cases from PCT applications .
- ❖ 72,867 were invention patent applications and 716 were utility model applications.
- ❖ Account for 51% of total number of applications from abroad



- ❖ Year: year of international filing date
- ❖ Type: 8-invention application from a PCT;
9-utility model of a PCT;
- ❖ Patent number and application number share the same number

Basic Procedure – Full list

- ❖ Fee for claiming a priority;
- ❖ Additional claim fee and application Size Fee

Matters	Chinese Patent Practice	US Patent Practice
Additional Claim fee	More than 10 claims; no more claim fee after application is filed or after the PCT is entered the Chinese national stage; For a PCT entry case, it is calculated based on the claims filed on the International Filing date.	1. More than three independent claims; 2. More than 20 claims; 3. Multiple dependent claims; For a PCT entry case, it is calculated based on the preliminary amendment when the claim fee is paid.
Application size fee	specification including drawings each page in excess of 30 pages or each page in excess of 300 pages	each additional 50 sheets that exceeds 100 sheets

Basic Procedure – Full list (Cont.)

- ❖ Request for immediate processing if the case is entered before 30-month due date;
- ❖ Examination basis

Matter	Chinese Patent Practice	US Patent Practice
Examination Basis	Choose from Article 19, 34, 28 or 41 amendment	last amendment made during the international stage

- ❖ Chinese translation of amendment if it is chosen as examination basis (two month from the date of entering)
- ❖ Chinese translation of abstract and drawings
- ❖ If there is an assignment in the international stage, document proving the assignment is needed

- ❖ Examination fee: three years from the earliest priority date;
 - No examination fee if SIPO was ISA and IPEA;
 - 20% reduction if ISA was JP, EP, SE;
 - If the ISR is not provided to SIPO when request of examination is filed, the applicant submitting the ISR at SIPO before Notice of Entering the Substantive Examination is issued could get a refund of 20% examination fee;

- ❖ Scope: specification, claims, abstract, drawings
- ❖ No new matter (strict)
- ❖ Time limits:
 - Entering the Chinese national stage (Article 28 or 41)
 - Filing request for examination
 - Three months from receipt of Notice of Entering the Substantive Examination (receipt date: issue date of notice + 15 calendar days)
- ❖ No government fee for filing voluntary amendment
- ❖ No additional claim fee after entering the Chinese national stage

Voluntary amendment – Utility Model

- ❖ Scope: specification, claims, abstract, drawings
- ❖ No new matter (strict)
- ❖ Two month from the date of entering Chinese national stage
- ❖ No government fee for filing voluntary amendment
- ❖ No additional claim fee after entering the Chinese national stage

- ❖ Amendments made only for addressing rejection/objection in Office Action
- ❖ Applicant cannot do the following:
 - broadening scope of protection of an independent claim on applicant's own initiative; (amending or deleting limitation)
 - adding claims which lack of unity of invention with the examined claims;
 - adding new independent claim which is not in the original claims;
 - adding new dependent claim which is not in the original claims;

Correction of Chinese Translation

- ❖ Benefit of entering the Chinese national stage through a PCT: correct the Chinese translation based on the PCT international publication
(No incorporation by reference in China – cannot amend application document based on the priority case)
- ❖ Voluntary correction
- ❖ Correction required by SIPO
- ❖ Government fee
- ❖ Time limits:
 - before preparation for pre-grant publication of invention application;
 - before preparation for issuance of utility model application;
 - three months from receipt of Notice of Entering the Substantive Examination (receipt date: issue date of notice + 15 calendar days)

- ❖ After issuance, if Chinese translation has a broader scope of protection, the scope of protection of the patent is determined by the original PCT application;
- ❖ After issuance, if Chinese translation has a narrower scope of protection, the scope of protection of the patent is determined by the issued Chinese patent;

Common Defects in Drawings

- ❖ Drawings are not reproducible for publication purpose;
Problem: adding new matter when we submit clearer drawings
Suggestion: 1) replace the drawings during international phase; or
2) ask the International Bureau republish the drawings to make them clearer;
- ❖ Drawings and reference numerals must be computer-generated

❖ Reasons of filing in Hong Kong:

- the port of Hong Kong is one of the largest in the world
- home to some of the largest trade shows in the world (Hong Kong Electronics Fair, the Hong Kong Optical Fair, and the Hong Kong Houseware Fair)
- patent certificate is the necessary title document for making complaint to the Legal Adviser of Fairs about patent infringement by another exhibitor.

- ❖ Application document can be filed either in English or Chinese
- ❖ Filing a request to record a designated patent application (about USD600): six months from publication at SIPO
- ❖ Filing a request for registration: six months from issuance at SIPO (about USD250)

- ❖ Application step and registration step
- ❖ Two approaches to carry out the two steps.
- ❖ Approach One:
 - carry out the application step at any time when the Chinese national stage case is pending.
 - after the Chinese case is issued, carry out the registration step within three months from the issue date of the Chinese case.
- ❖ Approach Two
 - within three months from the issue date of the Chinese case, we just take the application and registration steps together as a single step.
- ❖ Approach Two is recommended

Accelerate/shorten prosecution and reduce its cost

- ❖ Average pendency for invention applications: 22.2 months
- ❖ Average pendency for utility model applications: 4.3 months
- ❖ Reduce number of Office Actions
 - 1) if necessary Contacting examiner before sending in a response to an Office Action;
 - 2) Contacting the examiner again to follow up after filing the response and inviting the examiner to call us when any issue comes up
- ❖ PCT-PPH/PPH
 - 1) From our experience, Office Action is issued in about two months from the date of filing PCT-PPH;
 - 2) Majority Office Action only points out some formality issues;



派特恩

Accelerate/shorten prosecution and reduce its cost (Cont.)

❖ Accelerated Examination:

The applicant may file a request for accelerated examination if the case falls into one of the following circumstances (no evidence needs to be shown):

- (a) The invention has great significant to national interests or public interests;
- (b) Any entity or individual exploits the invention after its publication, which has impacted the interests of the applicant significantly; and
- (c) Filing an invention application is used as an important part of an investment of intangible asset.

Time frame: The Chinese Patent Office must issue an Office Action within 30 working days from the date the petition of expedited examination is granted.

Applicant must respond to an Office Action within two months.

Comparison with US patent practice and Chinese patent practice

- ❖ Importance of understanding the differences (change practice according to the differences);

Matters	Chinese Patent Practice	US Patent Practice
Request for Continued Examination	No	Yes
Divisional application	Yes (due date of filing: issue date of Notice of Allowance + 15 calendar days + 2 months)	Yes copending
Continuation in part	No Practice: claim a domestic priority within 12 months	Yes

Comparison with US patent practice and Chinese patent practice (Cont.)

Matters	Chinese Patent Practice	US Patent Practice
Inventorship	1. Inventors only have a right to put their names onto the patent application/patent; 2. Wrong inventorship cannot be used to invalidate a patent	Wrong inventorship can cause a patent to be invalid or unenforceable
Grace period following public disclosure	6 months; In practice, it is almost never used (do not rely on it)	12 months;
Duty of information disclosure	No, unless the examiner asks for search result from an office. A favorable written opinion or an Office Action from other countries would be helpful to get a patent fast or save cost.	Yes

Comparison with US patent practice and Chinese patent practice (Cont.)

Matters	Chinese Patent Practice	US Patent Practice
References used for 102 rejection	1) Publicly used before the priority date; 2) Publicly known before the priority date; 3) Patented or described in a printed publication before the priority date; 4) Filed before the priority date and published at SIPO after the priority date; for a PCT application, it must be published by SIPO after entering the Chinese national stage It does not matter entity; (1), (2) and (3) are worldwide	102
References used for 103 rejection	1) Publicly used before the priority date; 2) Publicly known before the priority date; 3) Patented or described in a printed publication before the priority date;	102

Comparison with US patent practice and Chinese patent practice (Cont.)

Matter	CN Patent Practice	US Patent Practice
Determining Obviousness/Inventive Step	1. Identify the closest reference – <u>disclose most limitations</u>; 2. Ascertaining the differences between the claimed invention and identify <u>object</u> of application based on technical effect archived by the differences; and 3. Resolving the level of ordinary skill in the pertinent art.	1. Identify the prior art; 2. Ascertaining the differences between the claimed invention and the prior art; and 3. Resolving the level of ordinary skill in the pertinent art.

Comparison with US patent practice and Chinese patent practice (Cont.)

Matters	Chinese Patent Practice	US Patent Practice
“Same invention type” double patenting	Same priority date or Chinese filing date Same owner: pick one or amend Different owners: owners make agreement of the ownership; amend claims; Otherwise, both applications are rejected	It is not possible to overcome the rejection other than by canceling or amending the identical claim
“Obviousness type” double patenting	Canceling or amending the claims	Canceling or amending the claims or Terminal Disclaimer
Applicant	Can be a legal entity; No need to record an assignment if the legal entity files the application from the start	After September 16, 2012, can be non-inventor applicant

Comparison with US patent practice and Chinese patent practice (Cont.)

Matters	Chinese Patent Practice	US Patent Practice
Appeal	Yes, but it is called reexamination	Yes
First Office Action Prediction	No	Yes
Nonobviousness (35 USC 103)	Inventive step: a limitation not disclosed in prior art + technical effect	a limitation not disclosed in prior art
Secondary considerations	(1) long felt but unresolved needs; (2) skepticism by experts; (3) unexpected result; (4) the invention's commercial success;	(1) the invention's commercial success, (2) long felt but unresolved needs, (3) the failure of others, (4) skepticism by experts, (5) praise by others, (6) teaching away by others, (7) recognition of a problem, (8) copying of the invention by competitors.

Comparison with US patent practice and Chinese patent practice (Cont.)

Matters	Chinese Patent Practice	US Patent Practice
Restriction practice	distinct inventions (unity of invention); traverse/adding special technical feature into claims/delete claims which do not comply with Unity of Invention	distinct inventions/ distinct species Traverse (not often)/pick a group



Thank you

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China PAT Intellectual Property Office

Hong Kong PAT IP Limited

www.china-pat.com

STRATEGIES FOR NATIONAL FILING

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PCT Seminar
July, 2014

WHAT AND WHERE TO FOREIGN FILE

- Evaluate the invention
- Evaluate Countries for foreign filing
 - General Evaluation
 - Patent Evaluation
- Many companies prepare matrix of product/country for foreign filing

EVALUATING THE INVENTION

- Provide an analysis of the invention:
 - Problem to be solved
 - Previously suggested solutions
 - How the invention works
 - Distinguishing features of the invention
- Identify the type of invention that is being evaluated
 - Is it a basic invention?
 - Is it an improvement invention?
 - Is it an alternate embodiment to an existing invention?

- Determine the relationship between the invention and the client's business
 - Is it directly, peripherally or unrelated to a core business?
 - Is the invention more significant to a competitor's business?
 - What is the amount of time and money to be invested into the invention?
 - What is the anticipated life span of the invention?
- What is the purpose of obtaining the patent?
 - To protect technology from being used by keeping competitors away?
 - To improve marketing positions?
 - To protect customer use of the product or the technology?
 - Is it being filed for defensive purposes to block others from obtaining patents in certain areas?

- Is it for recognition to establish a reputation or credentials?
- Is it for potential use in other business relationships such as:
joint venture with other companies?

Licensing (one way or cross licensing?)

- Is it being used to support existing licensing activities?
- Bottom line question; If we don't get a patent, so what?

EVALUATING POTENTIAL COUNTRIES FOR FILING

- General evaluation of countries
 - Population
 - Market potential
 - Emerging or industrialized country
 - Industry size and growth rate
 - Client's activity within country
- Patent Evaluation of country
 - The standards of patentability in the country
 - The type of patents available in the country
 - The patenting costs
 - Enforceability of patents in the country
 - Strength of the legal system
 - Any bias against foreign plaintiffs?

COUNTRY/INVENTION SELECTION

- Guidance Tools
 - Formulas, charts, guidelines
 - Must be updated regularly
 - Must be tailored for each product

PRIORITIZING COUNTRIES

1. Protect local manufacture
2. Cover competitor's home countries or major investment manufacturing countries
3. Cover major markets
4. Cover export sales

A SUGGESTED SET OF RECOMMENDATIONS

<u>Type of Invention/Product</u>	<u>Recommendation</u>
System, assembly, complex machine	Limited filing in industrialized countries
Components and materials	Broad filing in all major countries
High technology product	Limited filing in industrialized countries and sourcing countries
World-wide consumer product	Broad filing in major market countries
Industrial product	Limited filing in industrialized countries
Pharmaceutical/chemical products	Broad filing especially where product is easily producible
Labor-intensive product	Low-cost manufacturing countries

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Disclaimer: This presentation does not constitute any specific legal or business advice.

DRAFTING A GLOBAL APPLICATION

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AIPLA
PCT Seminar
July, 2014

THE NEED FOR A “GLOBAL” PATENT APPLICATION

- REVISION OF APPLICATION FOR EACH FOREIGN COUNTRY IS NOT AN ADEQUATE SOLUTION
 - Time required for revision
 - Different attorneys for revision requires relearning
 - Hesitancy to make changes, especially in claims
 - Many countries still require translation of priority documents
 - Need priority application for “reference filing” under PLT
 - For PCT need translation of original application
- PCT is already a “Global” application

THE NEED FOR A “GLOBAL” PATENT APPLICATION (cont.)

- **US APPLICATIONS ARE VERY LENGTHY**
 - Satisfying 35 USC. 112
 - Enablement, best mode, and written description
 - Satisfying CAFC Requirements
 - Standing up in litigation
 - Claim invention many ways - especially after Festo
 - Length to impress client
 - Try to do a “selling job” of obviousness in view of KSR
 - Translation of such lengthy application is costly

THE NEED FOR A “GLOBAL” PATENT APPLICATION (cont.)

- **FOREIGN COUNTRIES HAVE DIFFERENT REQUIREMENTS**
 - Citing prior art
 - Format of specification
 - Type and number of claims
 - Objects, advantages, benefits
 - Different formalities, different headings
 - Different style and approach of describing inventions
- **DIFFERENT WRITTEN DESCRIPTION REQUIREMENTS**
 - US – invention support
 - EPO – photographic support
 - JPO – technical support

GENERAL RECOMMENDATIONS FOR A “GLOBAL” APPLICATION

- DESCRIBE THE INVENTION ONLY ONCE
 - Typical US Applications describe it 4-5 times
 - Summary of Invention
 - Brief Description of Drawings
 - General Description of Invention
 - Best Mode of Invention
 - Concluding Summary
- DON'T TEACH THE TECHNOLOGY
 - Application addressed to one skilled in art
 - Prior art should be in IDS not applications
 - Don't discuss prior history of technology or prior reference



US006243373B1

(12) **United States Patent**
Turock

(10) **Patent No.:** **US 6,243,373 B1**
(45) **Date of Patent:** **Jun. 5, 2001**

(54) **METHOD AND APPARATUS FOR IMPLEMENTING A COMPUTER NETWORK/INTERNET TELEPHONE SYSTEM**

(75) **Inventor:** **David L. Turock**, Westfield, NJ (US)

(73) **Assignee:** **Telecom Internet Ltd.**, Gerrard's Crossing (GB)

(*) **Notice:** Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 0 days.

(21) **Appl. No.:** **08/548,323**

(22) **Filed:** **Nov. 1, 1995**

(51) **Int. Cl.:** **H04L 12/66; H04L 12/28; H04M 1/64**

(52) **U.S. Cl.:** **370/352; 370/401; 379/88.17**

(58) **Field of Search:** 379/207, 112, 113, 114, 88, 67, 100.15, 100, 90.01, 93.09, 93.01; 370/351, 450, 389, 392, 352, 485, 458, 404, 401, 394, 747; 395/200.01, 200.02, 200.03

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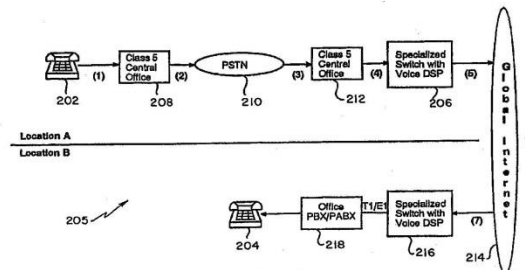
(List continued on next page.)

Primary Examiner—Wellington Chin
Assistant Examiner—Steven Nguyen
(74) *Attorney, Agent, or Firm*—Darby & Darby

(57) **ABSTRACT**

A method and apparatus are provided for communicating audio information over a computer network. A standard telephone connected to the public switched telephone network (PSTN) may be used to communicate with any other PSTN-connected telephone, where a computer network, such as the Internet, is the transmission facility instead of conventional telephone transmission facilities, such as the interexchange or intralata facilities. In addition to telephone-computer communication, telephone-computer and computer-telephone communication is also possible. The originator of a conversation (calling party) dials the number of an access port for the computer network. The call is routed to a central office switching system which is connected to the PSTN and then to the access port which is a specialized computer system (ITS node). The caller transmits the number of the desired party (the called party) to the specialized computer system (ITS node) which interfaces between the telephone switching system and the computer network. The specialized computer system (ITS node) receives the number of the called party and establishes a two-way, full duplex communications link via the computer network to a corresponding remote access port or specialized computer system (ITS node) in the vicinity of the called party. This specialized computer system (ITS node) at the receiving end is connected to the local PSTN in the region of the called party, and uses the local PSTN to connect the call to the called party. Once the call is answered at the called party, the calling and called party may communicate as if the call had been established using the conventional telephone system.

24 Claims, 10 Drawing Sheets



METHOD AND APPARATUS FOR IMPLEMENTING A COMPUTER NETWORK/ INTERNET TELEPHONE SYSTEM

FIELD OF THE INVENTION

The present invention generally relates to the field of telecommunications. More specifically, the present invention concerns a method and apparatus for transmitting telephone calls to or from a standard telephone set using a computer network such as the Internet.

BACKGROUND OF THE INVENTION

Communication systems for transmitting telephone calls have become an integral, indispensable part of everyday life. The first roots of telephony were planted in 1876 with the invention of the first practical telephone by Alexander Graham Bell. As the number of calling stations or customer lines (telephones) in the system began to grow, the wiring system interconnecting the telephones became extremely complicated and unwieldy. One solution to this problem was the introduction of switching systems. Each customer line terminated in a local switching system commonly referred to as a central office (CO). The central office then performed the task of connecting each of the telephone lines it served to a corresponding telephone line in order to complete a call. If the two parties to a call were serviced by the same central office, then the connection could be completed by the same central office without having to resort to other portions of the telecommunications network. If the call required connection to a telephone line serviced by a distant central office, then a connection between the central offices was carried out using a trunk, i.e., a connection between two central offices.

GENERAL RECOMMENDATIONS FOR A “GLOBAL” APPLICATION (cont.)

- AVOID OBJECTS
- AVOID PUFFING
- AVOID RECITATION OF NUMEROUS BENEFITS
- LIMIT NUMBER OF PAGES IN SPECIFICATION
 - Be Concise
 - Insist on Limits
- USE “GLOBAL” LANGUAGE
 - Short non-confusing sentences
 - Don't use ambiguous words
 - Avoid indefinite language
 - Avoid generalizations unless part of invention
 - Avoid critical language unless part of invention

GENERAL RECOMMENDATIONS FOR A “GLOBAL” APPLICATION (cont.)

- NO CROSS-REFERENCING
- NO INCORPORATION BY REFERENCE
- USE STANDARDIZED PCT FORMAT
- KEEP COPY ON PHYSICAL MEDIUM
- KEEP PARTS LIST
- USE SI UNITS

PREPARING A “GLOBAL” APPLICATION

- **ABSTRACT**
 - Use reference numerals
 - Can be removed for US if desired
 - Keep short
- **BACKGROUND OF INVENTION**
 - Use only one (1) reference at most - closest reference
 - Describe reference only briefly
 - Enclose copy of closest reference in all countries for agent's use
 - Use problem/solution approach
 - Problem
 - Prior art solution from reference

PREPARING A “GLOBAL” APPLICATION **(cont.)**

- **SUMMARY OF INVENTION**
 - Problem with prior art - try not to make it a simple problem in view of KSR
 - Solution provided by invention
 - Unobvious nature of invention - in view of KSR
 - Advantage of invention - general
 - Consistory statement - copy claim 1
 - No objects
- **BRIEF DESCRIPTION OF DRAWINGS**
 - Just itemize - don't describe
 - Keep Concise
- **DESCRIPTION OF THE INVENTION**
 - Describe only once
 - Describe as part of best mode

PREPARING A “GLOBAL” APPLICATION

(cont.)

- Each time you mention an item, give alternatives at that time
- Limit description of peripheral environment
- Be consistent in describing elements
- Use of examples is important, never too many
- Use generic type of examples and then list specifics covered by generic type
- Where range is recited, use example at low end, high end and mid-range
- Where values are critical, must show comparisons of in range and out of range
- For software patents include enough structure (even block diagrams)
- **CLAIMS**
 - Must limit foreign claims, preferably 10 claims
 - Write US claims so first 10 useful for foreign filing

PREPARING A “GLOBAL” APPLICATION **(cont.)**

- Foreign countries have broader unity of invention than US, thus more than one type of claim is permitted
- One independent claim for each type
- Limit dependent claims to novel features
- Use multiple dependencies when possible
- Foreign countries like functional language, but not all like “means”, therefore use descriptive terms plus function
- Insert reference numerals when preparing claims, can eliminate for US
- **DRAWINGS**
 - Use A-4 paper and PCT margins
 - Prepare one set without English words
 - Use computerized drawings to facilitate drawing changes

INTERNATIONAL ACTIVITIES

- Industrial Trilateral (AIPLA, IPO, Business Europe, JIPA) have formulated and IP5 Patent Offices have accepted “Single Format” covering formalities
- Substantive harmonization talks continuing in various forum
- Commonalities being reviewed by IP5 Offices

CONCLUSION

- APPLICATIONS CAN BE PREPARED FOR “GLOBAL” FILING
- CAN REDUCE INITIAL COST AS WELL AS FOREIGN FILING COST
- CAN PRODUCE A BETTER APPLICATION EVEN FOR US FILING
- YOUR PCT APPLICATION SHOULD BE PREPARED AS A GLOBAL APPLICATION

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Drafting an International Application as a Global Application – EP View

Tom Leonard

July 2014

“...separated by a common language”

- Different patent offices want and allow different things
- We must account for different audiences when drafting
- It can be too late after PCT filing

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Added Matter

Added Matter

- Article 123(2) EPC:

“The European patent application or European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed.”

- Requirement for grant
- Ground of opposition and revocation post-grant
 - Inescapable trap!!

Added Matter

- Amendments must be “directly and unambiguously derivable” from the application as originally filed
- A strict requirement: some examiners are looking for almost word-for-word textual basis (i.e. “support” in US-speak)
- Generally, implicit or explicit basis is OK
- Incorporation by reference?

Added Matter

- The EPO will object to picking one feature from a passage without the other
- So must be clear that:
 - The feature applies to all embodiments
 - The feature can be isolated from related features
 - i.e. the feature should be in a dependent claim

Added Matter: Intermediate Positions

- To add some but not all features from a dependent claim:
 - Need something that says or implies the features need not all come together

- To include multiple features from various dependent claims:
 - Need something that says or implies the features can come together
 - Selection from multiple lists: include intermediates

- To amend to a generalised form of specific feature in the description:
 - Need something that says or implies the feature could be more general
 - Introduction of a feature appearing in specific example into generalised claim otherwise not allowable

Added Matter: Essential v Optional Features

- EPO reads an independent claim as saying “The following features are essential...”
- EPO reads a dependent claim as saying “The following features are optional (but must all come together)...”
- To broaden an independent claim by removing a feature, **we must have basis**
 - Need something that says or implies the removed feature is not essential
 - What is said elsewhere in the application is therefore very important

Added Matter: Example

- If I claim:
 1. An automobile comprising a radio.
 2. The automobile of claim 1, comprising an anti-theft device.
 3. The automobile of claim 2, wherein the automobile is powered by a rocket.
 4. The automobile of claim 1, wherein the automobile is black and has a retractable roof.
- Can I amend to just a rocket-powered automobile?
- Can I amend to just a black automobile?
- Can I delete the radio?

Added Matter: Example

- More options for amendment if I originally had:
 1. An automobile.
 2. The automobile of claim 1, wherein the automobile has a radio.
 2. The automobile of claim 1 or 2, wherein the automobile has an anti-theft device.
 3. The automobile of any preceding claim, wherein the automobile is powered by a rocket.
 4. The automobile of any preceding claim, wherein the automobile is black.
 5. The automobile of any preceding claim, wherein the automobile has a retractable roof.

Added Matter: What does this mean for the draft?

- We need a “reservoir” of potential amendments from outset
 - Aim is to give maximum room for manoeuvre
 - This can be done in the claims, the Summary or the specific description
- Include:
 - Lots of intermediate statements between broad generalisations and specific embodiments
 - **Multiple claim dependencies**
 - Basis for optional features of one aspect of invention (e.g. product) also being optional features of other aspects of invention (e.g. method)
- Consider whether features are optional or essential

Added Matter: Bonus “incorporation by reference” slide

- T 689/90 states that it must be obvious:
 - (i) protection is or may be sought for such features;
 - (ii) such features contribute to solving the technical problem underlying the invention;
 - (iii) such features at least implicitly clearly belong to the description of the invention contained in the application as filed (Art. 78(1)(b)) and thus to the content of the application as filed (Art. 123(2)); and
 - (iv) such features are precisely defined and identifiable within the disclosure of the reference document.
- Moreover, documents not available to the public on the date of filing of the application can only be considered if (see T 737/90):
- (i) a copy of the document was available to the EPO on or before the date of filing of the application; and
- (ii) the document was made available to the public no later than on the date of publication of the application under Art. 93 (e.g. by being present in the application dossier and therefore made public under Art. 128(4)).

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Priority

Priority

- Claims are priority entitled:

“... only if the skilled person can derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole.”

Enlarged Board of Appeal decision G2/98

- Test for priority is effectively same as for added matter, a strict novelty standard
 - A generalisation or intermediate position not appearing in priority document will not be priority entitled

Priority: Ensuring ability to validly claim priority in Europe

- Paris Convention requires party filing priority claiming application (your PCT) to be the same as the party who filed application from which priority is claimed (or their successor in title)
- Chain of title needs to be in place before claiming priority
- Ideally, execute assignment before PCT filing
- Continuations and CIPs can complicate matters

Priority: What does it mean for the draft?

- Consider priority application when drafting claims
- If application is not a full repeat of priority document, retain basis for a priority-entitled position (e.g. include claims of priority application, or equivalent statements in the Summary)
- Remember, in Europe a priority document cannot be used as basis for amendment
- Make sure you have entitlement to claim priority
- “Poisonous priority”

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**Unity and
Independent
claims**

Unity of Invention

- Article 82 EPC:

“The European patent application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.”

- All independent claims should share the same, or a corresponding, novel and non-obvious concept
 - A requirement for grant, but not a ground of opposition or revocation
- EPO, whether searching as ISA or in EP phase, will search only the first invention appearing in the claims (but can pay additional search fees)

Unity of Invention: What does this mean from the draft?

- Lack of unity possible between claims or within a single claim (e.g. in a Markush grouping)
- Ensure your most important subject matter appears first in the claims
 - Can correct this on EP regional phase entry
 - As of 1 November 2014, can pay additional search fees
- Prepare your client for potentially expensive divisionals?

Number of Independent Claims

- Single independent claim only in each claim “category”
 - Usually no more than single independent product claim and single independent method claim allowed. Get a choice of which one is searched.
- Three exceptions [r.43(2)]:
 1. Inter-related products (plug-and-socket-type situation)
 2. Different uses of product or apparatus
 3. Alternative solutions to same problem
- You can amend to correct this problem (e.g. make them dependent claims), but you might need a divisional

Number of Independent Claims: What does this mean for the draft?

- Identify your most important independent claim
- Consider including a generic claim on filing (or basis for amendment to one)

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Clarity

Clarity

- EPO very strict on what it sees as “clear”
 - EPC states claims should usually be clear in isolation
 - Examiner not usually native English speaker
- Concerned with whether the skilled person easily determine the scope of the claim
- Added matter rules apply: **must have basis** for any amendment to cure lack of clarity
 - Without basis to amend, a lack of clarity could be fatal

Clarity: Types of objections

- Claim does not define “essential features” of the invention
 - Means you haven’t claimed technical solution to technical problem
- Claim defines result to be achieved
 - Must claim how problem is solved, not that it is solved
- Relative and/or inherently ambiguous terminology
 - High, low, (functional) fragment

Clarity: What does this mean for the draft?

- Must claim **how** effect is achieved, not **that** it is achieved
 - “functional fragment” language
- Mentally rehearse inventive step argument – are all the features you rely on in the independent claims?
- If not in claim on filing, make sure have basis to add later
- Consider back up/alternative wording for “difficult” terms
- Keep a word version of the specification

1 2 3 4 5

Inventive Step

Inventive Step

– The EPO loves the problem-and-solution approach!



1. Select the closest prior art document
2. Identify novel features of claimed invention over CPA
3. What is the technical effect of these features?
4. What technical problem do these features therefore solve?
5. Would it have been obvious to skilled person, starting from (1), and set the problem (4), to adapt (1) by adding the features (2), and thereby arrive at the solution of the claimed invention?

Inventive Step: What does this mean for the draft?

- Set up a technical problem in the Background
 - Setting the scene, rather than tying yourself to a position
 - Problem can be reformulated during prosecution
- Explain technical nature of your solution
 - Explain technical nature of optional features
- Consider scope of claims
 - Is problem solved over whole scope?
- Express all advantages
 - Not tied to exact wording

Inventive Step: Selection inventions (a special case)

1. Narrow;
2. Sufficiently far removed from the broader range;
3. Not an arbitrary choice from the earlier range, but must be another invention ('purposive selection'). In order to do so, the selected sub-range must generally confer a technical effect or advantage over the earlier range

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**Excluded
Subject Matter**

Excluded Subject Matter

- Art 52 EPC says *discoveries, scientific theories, mathematical methods, aesthetic creations, mental acts, methods for playing games, business methods and computer programs* are not inventions...
- ...but case law says that it's not excluded if non-obvious **technical solution to technical problem**
- A matter of substance, not form, so...
 - Make title sound technical, not business-related
 - Set up a technical problem in Background
 - Explain technical nature of solution in Summary

Excluded Subject Matter: Methods of treatment/diagnosis

- Art 53(c) EPC excludes methods of treatment of the human or animal body by surgery or therapy and diagnostic methods practiced on the human or animal body
- Include basis for medical use claims
 - EPC2000-style
- Include basis for non-excluded diagnostic method
 - Method without all four diagnostic steps (i) collect data; (ii) compare data with standard, (iii) note deviation; and (iv) attribute a diagnosis
 - Method without interaction with body, i.e. performed on a sample “obtained” from a patient, rather than always including step of obtaining the sample (*ex vivo* methods)

Summary

- Title
 - Excluded matter: make it sound technical
- Background
 - Excluded matter: set up a technical problem
 - Inventive step: telling a story; set up problem to be solved
- Summary section
 - Added matter: formal support for wording of the claims
 - Added matter: keep options open: reservoir of basis for amendment
 - Added matter: optional features, intermediates, independent “claims”...
 - Excluded matter: explain technical nature of solution
 - Inventive step: Mention advantageous effects of features as results

Summary

- Specific Description
 - Added matter: describe preferred and alternative embodiments
 - Added matter: include “reservoir” if you don’t like Summary sections
 - Clarity: give multiple definitions for “difficult” terms
- Claims
 - Clarity: are you relying on a feature’s name for novelty?
 - Clarity: have you recited features needed for inventive step argument?
 - Unity: novel and inventive features common to independent claims?
 - Number of independent claims
 - Multiple dependencies

The Opposition Division or Appeal Board

- Grounds of post-grant opposition:
 - Excluded subject matter, novelty, inventive step, industrial applicability
 - Added matter – **inescapable trap!!**
 - Insufficiency

- Unity, clarity and support don't appear

- Additional amendment requirement
 - No extension of claim scope allowed during Opposition.

The Judge (UK)

- Case will usually turn on scope of claims
 - Claim interpretation therefore critical
 - Same interpretation for both validity and infringement
- Grounds for revocation:
 - Excluded subject matter, novelty, inventive step, industrial applicability
 - Added matter – **inescapable trap!!**
 - Insufficiency
 - Entitlement
- Priority entitlement in the UK
 - Needs to be in place before claiming priority

Thank you

Any questions?

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CHINA PAT Intellectual Property OFFICE
Beijing · Hong Kong

[Http://www.china-pat.com](http://www.china-pat.com)

- ❖ Regular words
- ❖ Regular meaning
- ❖ Short sentence
- ❖ Easy to translate
- ❖ Concise

Measuring Unit

- ❖ China: International measuring unit (metric)
It might incur additional cost to convert
- ❖ US: inches, pounds

- ❖ Not viewed as part of original disclosure
- ❖ Keep it short
- ❖ Cannot amend the application based on the content only mentioned in the abstract

- ❖ Independent claim shall describe the essential limitations necessary for fulfilling object of the invention or utility model.
 - ground of invalidation;
 - it may cause the scope of protection narrower than it in the US;
 - more than one object;
 - technical effect and technical solution help to determine object if specification does not describe it, or problems mentioned in background;
 - each independent claim has to satisfy this requirement;
- ❖ Dependent claim

Matter	Chinese Patent Practice	US Patent Practice
Definition of dependent claims	1. must be about the same subject matter; 2. must include all the limitations; 3. must be in the same category (apparatus or method claim)	Determined by preamble



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Claims (Cont.)

- ❖ Apparatus claim is preferred
 - easy to enforce because China does not have discovery procedure;
- ❖ Multiple dependent claims are recommended;
- ❖ Multiple dependent claim cannot depend on another multiple dependent claim;
- ❖ Omnibus claim is not allowed (might work in other countries, such as India);
- ❖ Beauregard claim is not allowed;
- ❖ Machine or transformation also works in China;



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Claims (Cont.)

- ❖ The claims shall be definite
 - ground of invalidation;
 - “preferably” is indefinite; “substantially” is indefinite in most situation;
 - at least, define the meaning of “substantially” in the specification;
- ❖ Means-plus-function or step-plus-function;
 - similar to the US;
 - at enforcement stage, it is construed narrower than it at EPO

❖ Background

Matter	Chinese Patent Practice	US Patent Practice
Reference mentioned in background	No admission	Concede it as an admission of prior art

❖ Summary of invention

- Just has independent claims

❖ Embodiment

- No best mode requirement

❖ Written description is more strict in China (word-to-word textual basis)

- has claims for China in specification, even not in claims

Specification (Cont.)

- ❖ Enablement: similar to the US
- ❖ Incorporation by reference:

Matter	Chinese Patent Practice	US Patent Practice
Incorporation by reference	No Practice: to satisfy enablement, simply include the content in the application instead using incorporation by reference	Yes

- ❖ Technical effect
 - for inventive step purpose
 - cannot be added into the specification later
- ❖ Avoid using trademark to identify a product

Drawings

- ❖ No requirement: all limitations in claims must be shown in drawings;
- ❖ Computerized drawings



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Purpose of filing applications

- ❖ Protect products
- ❖ Block others
- ❖ License out
- ❖ Marketing purpose – additional value to products
- ❖ Different purposes might change how you draft and organize a patent application



Thank you

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Hong Kong PAT IP Limited

www.china-pat.com



Paris Convention for the Protection of Industrial Property

Carol Bidwell
July 2014

Claiming priority (PCT Article 8, Rule 4.10)

- The international application may contain a declaration claiming the priority of one or more earlier applications
 - ☐ filed in or, by way of a regional or international application, for any country party to the Paris Convention and/or
 - ☐ filed in any Member of the World Trade Organization (WTO) that is not party to the Paris Convention

Who is entitled to claim priority under Paris?

- Article 2 - National Treatment for Nationals of Countries of the Union
 - ☐ nationals of one Paris Convention country have the same right to protection of industrial property in other member countries as is offered by each other member country to its nationals
 - ☐ there is no requirement that the applicant must reside in the country where protection is claimed
- Article 3 - Same Treatment for Certain Categories of Persons as for Nationals of Countries of the Union
 - ☐ nationals of countries that are not members of the Paris Convention but who live in, or have real and effective industrial or commercial establishments in a Paris Convention country, shall be treated in the same manner as nationals of a Paris Convention country

Article 4 – Paragraph A

A. — (1) Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.

(2) Any filing that is equivalent to a regular national filing under the domestic legislation of any country of the Union or under bilateral or multilateral treaties concluded between countries of the Union shall be recognized as giving rise to the right of priority.

(3) By a regular national filing is meant any filing that is adequate to establish the date on which the application was filed in the country concerned, whatever may be the subsequent fate of the application.

Article 4 - Paragraph B

B. —Consequently, any subsequent filing in any of the other countries of the Union before the expiration of the periods referred to above shall not be invalidated by reason of any acts accomplished in the interval, in particular, another filing, the publication or exploitation of the invention, the putting on sale of copies of the design, or the use of the mark, and such acts cannot give rise to any third-party right or any right of personal possession. Rights acquired by third parties before the date of the first application that serves as the basis for the right of priority are reserved in accordance with the domestic legislation of each country of the Union.

Article 4 - Paragraph C

C. — (1) The periods of priority referred to above shall be twelve months for patents and utility models, and six months for industrial designs and trademarks.

(2) These periods shall start from the date of filing of the first application; the day of filing shall not be included in the period.

(3) If the last day of the period is an official holiday, or a day when the Office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day.

(4) A subsequent application concerning the same subject as a previous first application within the meaning of paragraph (2), above, filed in the same country of the Union, shall be considered as the first application, of which the filing date shall be the starting point of the period of priority, if, at the time of filing the subsequent application, the said previous application has been withdrawn, abandoned, or refused, without having been laid open to public inspection and without leaving any rights outstanding, and if it has not yet served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.

Article 4 - Paragraph D

D. — (1) Any person desiring to take advantage of the priority of a previous filing shall be required to make a declaration indicating the date of such filing and the country in which it was made. Each country shall determine the latest date on which such declaration must be made.

(2) These particulars shall be mentioned in the publications issued by the competent authority, and in particular in the patents and the specifications relating thereto.

(3) The countries of the Union may require any person making a declaration of priority to produce a copy of the application (description, drawings, etc.) previously filed. The copy, certified as correct by the authority which received such application, shall not require any authentication, and may in any case be filed, without fee, at any time within three months of the filing of the subsequent application. They may require it to be accompanied by a certificate from the same authority showing the date of filing, and by a translation.

(4) No other formalities may be required for the declaration of priority at the time of filing the application. Each country of the Union shall determine the consequences of failure to comply with the formalities prescribed by this Article, but such consequences shall in no case go beyond the loss of the right of priority.

(5) Subsequently, further proof may be required. Any person who avails himself of the priority of a previous application shall be required to specify the number of that application; this number shall be published as provided for by paragraph (2), above.

Article 4 - Paragraphs E and F

E. — (1) Where an industrial design is filed in a country by virtue of a right of priority based on the filing of a utility model, the period of priority shall be the same as that fixed for industrial designs.

(2) Furthermore, it is permissible to file a utility model in a country by virtue of a right of priority based on the filing of a patent application, and vice versa.

F. — No country of the Union may refuse a priority or a patent application on the ground that the applicant claims multiple priorities, even if they originate in different countries, or on the ground that an application claiming one or more priorities contains one or more elements that were not included in the application or applications whose priority is claimed, provided that, in both cases, there is unity of invention within the meaning of the law of the country. With respect to the elements not included in the application or applications whose priority is claimed, the filing of the subsequent application shall give rise to a right of priority under ordinary conditions.

Article 4 - paragraphs G

G. — (1) If the examination reveals that an application for a patent contains more than one invention, the applicant may divide the application into a certain number of divisional applications and preserve as the date of each the date of the initial application and the benefit of the right of priority, if any.

(2) The applicant may also, on his own initiative, divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the Union shall have the right to determine the conditions under which such division shall be authorized.

Article 4 - paragraphs H through I

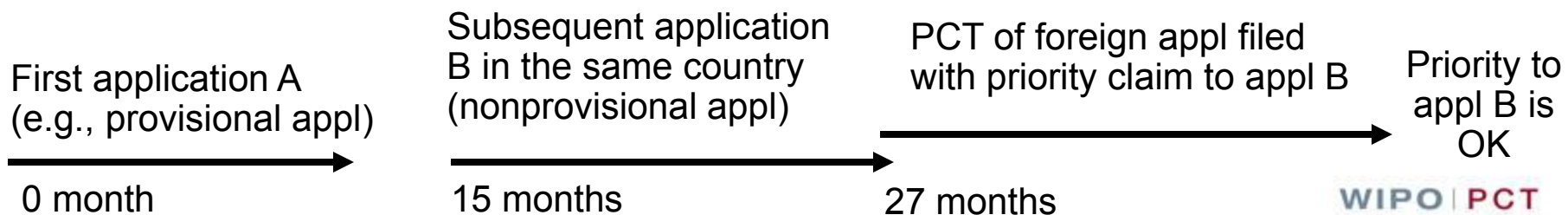
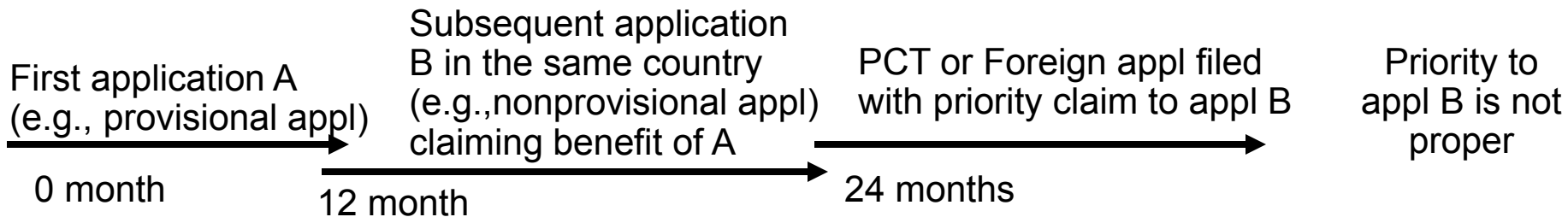
H. — Priority may not be refused on the ground that certain elements of the invention for which priority is claimed do not appear among the claims formulated in the application in the country of origin, provided that the application documents as a whole specifically disclose such elements.

I. — (1) Applications for inventors' certificates filed in a country in which the right to apply at their own option either for a patent or for an inventor's certificate shall give rise to the right of priority provided for by this Article, under the same conditions and with the same effects as applications for patents.

(2) In a country in which applicants have the right to apply at their own option either for a patent or for an inventor's certificate, an applicant for an inventor's certificate shall, in accordance with the provisions of this Article relating to patent applications, enjoy a right of priority based on an application for a patent, a utility model, or an inventor's certificate.

When is a subsequent application concerning the same subject matter considered the “first” application within the meaning of Article 4 C (4)?

1. First application has been withdrawn, abandoned or refused AND
2. First application has not been laid open to public inspection AND
3. First application has left no rights outstanding AND
4. First application has not yet served as the basis for claiming the right of priority AND
5. First application may not thereafter serve as a basis for claiming a right of priority



Different language in the U.S. Statutes than in the Paris Convention

- 35 U.S.C. 21(b) states:

When the day or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday or a Federal holiday within the District of Columbia, the action may be taken or fee paid on the next succeeding secular or business day

- 35 U.S.C. 119(e)(3) states:

If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday or Federal holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next secular or business day

- Under US law applicants are permitted to take action on the next business day when the last day for taking action falls on a weekend or Federal holiday, regardless of the mode or form of filing

Possible legal consequences of the USPTO accepting electronic applications on Saturday and Sunday

- International applications (or any other patent document) can be filed electronically in the USPTO during the hours of operation of EFS-Web every day of the week, including weekends and holidays
- Paris Convention Article 4C(3) says “If the last day of the period is an official holiday, or a day when the Office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day”
- Applicants should consider possible adverse consequences regarding the validity of a Paris Convention priority claim if they wait until Monday to file an international application in the RO/US where the priority year ends on a Saturday or Sunday

http://www.uspto.gov/patents/process/file/efs/guidance/New_legal_framework.js

C6. Are there any legal consequences of the USPTO's accepting electronic patent applications on Saturday and Sunday? Applicants may file patent applications electronically during the hours of operation of EFS-Web every day of the week, including weekends and holidays. EFS-Web will provide applicants with the opportunity to receive a filing date on any day of the week, including Saturday, Sunday, and Federal holidays. In addition, 35 U.S.C. 21(b) states:

When the day, or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or a Federal holiday within the District of Columbia, the action may be taken, or fee paid, on the next succeeding secular or business day.

Further, 35 U.S.C. 119(e)(3) states:

If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next succeeding secular or business day.

Thus, under United States law, applicants will be permitted to take action on the next business day when the last day for taking action falls on a weekend or Federal holiday, regardless of the mode or form of filing.

However, Article 4 of the Paris Convention addresses the priority period and in Article 4(c)(3) it states:

If the last day of the period is an official holiday, or a day when the Office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day.

Further, as stated above, the USPTO is capable of accepting electronic patent application filings every day of the week, including weekends and holidays, through EFS-Web. Thus, applicants are cautioned to consider possible adverse consequences regarding the determination in other countries of priority periods under Article 4(C)(3) of the Paris Convention when filing international applications with the United States Receiving Office. **Specifically, the ability to file applications electronically on weekends and holidays in the USPTO may result in loss of priority rights in foreign jurisdictions designated in international applications filed with the United States Receiving Office, if applicants elect, in accordance with 35 U.S.C. 21(b) or 119(e)(3), to file an international application on the next succeeding business day in the event that the twelve-month Paris Convention priority period set out in Article 4(C)(1) falls on a Saturday, Sunday, or Federal Holiday.** In such circumstances, other patent offices may deny the priority claim on the basis that the international application was not timely filed if their national law strictly incorporates the provision of Paris Convention Article 4(c)(3) and considers the USPTO to be open for the filing of applications on weekends and holidays. For this reason, applicants may prefer not to rely upon the "next business day" provisions of 35 U.S.C. 21(b) and 119(e)(3) when filing international applications with the USPTO, and instead file the international application before the Paris Convention twelve-month priority period has expired.

US Provisional applications Risks and possible benefits

Carl Oppedahl

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Why do we file provisionals?

- The client will be publishing an article next week
- The client will be revealing things to a third party tomorrow
- The client will be releasing a product to customers next week

Why do we file provisionals?

- The client wants to be able to say “patent pending”
- The client thinks it saves money to file a provisional as compared with filing a full patent application

What are some of the risks with a provisional application?

- The provisional application may flunk the best-mode test
- The provisional application may flunk the written-description test
- The provisional application may flunk the enablement test

When we file a risky provisional ...

- A risky provisional might be nothing more than a set of power-point slides for the meeting that will happen tomorrow
- A risky provisional might be nothing more than a copy of the article that will be published next week

When we file a risky provisional ...

- A risky provisional might be nothing more than a document prepared by the client, “shoveled” into an envelope and filed with the USPTO so hastily that there was no time for patent counsel to review it

When we file a risky provisional ...

- The client must be warned of the risks
- The next application ought to be drafted and filed very soon thereafter
- The next application might be filed as an additional provisional application, with the later non-provisional (for example PCT) application claiming priority from both provisionals